

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

6009

JOINT APPENDIX

IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 22,866

THE GOODYEAR TIRE & RUBBER COMPANY, *Appellant*

v.

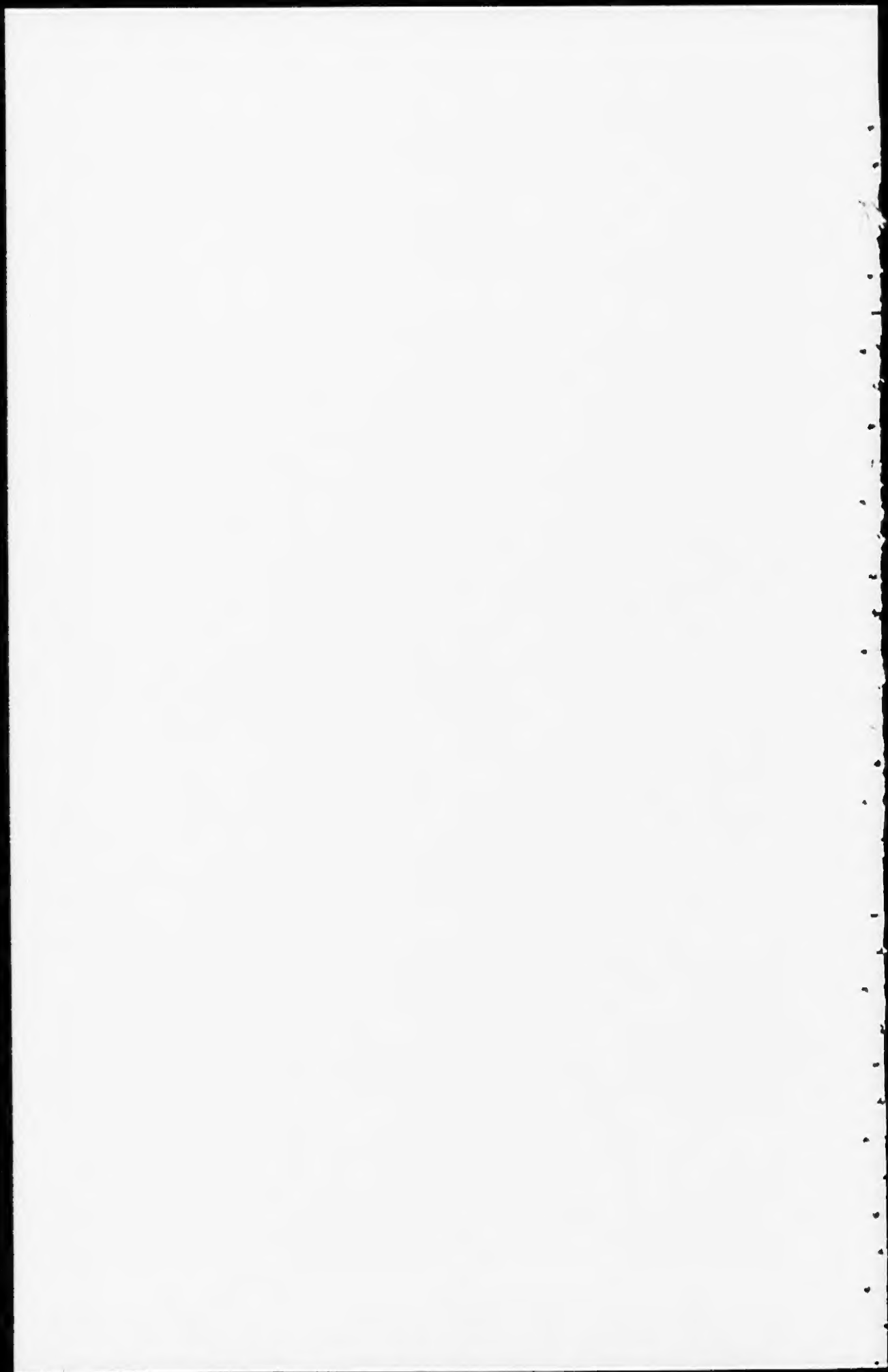
EDWARD J. BRENNER, Commissioner of Patents, EDWIN L.
REYNOLDS, First Assistant Commissioner of Patents,
Sub Nomine—THE COMMISSIONER OF PATENTS, *Appellees*

Appeal from the United States District Court
for the District of Columbia

United States Court of Appeals
for the District of Columbia Circuit

FILED JUN 16 1969

Nathan J. Paulson
CLERK



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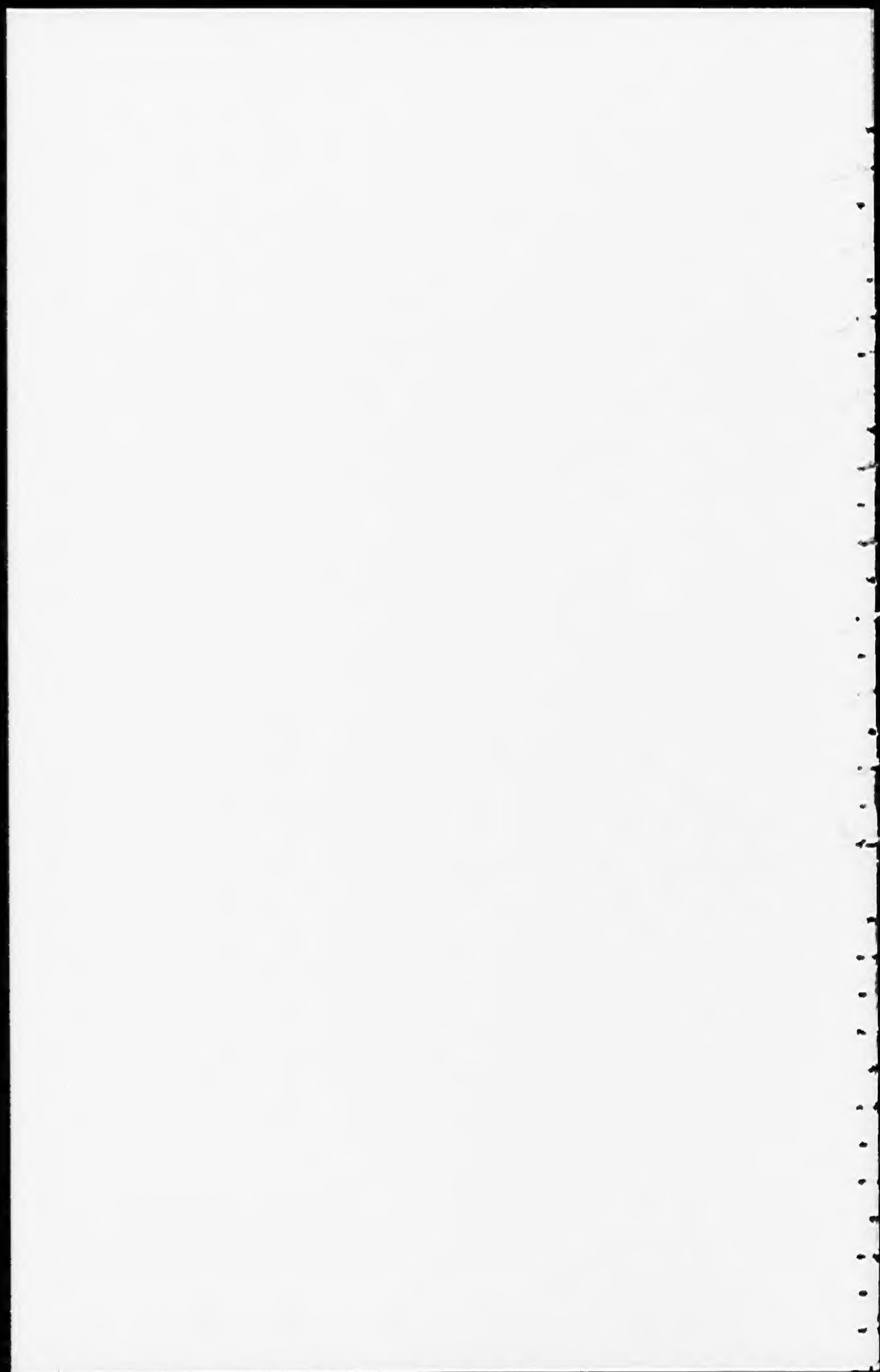
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IN THE
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FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 22,866

THE GOODYEAR TIRE & RUBBER COMPANY, *Appellant*

v.

EDWARD J. BRENNER, Commissioner of Patents, EDWIN L.
REYNOLDS, First Assistant Commissioner of Patents,
Sub Nomine—THE COMMISSIONER OF PATENTS, *Appellees*

Appeal from the United States District Court
for the District of Columbia

JOINT APPENDIX

[Filed February 24, 1967]

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THE GOODYEAR TIRE & RUBBER COMPANY, 1144 East Market
Street, Akron, Ohio 44316, *Plaintiff*

v.

EDWARD J. BRENNER, Commissioner of Patents, Department
of Commerce, Washington, D. C. 20231

and

EDWIN L. REYNOLDS, First Assistant Commissioner of
Patents, Sub Nomine, The Commissioner of Patents,
Department of Commerce, Washington, D. C. 20231,
Defendants

Civil Action No. 445-67

**Complaint Under Title 5 United States Code Sections 701-706
(Public Law 89-554, 89th Congress, 80 Stat. 392-393, Part I,
Ch. 7, Sept. 6, 1966) to Compel Agency Action Unlawfully
Withheld and Unreasonably Delayed and to Hold Unlaw-
ful and Set Aside Agency Action Which Is Not in Accord-
ance With Law; Contrary to Constitutional Right of Due
Process; in Excess of Statutory Authority; Without Ob-
servance of Procedure Required by Law and Rules; and
Unwarranted by the Facts**

1. Defendant Edward J. Brenner is Commissioner of Patents of the United States of America and Defendant Edwin L. Reynolds is First Assistant Commissioner of Patents of the United States of America, sub nomine, Commissioner of Patents of the United States of America.

2. Defendants are each, in their respective official capacities, residents of the District of Columbia, having their respective offices in the Department of Commerce, Washington, D. C., and are within the jurisdiction of this court.

3. Plaintiff, a party to Trademark Cancellation 8,738 instituted in the United States Patent Office pursuant to Title 15 United States Code 1064 (Section 14, Trademark Act of 1946) and the Trademark Rules of Practice of the Patent Office promulgated pursuant to Title 15 United States Code Sections 1125 and 1067 (Sections 41 and 17, Trademark Act of 1946) and Title 5 United States Code Section 552, 553, is suffering a legal wrong and is adversely affected and aggrieved by the agency action of defendants and those acting under their authority.

4. This action is brought under the provisions of Title 5 United States Code Sections 701-706 (Public Law 89-554, 89th Congress, 80 Stat. 392-393, Part I, Ch. 7, September 6, 1966) to compel defendants to conduct proceedings in Trademark Cancellation 8,738, such proceeding being unlawfully withheld and unreasonably delayed; the action of defendants in suspending such proceeding being arbitrary, capricious, and otherwise not in accordance with law; being a denial of constitutional due process; being in excess of statutory jurisdiction, authority and limitation; being without observance of procedure required by law and rules of procedure of the agency; and being unwarranted by the facts relied upon by defendants in support of their withholding action in said Cancellation 8,738.

5. This court has jurisdiction of the subject matter under Title 28 United States Code Section 1361 and Title 5 United States Code Sections 701-706.

6. This court has jurisdiction of all the necessary parties to this action under Title 28 United States Code Section 1391(c).

7. On or about July 28, 1966, Plaintiff filed in the United States Patent Office, as provided by Title 15 United States Code 1064 (Section 14, Trademark Act of 1946) and the applicable Trademark Rules of Practice of the Patent Office, a verified petition to cancel United States Trade-

mark Registration 811,725 which issued July 26, 1966 to Weather-Rite Sportswear Co., Inc.

8. The cancellation petition was transmitted to the Trademark Trial and Appeal Board pursuant to Trademark Rule 2.113, and said Board was directed by the Commissioner, pursuant to Title 15 United States Code Section 1067 (Section 17, Trademark Act of 1946) to determine and decide whether or not Registration 811,725 should be cancelled.

9. On August 19, 1966 the Clerk of the Trademark Trial and Appeal Board, by direction of the Commissioner pursuant to Trademark Rule 2.113, formally instituted Cancellation 8,738, *The Goodyear Tire & Rubber Company v. Weather-Rite Sportswear Co., Inc.*, stating that "Proceedings will be conducted in accordance with the Trademark Rules of Practice" and set a period of forty days from August 19, 1966 for the registrant to answer the petition.

10. Registrant filed its answer on or about September 28, 1966, the fortieth day from August 19, 1966.

11. On or about October 5, 1966 the Clerk of the Trademark Trial and Appeal Board assigned times for taking testimony pursuant to Trademark Rule 2.121, such assignment corresponding to "setting a case for trial in court proceedings" as stated in Trademark Rule 2.117(d).

12. On October 7, 1966, pursuant to Trademark Rule 2.120(a), plaintiffs served a "Notice of Taking Discovery Depositions" of Martin Greenberg, Vice-President of Weather-Rite Sportswear Co., Inc., for the taking of his deposition on October 17, 1966. In addition, a subpoena was served on Weather-Rite Sportswear Co., Inc. commanding Martin Greenberg to appear pursuant to the "Notice of Taking Discovery Depositions" on the date and at the time and place stated therein.

13. On or about October 12, 1966, Weather-Rite Sportswear Co., Inc. filed in the Patent Office and served on plain-

tiff a copy of a motion to consolidate Cancellation 8,738 with an Opposition 44,248, The Goodyear Tire & Rubber Company v. Irving Raincoat Co., Inc., and to suspend proceedings in said cancellation pending determination of the opposition or, in the alternative, pending completion of discovery proceedings in Civil Action 65C476, The Goodyear Tire & Rubber Company v. Weather-Rite Sportswear Co., Inc.

14. On or about October 18, 1966, plaintiff filed in the Patent Office and served on the registrant a memorandum in opposition to registrant's motions to consolidate and to suspend proceedings.

15. On October 27, 1966 a member of the Trademark Trial and Appeal Board denied the motion of the registrant to consolidate the cancellation with the opposition pending between plaintiff and a third party, but placed the parties under an order to show cause by November 14, 1966 why the cancellation proceeding should not be suspended "pending the final determination" of the civil action.

16. On November 14, 1966 plaintiff responded to the order to show cause, among other things, making reference in said response to the representations made on behalf of the present defendants by the Assistant Solicitor for the Patent Office in an antecedent Civil Action 2894-64 filed November 23, 1964 in this court by The Goodyear Tire & Rubber Company against the Commissioner of Patents at a hearing before Judge Joseph R. Jackson, with respect to the right of plaintiff to have remedy by way of cancellation of the registration, the issuance of which plaintiffs sought to have withheld by the Commissioner of Patents pending publication for purposes of opposition.

17. On December 9, 1966 a member of the Trademark Trial and Appeal Board suspended proceedings in Cancellation 8,738 "pending the final outcome" of the civil action between the parties in the United States District

Court for the Southern District of New York "notwithstanding the fact that the civil suit is not concerned with the cancellation of respondent's registration here involved".

18. On December 19, 1966 plaintiff filed in the Trademark Trial and Appeal Board and served on registrant a petition for reconsideration of the action of the Board member dated December 9, 1966 suspending proceedings in Cancellation S.738, pointing out that the Acting Commission of Customs, although aware of the pending cancellation proceeding, recorded the subject registration in the Bureau of Customs, saying: "However, until such time as the cancellation proceeding may be concluded in favor of your client, we know of no authority providing us a basis for refusing to record a trademark which is currently registered in the Patent Office".

19. On January 19, 1967 a member of the Trademark Trial and Appeal Board denied plaintiff's petition for reconsideration.

20. On January 27, 1967, pursuant to Trademark Rule 2.146(a)(3), (b) and (c), plaintiff filed a petition to the Commissioner of Patents, in person, seeking the exercise of his supervisory authority over the Trademark Trial and Appeal Board to compel it to resume and go forward with the cancellation proceeding; to designate himself as a member of the Trademark Trial and Appeal Board pursuant to Title 15 United States Code 1067 (Section 17, Trademark Act of 1946) to hear and decide further matters in the proceeding and to conduct an oral hearing on plaintiff's petition as provided by Trademark Rule 2.146(c).

21. On or about February 16, 1967 registrant filed in the United States Patent Office and served on plaintiff a copy of a memorandum in response to plaintiff's petition to the Commissioner of Patents in person, but there is nothing in the record to indicate whether or not the contents thereof

was considered by either of the defendants before a decision was rendered on plaintiff's petition to the Commissioner of Patents in person.

22. The Commissioner of Patents, in person, did not consider plaintiff's petition either in his capacity as Commissioner of Patents or as a statutory member of the Trademark Trial and Appeal Board.

23. On February 16, 1967, defendant Reynolds, sub nomine Commissioner of Patents, denied plaintiff's petition to the Commissioner of Patents in person, refusing to hold an oral hearing, refusing to have the Commissioner designate himself a member of the panel to determine and decide the right of registrant to retain the subject registration, and refusing to exercise any supervisory action whatever, while stating that the suspension of the cancellation proceeding "does not deny the petitioner's right to maintain the present proceeding" and that "at the most it merely delays the decision somewhat in the interest of avoiding unnecessary work by the parties and the Patent Office".

24. The action of defendants in suspending proceedings in Cancellation 8,738 is inconsistent with the action taken on February 20, 1967 in Trademark Application Serial No. 226,675 filed August 27, 1965, wherein the request of applicant to have proceedings on the application suspended pending the final outcome of ancillary concurrent use proceeding was denied.

25. There is no precedent for suspending action in a cancellation proceeding pending the outcome of a civil action between the same parties, wherefore the action of defendants in suspending proceedings in Cancellation 8,738 has no precedent, is not based on any statute or rule, and is not in accordance with any established or long-standing practice before the agency.

26. The action of defendants in suspending proceedings in Cancellation 8,738 is inconsistent with the representations made on their behalf before this court in antecedent Civil Action 2894-64 wherein defendants urged that they should not be required to republish for opposition the mark which is the subject of the present cancellation for the reason that plaintiff would have remedy by way of cancellation of the registration after issuance and that the consequences of issuance of such registration would be no more damaging to plaintiff than if the mark was republished for opposition.

27. Plaintiff has been irreparably damaged by the issuance of the subject registration and is further damaged by defendants' refusal to perform their statutory duty to proceed to determine and decide the issues raised in Cancellation 8,738 without further delay on the part of defendants.

28. The Commissioner of Customs will not remove Registration 811,725 from the records of the Bureau of Customs pending cancellation of said registration upon final disposition of Cancellation 8,738 and defendants, Commissioner of Patents and First Assistant Commissioner of Patents, sub nomine Commissioner of Patents, refuse to proceed with said cancellation in the manner prescribed by the statutes and Rules of Practice.

29. The Commissioner of Patents and those acting in his name and under his authority are unlawfully withholding and unreasonably delaying action in the aforesaid Trademark Cancellation 8,738 by suspending proceedings therein; have acted arbitrarily, capriciously, and otherwise contrary to and not in accordance with law in doing so; and are causing plaintiff immediate and irreparable damage each day such proceedings remain suspended.

30. A copy of this Complaint and Summons is being forwarded by first-class certified air mail, return receipt requested, to Weather-Rite Sportswear Co., Inc., 5802 Third Avenue, Brooklyn, New York 11220, respondent in Cancel-

lation 8,738 and Friedman & Goodman, 26 Court Street, Brooklyn, New York 11201, counsel of record for said respondent in Cancellation 8,738 for their information.

WHEREFORE, Plaintiff prays that:

A. Defendants, the Commission of Patents, the First Assistant Commissioner of Patents, sub nomine Commissioner of Patents, and all those acting in their names or under their authority be directed to immediately resume proceedings in Trademark Cancellation 8,738 and to go forward with such proceedings in accordance with the statute and applicable Trademark Rules of Practice of the Patent Office until said proceeding is terminated in accordance with law and such rules.

B. Defendants, the Commissioner of Patents and the First Assistant Commissioner of Patents be ordered and directed to perform their statutory duty of determining and deciding, as members of the Trademark Trial and Appeal Board, the right of registrant to retain Registration 811,725.

C. Defendants be ordered and directed to refrain from further suspension of proceedings in Cancellation 8,738 in the absence of a stipulation of the parties or order of this court.

Respectfully,

THE GOODYEAR TIRE & RUBBER COMPANY

By FRANCIS C. BROWNE

1815 H Street, N.W.

Washington, D. C. 20006

Attorney for Plaintiff

Phone: 638-6181

Of Counsel:

BROWNE, SCHUYLER & BEVERIDGE

1815 H Street, N.W.

Washington, D. C.

[Filed April 25, 1967]

Answer to Complaint

To the Honorable the Judges of the United States District
for the Court for the District of Columbia

1. 2. Defendants admit the allegations of these paragraphs of the complaint.

3. Defendants admit the allegation of this paragraph of the complaint respecting plaintiff being a party to Trademark Cancellation 8738, but defendants deny, for reasons hereinafter given, the allegation that plaintiff is suffering a legal wrong by the agency, action of defendants.

4. Except for admitting the allegations of this paragraph of the complaint respecting Title 5 United States Code Sections 701-706, defendants deny all other allegations of this paragraph, for reasons hereinafter given.

5. 6. Defendants admit the allegations of these paragraphs of the complaint.

7-11. Defendants admit the allegations of these paragraphs of the complaint.

12. Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph of the complaint, and, therefore, defendants deny said allegations.

13-23. Defendants admit the allegations of these paragraphs of the complaint.

24. Defendant denies the allegations of this paragraph of the complaint.

25, 26. Defendants deny the allegations of this paragraph of the complaint, for reasons hereinafter given.

27. Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph of the complaint, and, therefore, defendants deny said allegations.

28. Defendants admit the allegations in this paragraph of the complaint, except that which alleges that defendants refusal to proceed with said cancellation, is contrary to law or rules of practice, which allegation defendants deny.

29. Defendants deny the allegations of this paragraph of the complaint, for reasons hereinafter given, with the exception of the allegation respecting immediate and irreparable damage each day the cancellation proceeding remains suspended, which allegation defendants deny, because they are without knowledge or information sufficient to form a belief as to the truth of said allegation.

30. The allegations of this paragraph of the complaint are considered to be of a nature not requiring an answer by defendants.

FURTHER ANSWERING, defendants denying that plaintiff is entitled to an order of this Court directing immediate resumption of proceedings in Trademark Cancellation 8,738, as requested in prayer A of the complaint, or an order directing defendants to decide, as members of the Trademark Trial and Appeal Board, the right of registrant to retain registration 811,725, as requested in prayer B, or an order directing defendants to refrain from further suspension of proceedings in Cancellation 8738 in the absence of a stipulation of the parties or order of the court, for the reasons given and in view of the authorities cited and relied upon by the member of the Trademark Trial and Appeal Board in the decisions of December 9, 1966 and January 19, 1967, and by the First Assistant Commissioner in his decision of February 16, 1967. Profert of said decisions is hereby made.

Respectfully submitted,

JOSEPH SCHIMMEL
*Solicitor, United States
Patent Office, Attorney for
the Defendants*

[Filed August 30, 1967]

Plaintiff's First Set of Interrogatories to Defendants

Plaintiff requests that each defendant answer, under oath, in accordance with Rule 33 of the Federal Rules of Civil Procedure, each and all of the following Interrogatories:

1. Has the Secretary of Commerce ever vested in himself any function conferred on the Commissioner of Patents or the Trademark Trial and Appeal Board by statute under Title 15, United States Code?

1a. If the answer to Interrogatory 1 is in the affirmative, describe each such function, the statutory basis for such action, and the respective dates on which the Secretary of Commerce vested each such function in himself.

1b. If the answer to Interrogatory 1 is in the affirmative, has the Secretary of Commerce delegated to the Commissioner of Patents, the Trademark Trial and Appeal Board, or anyone acting under the authority of either, any of those functions which the Secretary of Commerce vested in himself or vested in him by statute?

1c. If the answer to Interrogatory 1b is in the affirmative, describe which such functions have been delegated, the statutory basis for such action, to whom and the respective dates on which the delegation became effective.

2. On what date did defendant, Edward J. Brenner, assume the office and duties of Commissioner of Patents?

3. Has defendant, Edward J. Brenner, continuously held the office of Commissioner of Patents from the date given in answer to Interrogatory 2 to the date of answering this Interrogatory?

4. Was defendant, Edward J. Brenner, Commissioner of Patents on February 16, 1967?

4a. If the answer to Interrogatory 4 is in the negative, who was Commissioner of Patents or Acting Commissioner of Patents on February 16, 1967?

5. Has defendant, Edward J. Brenner, in his capacity as Commissioner of Patents, ever, since the date given in answer to Interrogatory 2, acted, in person, upon a petition of a party addressed to the Commissioner of Patents under Rule 2.146(a) of the Trademark Rules of Practice of the Patent Office?

5a. If the answer to Interrogatory 5 is in the affirmative, identify each such instance and state whether each such petition was granted or denied.

6. Has Edward J. Brenner, in his capacity as Commissioner of Patents, ever, since the date given in answer to Interrogatory 2, designated himself a member of the Trademark Trial and Appeal Board to hear a case within the meaning of Section 17 of the Trademark Act of 1946 (15 USC 1067)?

6a. If the answer to Interrogatory 6 is in the affirmative, identify each such case and state the names and title of each person other than the Commissioner of Patents designated to hear the respective cases.

7. Has the Commissioner of Patents designated the members of the Trademark Trial and Appeal Board who are to hear Cancellation 8,738?

7a. If the answer to Interrogatory 7 is in the affirmative, state the names and titles of each person thus designated and the date on which such designation was made.

8. On what date, if at all, did defendant, Edward J. Brenner, personally first see the Patent Office file of Cancellation 8,738?

9. Has Edward J. Brenner, in his capacity as Commissioner of Patents, ever, since the date given in answer to Interrogatory 2, issued or caused to be issued by any person acting under his authority, any Rule of Practice, regulation, or oral or written statement of policy setting forth guidelines to be followed by members of the Trademark

Trial and Appeal Board or the Assistant Commissioner of Patents with respect to suspension of cancellation proceedings in the United States Patent Office pending the outcome of a civil action between the parties to such cancellation proceedings?

9a. If the answer to Interrogatory 9 is in the affirmative, state the effective date of each such rule, regulation or statement of policy and where the text thereof may be inspected and copied.

10. Under what statute, rule, regulation or statement of policy do the defendants contend the Commissioner of Patents or anyone acting under his authority may suspend all action in a trademark cancellation proceeding in the Patent Office in the absence of consent or stipulation between all parties that such proceedings may be suspended?

11. What is the Cancellation Docket Number of each cancellation proceeding in the United States Patent Office (except Cancellation 8,738) in which action in such proceeding was suspended by the Patent Office pending the outcome of a civil action between the same parties, in the absence of a stipulation between or consent of one or more of each of the parties that such proceeding should be suspended?

12. On what date did Edwin L. Reynolds assume the duties of First Assistant Commissioner of Patents?

13. Has defendant, Edwin L. Reynolds, continuously held the office of First Assistant Commissioner of Patents from the date given in answer to Interrogatory 12 to the date of answering this Interrogatory?

14. Was defendant, Edwin L. Reynolds, Commissioner of Patents or Acting Commissioner of Patents on February 16, 1967?

15. Was defendant, Edwin L. Reynolds, First Assistant Commissioner of Patents on February 16, 1967?

16. Has defendant, Edwin L. Reynolds, in his capacity as First Assistant Commissioner of Patents or Acting Commissioner of Patents ever, since the date given in answer to Interrogatory 12, been designated, designated himself, or served as a member of the Trademark Trial and Appeal Board to hear a case within the meaning of Section 17 of the Trademark Act of 1946 (15 USC 1067)?

17. If the answer to Interrogatory 16 is in the affirmative, identify each such case and indicate the disposition thereof.

18. On what date, if at all, did Edward J. Brenner first see plaintiff's Petition to the Commissioner of Patents, in person, in Cancellation 8,738?

18a. Did Edward J. Brenner take any action whatever on plaintiff's Petition to the Commissioner of Patents, in person, in Cancellation 8,738?

18b. If the answer to Interrogatory 18a is in the affirmative, state what action he took, identify each and every written or oral action taken and specify the respective dates of each such action.

19. Did Edward J. Brenner authorize or direct Edwin L. Reynolds to render a decision on plaintiff's petition to the Commissioner of Patents, in person, in Cancellation 8,738?

19a. If the answer to Interrogatory 19 is in the affirmative, state the wording of such authorization or direction and state where it may be inspected and a copy thereof made.

20. Under what authority did defendant, Edwin L. Reynolds, act on plaintiff's Petition to the Commissioner of Patents, in person, in Cancellation 8,738, on February 16, 1967?

21. Has defendant, Edwin L. Reynolds, acted on any petition to the Commission of Patents under Trademark Rule 2.146, other than the petition in Cancellation 8,738?

21a. If the answer to Interrogatory 21 is in the affirmative, state whether or not his authority to act on such petitions was delegated to him by the Commissioner of Patents.

21b. If the answer to Interrogatory 21a is in the affirmative, state the statutory authority for the delegation of such authority to him by the Commissioner of Patents.

21c. If the answer to Interrogatory 21 is in the affirmative, state the number of cases in which such petitions were denied, in whole or in part.

21d. If the answer to Interrogatory 21 is in the affirmative, state the number of cases in which such petitions were granted.

22. Did defendants deny plaintiff's request for an oral hearing on plaintiff's Petition to The Commissioner of Patents, in person?

23. Does defendant, Edwin L. Reynolds, in his capacity as First Assistant Commissioner of Patents, have supervisory authority over the Trademark Trial and Appeal Board or the members thereof?

24. Have the defendants, or either of them, ever received any written or oral communication from Weather-Rite Sportswear Co., Inc., or any of its officers, agents, employees, or attorneys other than or in addition to the communications of record in Application Serial No. 172,441, filed July 3, 1963, and this Cancellation 8,738?

24a. If the answer to Interrogatory 24 is in the affirmative, what was the date of each such communication?

24b. If the answer to Interrogatory 24 is in the affirmative, from whom did defendants, or either of them, receive such communication?

24c. If the answer to Interrogatory 24 is in the affirmative, state where and in whose custody is each such com-

munication, if written, or each memorandum thereof, if oral.

25. Did Application Serial No. 172,441 comply with all requirements of the statutes and rules prerequisite to issuance of a registration thereon at the time it was published in the Official Gazette on May 12, 1964?

25a. If the answer to Interrogatory 25 is in the negative, state whether or not any lack of compliance was corrected after May 12, 1964.

25b. If the answer to Interrogatory 25 is in the negative, state whether or not any lack of compliance was corrected after May 12, 1964.

25c. If the answer to Interrogatory 25b is in the affirmative, state whether or not the mark was published for opposition in the Official Gazette pursuant to Sections 12(a) and 13 of the Trademark Act of 1946.

25d. If the answer to Interrogatory 25c is in the negative, state the basis upon which the Commissioner of Patents acted in failing to publish the mark for opposition after the lack of compliance was corrected.

26. Was Application Serial No. 172,441 ever published in the Official Gazette for opposition anytime other than on May 12, 1964?

27. Did a registration ever issue under Registration No. 780,649?

28. Did the defendants, or either of them, or anyone acting under their authority, refuse to withhold issuance of a registration on Application Serial No. 172,441 after being apprised of the fact that a civil action was then pending in the United States District Court for the Southern District of New York between The Goodyear Tire & Rubber Company and the applicant, Weather-Rite Sportswear Co., Inc.?

28a. If the answer to Interrogatory 28 is in the affirmative, why were proceedings on the application not suspended pending the outcome of the civil action?

29. Did the Commissioner of Patents issue a registration to Weather-Rite Sportswear Co., Inc. on application Serial No. 172,441?

29a. If the answer to Interrogatory 29 is in the affirmative, state the number of the registration and the date of issue.

30. Did a registration issue under Registration No. 811,725?

31. On what date was Registration 811,725 first subject to cancellation under Section 14 of the Trademark Act of 1946?

32. On what date did defendants receive the petition of plaintiff to cancel Registration 811,725 pursuant to Section 14 of the Trademark Act of 1946?

33. Is the registration sought to be cancelled in Cancellation 8,738 involved in Civil Action 65C476, pending in the United States District Court for the Southern District of New York between The Goodyear Tire & Rubber Company and Weather-Rite Sportswear Co., Inc.?

33a. If the answer to Interrogatory 33 is in the affirmative, identify the pleading or other basis upon which defendants will rely to establish that such registration is involved in the aforesaid civil action.

34. Did Mr. Roeming, on behalf of the Commissioner of Patents in Civil Action 2894-64, in this Court on December 11, 1964, represent to the Court that "... if this Court should dismiss this complaint, the plaintiff can just, by the asking, find out on what day the registration of Weather-Rite would be issued and it would be possible for him to file a petition to cancel it on the very day it was issued ..." and that "... he clearly has his remedy by petition

to cancel" and that "the complaint should clearly be dismissed as to Prayer A"?

35. Did Mr. Roeming, on behalf of the Commissioner of Patents in Civil Action 2894-64, in this Court on December 11, 1964, represent to the Court that Congress provided a remedy for plaintiff in this situation under Section 14 of the Trademark Act of 1946?

36. Did either defendant authorize Mr. Roeming to state before the United States District Court for the District of Columbia in Civil Action 2894-64 on December 11, 1964 that plaintiff "... clearly has his remedy by petition to cancel ..." the registration which was about to be issued by the Commissioner of Patents on Application Serial No. 172,441?

37. Did the United States District Court for the District of Columbia hold, in an opinion filed February 23, 1965 in Civil Action 2894-64 between The Goodyear Tire & Rubber Company and The Commissioner of Patents that the plaintiff still has open to it the remedy of having the registration to be issued on Application Serial No. 172,441 cancelled by the Patent Office after registration?

38. Did the Patent Office remit plaintiff to a remedy under Section 14 of the Trademark Act of 1946 (15 U.S.C. Sec. 1064) for cancellation of Registration No. 811,725, as held by the United States Court of Appeals for the District of Columbia Court on December 29, 1965 in Appeal No. 19276?

39. Do the defendants have a duty under Section 14 of the Trademark Act of 1946 to conduct cancellation proceedings?

40. Are defendants conducting cancellation proceedings under Section 14 of the Trademark Act of 1946 at this time with respect to Registration No. 811,725?

40a. If the answer to Interrogatory 40 is in the affirmative, state whether or not plaintiff is entitled to take any action in such cancellation proceeding at this time.

40b. If there is any action which plaintiff can take at this time in such cancellation proceeding, state the nature of such action.

40c. If the answer to Interrogatory 40 is in the negative, state the date on which defendants will conduct such cancellation proceeding.

41. Has the Commissioner of Patents furnished status copies of Registration 811,725 to anyone since July 28, 1966?

41a. If the answer to Interrogatory 41 is in the affirmative, did such copies include a reference to the fact that such registration is the subject of pending Cancellation 8,738?

42. Have the defendants received any communication, either orally or in writing, from the Bureau of Customs with respect to Registration 811,725?

42a. If the answer to Interrogatory 42 is in the affirmative, identify each such communication by date and the parties between whom such communications passed and state where such communications or memoranda thereof may be inspected and copied.

42b. If the answer to Interrogatory 42 is in the affirmative, was the Bureau of Customs informed of the existence of Cancellation 8,738 against Registration 811,725?

42c. Has Registration 811,725 been recorded with the Bureau of Customs under Section 42 of the Trademark Act of 1946?

42d. If the answer to Interrogatory 42c is in the affirmative, state whether the Bureau of Customs will be informed of cancellation of Registration 811,725 by the Commis-

sioner of Patents if the registration is ordered cancelled in Cancellation 8,738.

43. Was a copy of defendants' Answer to Complaint in the present action furnished Weather-Rite Sportswear Co., Inc. or their attorneys of record in Cancellation 8,738?

44. What is the authority for including Paper No. 12 in the Patent Office file of Registration 811,725?

45. Will the Commissioner of Patents be bound by the final decision in Civil Action 65C476 in the United States District Court for the Southern District of New York in any respect whatever?

46. If the answer to Interrogatory 45 is in the affirmative, state in what respect the Commissioner of Patents would be bound.

47. Does the Commissioner of Patents have any basis in fact or law upon which he could intervene in Civil Action 65C476 in the United States District Court for the Southern District of New York?

48. Has the Commissioner of Patents taken any steps to intervene in Civil Action 65C476 in the United States District Court for the Southern District of New York?

49. Has either of the defendants or anyone acting under their authority read any of the pleadings of record in Civil Action 65C476 in the United States District Court for the Southern District of New York?

49a. If the answer to Interrogatory 49 is in the affirmative, identify and quote each pleading which refers to Registration 811,725.

50. Do any of the pleadings in Civil Action 65C476 in the United States District Court for the Southern District of New York seek cancellation of Registration 811,725?

51. Would the final action by the Patent Office in Cancellation 8,738 be subject to judicial review in the United

States District Court for the Southern District of New York?

51a. If the answer to Interrogatory 51 is in the affirmative, would the Commissioner of Patents be a party to the action in which review is sought?

52. Does the Commissioner of Patents have the right to intervene in a civil action in which judicial review is sought of the final action of the Patent Office in a trademark cancellation proceeding conducted in accordance with Section 14 of the Trademark Act of 1946 (15 U.S.C. 1064)?

53. What "unnecessary work" on the part of the Patent Office is or would be avoided by suspending action in Cancellation 8,738 under the circumstances of this case?

54. Did defendants or any person acting under their authority refuse on February 20, 1967 to suspend ex parte proceedings in Application Serial No. 226,675 upon request of the applicant pending the outcome of ancillary concurrent use proceedings?

Respectfully,

THE GOODYEAR TIRE & RUBBER COMPANY

By FRANCIS C. BROWNE

Counsel for Plaintiff

[Filed September 11, 1967]

Opposition to and Motion to Strike Interrogatories

Now comes defendants Edward J. Brenner, Commissioner of Patents, and Edwin L. Reynolds, First Assistant Commissioner of patents, and in accordance with the provisions of Rule 33 of the Rules of Civil Procedure, object to and move to strike all of the interrogatories contained in Plaintiff's First Set of Interrogatories To Defendants,

served on defendants' attorney on August 30, 1967, for the reasons set forth in the accompanying Points and Authorities.

An oral hearing is requested.

JOSEPH SCHIMMEL
Solicitor

September 11, 1967

POINTS AND AUTHORITIES

1. This action was brought by plaintiff under the Administrative Procedure Act to compel defendants to resume proceedings in a trademark cancellation matter, instituted by plaintiff against a registrant. Plaintiff and said registrant are parties to a federal court suit involving questions relevant to the cancellation proceeding in the Patent Office. Therefore, the registrant asked defendants to suspend that proceeding pending final determination of the court suit. That request was granted, for reasons fully stated in the record of the cancellation proceeding.

2. Plaintiff, as a party to the indicated cancellation proceeding, is fully informed of the reasons for suspension. *There simply is no need to elicit any further facts.* The nature of the present suit is one for review of the record in the cancellation proceeding, as though on appeal. *Winkler v. Ladd*, Comr. Pats., 221 F.Supp. 550, 138 USPQ 666 (aff'd. 143 USPQ 172).

3. For the most part the interrogatories are unreasonably burdensome, oppressive, immaterial, irrelevant and pointless, since plaintiff already possesses much of the information and the remainder would clearly be irrelevant. The listing is tedious, but the following will serve as examples. Interrogatory 50 asks if any of the pleadings in the previously indicated suit "seek cancellation of Registra-

tion \$11,725." Plaintiff, as a party to that suit, already knows the answer, whereas defendants do not have all the pleadings therein, not being a party therein. Then there is interrogatory 30, asking whether that same registration issued. Plaintiff knows that it did, having brought the previously mentioned cancellation proceedings there-against. Interrogatories 34-38 pertain to a prior suit by plaintiff against the Commissioner of Patents, wholly irrelevant to the present action. In interrogatory 54, plaintiff asks whether or not a given action was taken in another unrelated matter, in no way relevant here. Moreover, certain interrogatories, such as 21c and d, would entail much research to no point whatever.

4. In view of the foregoing, defendants can only conclude that plaintiff is deliberately attempting to harass them, to the detriment of others having business before the Patent Office. Of course, should plaintiff show that certain information not already known to it is relevant, defendants stand ready to answer appropriate interrogatories. Rule 33 does not sanction pointless quizzing of a party, particularly an executive head of a federal agency, and "only after the interrogatories have been found to be relevant should the court order them to be answered," *Greene v. Raymond*, (DC Colo., 1966) 41 F.R.D. 11.

JOSEPH SCHIMMEL
Solicitor

September 11, 1967

[Filed September 20, 1967]

Motion for Leave to Amend Answer

The defendants, Edward J. Brenner, Commissioner of Patents, and Edwin L. Reynolds, First Assistant Commissioner of Patents, move, under Rule 15(a) of the Federal Rules of Civil Procedure, for permission to amend the

Answer by substituting for the correspondingly numbered and "FURTHER ANSWERING" paragraphs thereof the following:

4. Except for admitting that this action is brought under 5 U.S.C. 701-706 "to compel defendants to conduct proceedings in Trademark Cancellation 8,738," corresponding to Prayers A and C only, defendants deny all other allegations of this paragraph, for reasons hereinafter given.

5. Defendants admit that this court has jurisdiction over the subject matter represented by Prayers A and C under 5 U.S.C. 701-706, but otherwise defendants deny the allegations of this paragraph. Defendants specially deny any jurisdiction in this court as to Prayer B under 5 U.S.C. 701-706, for lack of any final agency action with regard thereto and also because the particular composition of a Trademark Trial and Appeal Board is committed to agency discretion by law.

6. Defendants admit the allegation of this paragraph.

.

13. Defendants admit that on October 12, 1966, Weather-Rite Sportswear Co., Inc. filed a motion in the Patent Office, having served a copy on plaintiff, for certain relief specified on the first page thereof, a copy of said page being attached hereto as Exhibit A, but otherwise defendants deny the allegations of this paragraph.

14-22. Defendants admit the allegations of these paragraphs of the complaint.

23. Defendants admit that on February 16, 1967, defendant Reynolds, sub nomine Commissioner of Patents, denied plaintiff's petition to the Commissioner of Patents in person, except for the request that the Commissioner serve on the particular board to consider the involved cancellation proceeding which was held to be "moot at the present time," while refusing to hold an oral hearing, while exercis-

ing supervisory authority in the sense of review, and while stating that the suspension of the cancellation proceeding "does not deny the petitioner's right to maintain the present proceeding" and that "at the most it merely delays the decision somewhat in the interest of avoiding unnecessary work by the parties and the Patent Office." In all other respects, however, defendants deny the allegations of this paragraph of the complaint.

24. Defendants deny the allegations of this paragraph of the complaint, inasmuch as the indicated action by the trademark examiner in Trademark Application Serial No. 226,675 was the only inconsistent action, not the action of defendants complained of here. This is evident from the fact that the trademark examiner did suspend proceedings in Trademark Application Serial No. 226,675 a month later after plaintiff's attorney had argued that "[t]he action of the Examiner in refusing to suspend *ex parte* proceedings in the present application is utterly inconsistent with the cases relied upon by the Trademark Trial and Appeal Board and the Commissioner of Patents (speaking through the First Assistant Commissioner of Patents) in suspending *inter partes* proceedings in Cancellation 8,738, *The Good-year Tire & Rubber Company v. Weather-Rite Sportswear Co., Inc.*." This, of course, resulted in wholly consistent suspensions in the two proceedings.

. . . .

FURTHER ANSWERING, defendants deny that plaintiff is entitled to an order of this Court directing immediate resumption of proceedings in Trademark Cancellation 8,738, as requested in Prayer A of the complaint, or an order directing defendants to decide, as members of the Trademark Trial and Appeal Board, the right of registrant to retain registration 811,725, as requested in Prayer B, or an order directing defendants to refrain from further suspension of proceedings in Cancellation 8,738 in the absence of a stipulation of the parties or order of the court, for

the reasons given and in view of the authorities cited and relied upon by the member of the Trademark Trial and Appeal Board in his decisions of December 9, 1966 and January 19, 1967, and by the First Assistant Commissioner in his decision of February 16, 1967, copies of said decisions being attached hereto as Exhibits B, C and D, respectively.

Should any hearing be necessary, defendants request that it coincide with that for their recently opposed "Opposition To and Motion To Strike Interrogatories."

Respectfully submitted,

JOSEPH SCHIMMEL

*Solicitor, U. S. Patent Office,
Attorney for Defendant*

September 20, 1967

POINTS AND AUTHORITIES IN SUPPORT OF
DEFENDANTS' MOTION FOR LEAVE
TO AMEND ANSWER

1. Rule 15(a) states that leave to amend a pleading "shall be freely given when justice so requires." The need for amending defendants' answer has only recently been realized, in the course of considering interrogatories served on defendants August 30, 1967. The only answers which would be changed in substance are 4, 5, 13, 23 and 24. The specific nature of those changes is explained in the following points. Also, copies of pertinent papers would be added as exhibits, as permitted by Rule 12(c).

2. The changes in answers 4 and 5 reflect defendants' present view inadvertently omitted from the original answer that the Court lacks jurisdiction where prayer B is concerned. As is evident from the paragraph beginning at the bottom of page 2 of Exhibit D, there has been no final refusal by the agency to include defendant Brenner as a member of the board to eventually consider plaintiff's

Cancellation proceeding. Also, plaintiff had never requested the agency to appoint defendant Reynolds to serve on such a board. Hence, there has been no final agency action where prayer B is concerned. Moreover, the composition of any particular board is wholly discretionary with the Patent Office. Therefore, there can be no jurisdiction in this court as to Prayer B under 5 U.S.C. 701-706, which in pertinent part only sanctions review of "final agency action" (Section 704) and exempts agency action "committed to agency discretion by law" (Section 701 [a] 2). As for 28 U.S.C. 1361, this section conferring federal jurisdiction in mandamus action against federal officers extends to district courts mandamus jurisdiction formerly exercised only by District of Columbia courts, and did not make any substantive change in law or extend scope of mandamus relief. *Commonwealth of Mass. v. Connor*, D.C. Mass. 1966, 248 F. Supp. 656; *Sprague Electric Co. v. Tax Court of U.S.*, D.C. Mass. 1964, 230 F. Supp. 779, *affd.* 340 F.2d 947.

3. The change in answer 13 is occasioned by the fact that Weather-Rite, the registrant in the cancellation proceeding instituted by plaintiff, did request the Patent Office to suspend that proceeding "pending the determination of the action," viz. "Civil Action 65 C 476" This is evident from part (b) on the first page of its motion (Exhibit A). Weather-Rite did not request suspension "pending determination of the opposition" as alleged by plaintiff.

4. The change in answer 23 is in line with those for answers 4 and 5, already discussed in point 2.

5. The change in answer 24 is to point out the half-truth of plaintiff's narrow allegation, by calling the Court's attention to the fact that the trademark examiner eventually suspended proceedings in that matter after plaintiff's attorney relied upon the suspension of cancellation proceeding involved here as a precedent. The ultimate suspension of both proceedings is wholly consistent.

6. The "Further Answering" paragraph of the answer is changed to include copies of the three decisions referred to, as exhibits permitted by Rule 12(c). Such copies were only proffered in the original answer. There is no change in substance.

JOSEPH SCHIMMEL
Solicitor, U. S. Patent Office
Attorney for Defendant

September 20, 1967

EXHIBIT B

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

BOG/acj

PAPER No. 14

Cancellation No. 8,738

THE GOODYEAR TIRE & RUBBER COMPANY

v.

WEATHER-RITE SPORTSWEAR CO., INC.

The response filed November 16, 1966 by petitioner to the order to show cause why proceedings herein should not be suspended pending the outcome of a civil suit involving the parties in the United States District Court for the Southern District of New York is noted.

In arguing against suspension, petitioner urges that the registration here involved is not the subject matter of the civil suit; that the outcome of the civil action may therefore not necessarily obviate the trouble and expense of a cancellation proceeding in the Patent Office; that the suspension of proceedings herein would unfairly prolong respondent's use of the registration notice to both the public's and petitioner's detriment; and that the case of *Townley Clothes, Inc. v. Goldring, Inc.* 100 USPQ 57 (Comr., 1953); *Squirrel Brand Company v. Barnard Nut Co., Inc.* 101 USPQ 340

(Comr., 1954); and *A. E. Staley Manufacturing Company v. Staley Milling Company* 99 USPQ 175 (Comr., 1953), upon which the Trademark Trial and Appeal Board relies in suspending Patent Office proceedings where the parties are also involved in a civil suit, is not applicable for the reason that these cases were concerned with opposition proceedings whereas the instant case relates to a petition for cancellation.

Although, as indicated by petitioner, the civil suit is not concerned with the cancellation of respondent's registration here involved, the injunctive relief which petitioner is seeking therein in respect to respondent's use of the term "GOODYEAR" will unquestionably have a direct bearing on the question of respondent's right to maintain its registration of a composite mark which included said term as a salient feature thereof.

The fact that the cases upon which the Office relies relate to opposition proceedings whereas the instant situation involves a cancellation proceeding in no way invalidates the pertinency of these cases as a basis for suspension. The overriding consideration is that while a decision by the United States District Court will be binding on the Patent Office, a decision by the Trademark Trial and Appeal Board would be only advisory in nature in regard to the disposition of the cases pending in the District Court. As stated in the case of *Mills v. Greene* (159 U.S. 533):

"The duty of this Court as in every other judicial tribunal, is to decide actual controversy by a judgment which can be carried into effect, and not to give opinions upon moot questions of abstract propositions, or to declare principles or rules of law which cannot affect the matter in issue in the case before it."

In view of the foregoing, proceedings herein are suspended pending the final outcome of the civil suit between the parties in the United States District Court for the Southern District of New York. Not later than twenty

days thereafter, the instant case should be called up for appropriate action by the interested.

S. LEFKOWITZ
*Member, Trademark Trial and
 Appeal Board*

EXHIBIT A

IN THE UNITED STATES PATENT OFFICE
 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PAPER No. 7

Cancellation No. 8,738

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

WEATHER-RITE SPORTSWEAR Co., Inc., *Respondent*

Respondent, by its undersigned attorneys, hereby moves—

a.) To consolidate this cancellation proceedings with Opposition proceeding No. 44,248, entitled:

“THE GOODYEAR TIRE & RUBBER COMPANY, *Opposer*

v.

IRVING RAINCOAT Co., Inc., *Applicant*”

b.) To suspend the proceedings herein pending the determination of the action or, in the alternative, the completion of discovery proceedings in Civil Action 65 C 476 in the United States District Court in the Southern District, entitled:

“THE GOODYEAR TIRE & RUBBER COMPANY, *Plaintiff*

v.

WEATHER-RITE SPORTSWEAR Co., Inc., *Defendant*”

The grounds for said motion to consolidate the afore-

EXHIBIT C

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

Cancellation No. 8,738

THE GOODYEAR TIRE & RUBBER COMPANY

v.

WEATHER-RITE SPORTSWEAR CO., INC.

This case comes up on a petition filed December 19, 1966 by petitioner for reconsideration of the decision dated December 9, 1966 wherein proceedings herein were suspended pending final determination of a civil suit involving the parties in the United States District Court for the Southern District of New York. Respondent has filed a brief in opposition to the petition.

As grounds for reconsideration, petitioner reveals that respondent's Registration No. 811,725 has been recorded by the Bureau of Customs notwithstanding the pendency of the present cancellation proceeding in the Patent Office. Petitioner urges that it is prejudiced by suspension of this proceeding since a favorable decision herein would reverse the action taken by the Bureau. Petitioner also asserts that suspension of the instant proceeding contradicts a representation made by the Assistant Solicitor for the Patent Office that petitioner could have recourse to cancellation proceedings immediately upon issuance of the registration in question.

Inasmuch as petitioner has in fact filed a cancellation proceeding in the Patent Office, the representation made by the Assistant Solicitor has been fulfilled and the question of whether or not this cancellation proceeding should be suspended pending the outcome of the civil suit which petitioner has filed against respondent in no way traverses the representation.

The mere fact that the Bureau of Customs has recorded respondent's registration does not change, diminish, or vitiate the reason for suspending the administrative proceeding pending the outcome of the civil action. That is to say, the injunctive relief which petitioner is asking in the civil action will unquestionably affect respondent's right to the registration which the Board of Customs has recorded. In view thereof, and since as previously indicated, a decision by the United States District Court will be binding on the Patent Office whereas a decision by the Trademark Trial and Appeal Board would be only advisory in respect to the disposition of the civil suit, it is concluded that petitioner has failed to provide a proper basis for reconsideration of the decision to which it is directed. It may be noted at this point that petitioner is free to urge the District Court to expedite the prosecution of the civil suit.

The petition for reconsideration is accordingly denied.

S. LEFKOWITZ
*Member, Trademark Trial and
Appeal Board*

EXHIBIT D

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

February 16, 1967

Cancellation No. 8,738

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

WEATHER-RITE SPORTSWEAR Co., Inc., *Respondent*

By direction of the Commissioner, the petition filed in the above-identified proceeding and directed to him in person has been considered by the First Assistant Commis-

sioner. The petition requests an oral hearing but it is settled practice not to hold oral hearings on petitions and no sufficient reason appears for making an exception in the present case.

The petition arises out of the action of the Trademark Trial and Appeal Board in suspending proceedings in this case pending the outcome of a suit in the United States District Court for the Southern District of New York in which the same parties and similar issues are involved. The precedents and reasons for such action are set forth in the opinion of a member of the Board, dated December 9, 1966, and are considered to justify the action taken. The petitioner notes that the cited cases involved opposition proceedings whereas this is a cancellation proceeding, but the applicable principles are thought to be the same in both cases. There is no more reason why the Patent Office should independently decide an issue which is pending before a Federal Court in a cancellation than in an opposition.

It may be conceded that there is nothing which requires this Office to suspend proceedings in a situation such as is here involved, but there is certainly nothing to preclude such suspension, and it is in accordance with the practice which has been consistently followed in similar cases for many years. This practice, it may be noted, was recently approved by the United States District Court for the Southern District of New York in an opinion dated January 19, 1967 in *Tuvache v. Emilio Pucci Perfumes International, Inc., et al*, 65 Civ. 3730 in which the Court declined to suspend action pending determination of a related case by the Trademark Trial and Appeal Board and clearly indicated that the Court case should take precedence.

The petitioner emphasizes the fact that it was repeatedly stated in proceedings before the United States District Court for the District of Columbia that the petitioner could have a remedy by a proceeding to cancel the registration here involved. That, of course, is true, but no assurance

was or could properly have been given that such a proceeding would be expedited in any unusual way or that it would not be subject to the same conditions and procedure as other such cases. The action complained of here does not deny the petitioner's right to maintain the present proceeding; at the most it merely delays the decision somewhat in the interest of avoiding unnecessary work by the parties and the Patent Office.

The fact that Title 35, Sections 17 and 18, does not, in terms, authorize the suspension of a cancellation proceeding is not considered controlling here. The authority to suspend such proceedings in the interest of expediency and orderly conduct is inherent in the right to hold them at all. The statutes clearly leave the details of such matters to the discretion of the Commissioner.

In view of the above conclusion, the petitioner's request that the Commissioner designate himself a member of the panel hearing this case is moot at the present time. It does not appear, however, that the circumstances of this case are such as to require such a designation.

This entire case has been carefully reviewed in the light of the present petition but no such error has been found in the decision complained of as would justify supervisory action.

The petition is denied.

EDWIN L. REYNOLDS

First Assistant Commissioner

BROWNE, SCHUYLER & BEVERIDGE

1815 H Street, N. W.

Washington, D. C. 20006

WEATHER-RITE SPORTSWEAR Co., Inc.

5802 Third Avenue

Brooklyn, New York 11220

FRIEDMAN & GOODMAN

26 Court Street

Brooklyn, New York 11201

[Filed September 29, 1967]

Recommendation of Pretrial Examiner

Upon consideration of defendant's motion for leave to amend answer, and oral argument thereon, it is this 29th day of September, 1967,

RECOMMENDED that said motion be allowed and that the amendment to the answer contained in the motion be deemed to be the amendment to said answer.

JOHN H. FINN
Pretrial Examiner

[Filed October 3, 1967]

**Supplemental Points and Authorities in Support of Defendants'
"Opposition to and Motion to Strike Interrogatories"**

5. In line with original point 2, the Court's review should be limited to consideration of the written record in the suspended cancellation proceeding, thus obviating any proper roll for discovery here. The Supreme Court has cited the Administrative Procedure Act, particularly former section 1009 of Title 5 U.S.C., as a foremost example of "review limited to the administrative record," in *United States v. Bianchi & Co.*, 373 U.S. 709, 715-716. This is the very jurisdiction plaintiff pleads. [Note *Sikora v. Brenner, Comr. Pats.* (CA DC, May 8, 1967), 379 F2d 134, 153 USPQ 585, f.n. 3, where the Court explained that "5 U.S.C. §§ 702-04, as codified by Public Law 89-554, 80 Stat. 378, . . . , takes the place of what was formerly 5 U.S.C. § 1009."]. Also, as recognized in *Seagram et al. v. Dillon* (CA DC, 1965) 344 F.2d 497, "[t]he doctrine of 'exhaustion of administrative remedies' . . . encompasses the principle that a ruling of an administrative officer . . . will not be set aside by a court upon evidence which was not before that officer." Thus, plaintiff's interrogatories are not relevant to the subject matter of the action and cannot lead to the discovery of facts pertinent here, and

are therefore improper and objectionable as "irrelevant." See *Walled Lake Door Company v. United States*, (DC Mich, 1962) 31 F.R.D. 258, where the Court sustained objections by ICC as to production of documents as "irrelevant, since in reviewing an administrative order the Court must base its decision solely on the evidence in the record." The only interrogatories that might be warranted in this kind of action would be those directed to the procurement of simple facts to clarify or narrow the issues involved in the agency's decision, e.g., were reliance had therein on "long standing practice" of the agency, without any amplification. That is not the case here. However, should plaintiff demonstrate the need for any facts to clarify or narrow the issue, then defendants stand ready to answer appropriate relevant interrogatories, as indicated in original point 4.

While it is probably obvious, one further reason why review in this action should be limited to the administrative record merits consideration. In a real sense, the merit of registrant Weather-Rite's request for suspension of the Cancellation proceeding is to be reviewed in this action, although Weather-Rite is not a party to the present action. Should the Court grant either of plaintiff's Prayers A or C, Weather-Rite would be adversely affected. Hence, in fundamental fairness to Weather-Rite, the Court should not consider any evidence beyond that considered by defendants in suspending the Cancellation proceeding, as to which Weather-Rite has had an opportunity to state its position.

6. Defendants' suspension of plaintiff's Cancellation proceeding, at the request of the registrant Weather-Rite, is comparable to a judge's postponement of a trial, upon motion of a defendant. Where the administrative proceeding has the quality resembling that of a judicial proceeding, those responsible for the administrative determination should not be subjected to examination. *United States v. Morgan*, 313 U.S. 409, 422. "Just as a judge cannot be

subjected to such a scrutiny . . . so the integrity of the administrative process must be equally respected." Accordingly, plaintiff's interrogatories are improper here.

7. In *In Coca-Cola Company v. Dixie Cola Laboratories* (DC Md. 1939) 30 F. Supp. 273, 279, Judge Chestnut opined "that the number of interrogatories should be relatively few and related to the important facts of the case, rather than very numerous and concerned with relatively minor evidentiary details." He went on to say that "in general it may be observed that it will be only the exceptional case where more than fifteen or twenty interrogatories can conveniently and efficiently be submitted." and that "[w]here a more comprehensive examination of the adverse party is desired it should ordinarily be done by taking his deposition." Here, in an unexceptional case requiring no more than judicial review of a written record made in the Cancellation proceeding, plaintiff has submitted a "First" set of fifty-four interrogatories, not including subdivisions. As for oral depositions, a party should not be compelled to answer irrelevant questions, as held in *Ochsner et al. v. Millis* (CA 6th, Sept. 15, 1967) (Appeal No. 17526, F2d , 155 USPQ . Moreover, as stated by Judge Walsh of this Court in *The Union Saving Bank of Patchogue, New York. v. Saxon*, (D.C. D.C., 1962), 13 Ad. L. (2d) 112:

"Certainly, this Court does not encourage the procedure of taking the oral deposition of the head of an agency of the United States Government, and under normal circumstances would not allow such procedure. The Court recognizes that such an official's time and the exigencies of his everyday business would be severely impeded if any plaintiff filing a complaint against an agency head, in his official capacity, were allowed to take his oral deposition. Such procedure would be contrary to the public interest, plus the fact that ordinarily the head of an agency has little or no knowledge of the facts in the case."

The same reservation, it is submitted, should apply to plaintiff's interrogatories here.

Nevertheless in order to delineate defendants' position clearly particular objections to specific interrogatories are stated in the following points, wherein reference to any interrogatory includes any subdivisions thereof as well. 8. Interrogatories 1-5, 8, 12-15, 18-21 and 23, calculated to elicit information upon which plaintiff at most might hope to challenge the authority of defendant Reynolds in rendering the agency action complained of here, are clearly irrelevant. That authority cannot be questioned in this action. In paragraph 5 of its complaint, plaintiff alleged as a jurisdictional basis the pertinent part of the Administrative Procedure Act, 5 U.S.C. 701-706, and defendants admitted jurisdiction under 5 U.S.C. 704 as to Prayers A and C [see original answers 4 and 5 as well as proposed amended answers 4 and 5], the only prayers of any substance [see following point 9 as to remaining Prayer B]. However, an essential prerequisite for any jurisdiction under that Act is that the agency action complained of be *final*, as specified by 5 U.S.C. 104. Any questioning by plaintiff of defendants for the purpose of challenging defendant Reynolds' authority to render the agency action complained of could only impeach its finality, and hence the very jurisdiction plaintiff has pleaded. Consequently, these interrogatories are irrelevant and to force answers thereto would be pointless.

9. Interrogatories 6, 7, 16 and 17 only pertain to Prayer B, and therefore are irrelevant to the only real subject matter before this Court—viz, defendants' suspension of the Cancellation proceeding instituted by plaintiff. The Court has no jurisdiction where Prayer B is concerned, because there has been no final agency refusal to include defendants as members of the particular Trademark Trial and Appeal Board to eventually consider the merit of plaintiff's Cancellation petition, and also because the empaneling of any particular board is by law committed to

agency discretion. Attention is directed to the paragraph beginning at the bottom of page 2 of defendant Reynolds' decision of February 16, 1967 (Exhibit D, forming part of defendants' recent Motion For Leave To Amend Answer), where it was held that in view of suspension of the Cancellation proceeding "the petitioner's request that the Commissioner designate himself a member of the panel hearing this case is moot at the present time." As for inclusion of defendant Reynolds in that panel, plaintiff made no such request, apart from eliciting no final refusal. The fundamental need for finality of agency action is emphasized by recent Court of Appeals decisions, e.g.:

Sikora v. Brenner, Comr. Patents (CA DC, May 8, 1967) 379 F2d 134, 153 USPQ 585

Phillips Petroleum Co. v. Brenner, Comr. Patents (CA DC, June 29, 1967) F2d , 154 USPQ 211

No petitioner for cancellation of a trademark can be permitted to pick his own particular board, any more than plaintiff could demand that any particular judge hear this action. However, by Prayer B, plaintiff would enlist the aid of the court to achieve the former, in clear violation of the constitutional principle of separation of powers. Manifestly, plaintiff's Prayer B is a transparent sham, devoid of any substance. Consequently, the indicated interrogatories, pertaining only to service by defendants on prior boards and empaneling of a board for plaintiff's Cancellation petition, are irrelevant.

10. Interrogatories 9, 19 and 36 are barred by executive privileges, inasmuch as each inquires as to possible instructions from the head of an executive agency to subordinates. In *Kaiser Aluminum & Chemical Corp. v. United States* (Ct. Cl., 1958) 157 F. Supp. 939, the court sustained the Government's objection to disclosure of a document allegedly containing recommendations and advice on policy for use within the Government, indicating that a strong

public policy was involved in this claim of privilege—"the policy of open, frank discussion between subordinate and chief concerning administrative action." Also, in *Walled Lake Door Company v. U. S.*, (DC Mich., 1962) 31 F.R.D. 258, the court sustained the Government's objections to disclosure of documents and interrogatories on the basis of executive privilege, noting that "all of the internal workings of the agency are privileged, just as memoranda between a judge and his clerk," citing *United States v. Morgan*, 313 U.S. 409, 61 S. Ct. 999, 85 L. Ed. 1429.

11. Interrogatories 18, 22, 29, 30, 32, 33, 40, 49, 50, 53 and 54 require no answers since defendants have already provided plaintiff with the desired information. In *United States v. General Motors* (DC Ill. 1942) 2 F.R.D. 528, the Government asked "May interrogatories be used as a substitute for a bill of particulars, and may a party having voluntarily given specifications be required again to give them by interrogatories?" The Court replied "[t]he answer to both questions is no."

11a. Interrogatory 18 inquires about any action defendant Brenner may have taken concerning plaintiff's petition. However, defendants have admitted paragraph 22 of the complaint, which alleged that "the Commissioner of Patents, in person, did not consider plaintiff's petition" Therefore, this interrogatory requires no answer.

11b. Interrogatory 22 asks if defendants denied plaintiff's request for an oral hearing on its petition to the commissioner. However, defendants have admitted the allegation in paragraph 23 of the complaint which concerns defendant Reynolds' "refusing to hold an oral hearing." Obviously, this interrogatory requires no answer.

11c. Interrogatories 29 and 30 require no answer. These request information about the issuance of Registration 811,725, the very registration plaintiff seeks cancellation of in the Patent Office. However, defendants have admitted paragraph 7 of the complaint which alleges the fil-

ing by plaintiff "[o]n or about July 28, 1966" of its "verified petition to cancel United States Trademark Registration \$11.725, which issued July 26, 1966 to Weather-Rite Sportswear Co., Inc." The same admission embraces interrogatory 32 as well. As plaintiff well knows, the precise date of filing the cancellation petition was July 28, 1966, a matter of no material significance here.

11d. Interrogatory 33 inquires whether the "registration sought to be cancelled in Cancellation 8, 738," i.e. Registration \$11.725, is "involved in Civil Action 65C476," and what basis defendants might have for believing so. However, since defendants have admitted paragraph 17 of the complaint, which alleges recognition by the ruling member of the Trademark Trial and Appeal Board "that the civil suit is not concerned with the cancellation of respondent's registration here involved," answering this interrogatory is deemed unnecessary. Of course, defendants have no more of the pleadings in that suit than did the Board member then, whereas plaintiff is a party to that suit and therefore better informed. The position of defendants remains the same on that matter, and has been comprehensively stated by the ruling Board member in his decisions of December 9, 1966 and January 19, 1967, and by defendant Reynolds in his decision of February 16, 1967 (Exhibits B-D accompanying defendants' recent "Motion For Leave To Amend Answer"). Moreover, since these are essential components of the record which the Court will review, in accordance with 5 U.S.C. 706, final sentence, these facts will be before the Court.

11e. Interrogatories 49 and 50 are subordinate to 33 discussed above, and appear to have been included only for their nuisance value. The same objection applies.

11f. Interrogatory 40 is patently ridiculous, in view of the circumstances here. If defendants had resumed the Cancellation proceeding, plaintiff would have been notified and been made aware of that change, and this paper would be needless. The terms of the suspension are explained

at page 3 of the ruling Board member's decision of December 9, 1966 (Exhibit B accompanying defendants' "Motion For Leave To Amend Answer"). The only action plaintiff could presently properly take in the Cancellation proceeding would be a renewed petition to the Commissioner, provided significant *new* evidence or considerations are advanced bearing on the question of suspension. Of course, the registrant Weather-Rite would be entitled to state its position concerning any such renewed petition. That is the only proper way to amplify the record before this Court, not through discovery as here. The Court should bear in mind that any relief it might grant plaintiff would affect the registrant Weather-Rite, not a party to this action.

11g. Interrogatory 53 asks "what 'unnecessary work' on the part of the Office would be avoided by suspending action" in the Cancellation proceeding. This was explained by the ruling Board member in his decision of December 9, 1966 (Exhibit B accompanying defendants' "Motion For Leave To Amend Answer," particularly the first full paragraph on page 2 thereof). Moreover, it appears from the record of Cancellation proceeding 8,738 that many, if not all, of plaintiff's registrations, relied upon as a basis for seeking cancellation of Registration 811,725, are in turn subject to possible cancellation through counterclaim by Weather-Rite in Civil Action 65 C476. The possible saving of effort to the Patent Office should Weather-Rite succeed in that counterclaim is apparent. Moreover, that counterclaim affords a valid analogy to Trademark Rule 2.67(b), as a further reason justifying suspension of the Cancellation proceedings.

11h. Interrogatory 54 asks whether a certain action was taken on February 20, 1967 in a given application, wherein plaintiff's attorney represents another party. Defendants have already provided the solicited information, through the indicated action of the Trademark examiner on that date in that application. Also, additional commentary ap-

appears in defendants' proposed amended answer to paragraph 24 of the complaint, along with accompanying supporting point 5, in defendants' "Motion For Leave To Amend Answer." The action inquired of occurred on February 20, 1967, whereas defendant Reynolds' decision was mailed earlier on February 16, 1967. Hence, the information solicited here could not possibly form any part of the record of Cancellation S,738 subject to review here.

12. Interrogatories 10, 25, 31, 37-39, 44-47, 51, and 52 are clearly improper, in soliciting legal conclusions or opinions instead of facts. As stated by the Court in *United States v. General Motors* (DC Ill, 1942) 2 F.R.D. 528, "[i]t was never intended that a party should by interrogatories compel the adverse party to submit every item of evidence he expects to produce on the trial of the case [, n]or is a party expected in answer to interrogatories, to state his opinions on matters of law or fact." Interrogatory 25 is particularly unwarranted, since Weather-Rite (the owner of Application S.N. 172,441 which issued as Registration 511,725) is not a party here and plaintiff is fully informed of the position taken by the Patent Office concerning re-publication in S.N. 172,441, which plaintiff unsuccessfully sought in *Goodyear Tire & Rubber Co. v. Commissioner of Patents*, 238 F. Supp. 509, 144 USPQ 526; affd. 355 F. 2d 109, 148 USPQ 124; cert. denied 384 U.S. 941; 149 USPQ 906.

13. Interrogatory 11 is irrelevant, since the final clause excludes situations where any party consented to suspension. Here, the registrant specifically asked for the suspension (see Exhibit A accompanying defendant's "Motion For Leave To Amend Answer," particularly part b). However, it should be clear to plaintiff from the decisions of the ruling Board member and defendant Reynolds (Exhibits B-D accompanying that same motion) that no prior instances of suspending cancellation proceedings as such are relied upon. Hence, interrogatory 11 would be un-

warranted even if "one or more" did not appear in its final clause.

14. Parts *c* and *d* of Interrogatory 21 pose an unreasonable burden and would yield no relevant information, particularly since the solicited statistics would not be restricted to petitions from suspensions of cancellation and/or opposition proceedings. Apart from that, however, statistics could not be relevant, since every petition is decided on its individual merit.

15. Interrogatory 24 is unreasonable on its face, since it is not limited to communications pertaining to Cancellation 8,738, the only record that is relevant to this action. Indeed, the interrogatory extends to any and all communications from Weather-Rite, regardless of the business at hand. However, plaintiff may be assured that all communications from Weather-Rite pertaining to Cancellation 8,738 are of record therein.

16. Interrogatories 25-28 and 34-38 are irrelevant to the only real issue before this Court, viz, whether or not defendants' suspension of the Cancellation proceedings, at the specific request of the registrant, was warranted on the record in the Cancellation proceeding. These interrogatories merely relate to events prior to issuance of Registration 811,725, or to the merits thereof. Mr. Roeming's representations in this Court on behalf of the Commissioner of Patents in Civil Action 2894-64 (corresponding to the case cited in point 12) are matters of judicial record, well known to plaintiff. Moreover, plaintiff has already been apprised of defendants' position concerning those representations, as having no bearing on suspension of the Cancellation proceeding (see Exhibits C and D accompanying defendants' "Motion For Leave To Amend Answer," particularly the second and third paragraphs of Exhibit C, and the second paragraph on p. 2 of Exhibit D). Defendants therefore should not be compelled to repeat themselves needlessly (see authority cited in point 11). It might

be added, however, that when Mr. Roeming made such representations, plaintiff had not even filed Civil Action 65 C476 against Weather-Rite. The persistence of that suit and its issues, as represented to defendants in the record of the Cancellation proceeding, constitute the very basis for the suspension.

17. Interrogatories 41 and 42 are irrelevant, inasmuch as plaintiff has never so much as alleged that any of its imported goods have been impounded by the Bureau of Customs, or that its business has in any other way been interfered with, by reason of Registration 811,725 having been recorded with the Bureau of Customs under 15 U.S.C. 1124. The mere recording of that registration could not affect plaintiff adversely. Consequently, this line of questioning is clearly pointless. However, plaintiff should realize that the Patent Office plays no direct role in recording registrations with the Bureau of Customs (see 19 C.F.R. 11.15). Also, that recording would probably have entailed securement by the registrant Weather-Rite of a status copy, as provided for by Trademark Rule 2.6(a). It is evident from that rule that such a copy would not indicate the filing of a cancellation petition, as distinguished from actual cancellation.

18. Interrogatory 43 is clearly irrelevant, Weather-Rite not being a party to this action. Since the Court's review should be on the record made in the Cancellation proceeding, no point is seen in keeping Weather-Rite informed of developments herein.

19. Interrogatory 48 is clearly irrelevant. Moreover, if the Commissioner of Patents had taken actual steps to intervene in that suit, plaintiff, as a party thereto, would have been notified.

JOSEPH SCHIMMEL
Solicitor, U.S. Patent Office
Attorney for Defendants

**INDEX OF INTERROGATORIES COVERED
IN POINTS 8-19**

Interrogatory	Points	Interrogatory	Points
1	8	28	16
2	8	29	11c
3	8	30	11c
4	8	31	12
5	8	32	11c
6	9	33	11d
7	9	34	16
8	8	35	16
9	10	36	10, 16
10	12	37	12, 16
11	13	38	12, 16
12	8	39	12
13	8	40	11f
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15	8	42	17
16	9	43	18
17	9	44	12
18	8, 11a	45	12
19	8, 10	46	12
20	8	47	12
21	8, 14	48	19
22	11b	49	11e
23	8	50	11e
24	15	51	12
25	12, 16	52	12
26	16	53	11g
27	16	54	11h

[Filed October 24, 1967]

**Pretrial Examiner's Recommendation on Defendants'
Opposition to and Motion to Strike Interrogatories**

This action was brought by plaintiff under the Administrative Procedure Act to compel defendants to resume proceedings in a trademark cancellation matter, instituted by plaintiff against a registrant.

The following facts are agreed upon by the parties, as ascertained from the pleadings:

On July 28, 1966, the plaintiff filed in the U.S. Patent Office, pursuant to 15 U.S.C. 1064, a petition to cancel U.S. Trademark Registration S11,725, which was issued July 26, 1966, to Weather-Rite Sportswear Company, Inc. The petition was transmitted to the Trademark Trial and Appeal Board for a determination and decision as to whether or not Registration S11,725 should be cancelled.

On August 19, 1966, the Clerk of the Trademark Trial and Appeal Board instituted Cancellation 8,738. Weather-Rite responded to the Cancellation on September 28, 1966.

Subsequently, on October 12, 1966, Weather-Rite Sportswear Company, Inc. filed in the Patent Office and served on the plaintiff a copy of a motion to consolidate Cancellation 8,738 with an Opposition 44,248, *The Goodyear Tire and Rubber Company v. Irving Raincoat Company, Inc.*, and to suspend proceedings in the aforesaid Cancellation pending determination of the Opposition, or alternatively, completion of discovery proceedings in Civil Action 65C476, *The Goodyear Tire and Rubber Company v. Weather-Rite Sportswear Company, Inc.*, U.S.D.C., S.D.N.Y.

On December 9, 1966, a member of the Trademark Trial and Appeal Board suspended proceedings in Cancellation 8,738 "pending the final outcome" of the civil action between the parties in the U.S. District Court for the Southern District of New York "notwithstanding the fact that the Civil suit is not concerned with the cancellation of respondents' registration here involved".

Subsequently, on February 16, 1967, the defendant Reynolds, in the name of the Commissioner of Patents, denied plaintiff's petition seeking the exercise of the supervisory authority of the Commissioner of Patents over the Trademark Trial and Appeal Board, to compel and to resume and go forward with the cancellation proceedings, to desig-

nate himself as a member of the Trademark Trial and Appeal Board to hear and decide further matters in the proceedings, and to conduct an oral hearing on the plaintiff's petition, thereby refusing the plaintiff's requests and stating that the suspension of the Cancellation proceedings "does not deny the petitioner's right to maintain the present proceedings" and that "at the most it merely delays the decision somewhat in the interest of avoiding unnecessary work by the parties and the Patent Office."

Interrogatories were filed by the plaintiff on August 30, 1967, to be answered by defendants, who, on September 14, 1967, filed an opposition to and motion to strike interrogatories which is considered on the bases of the foregoing facts, the memoranda of counsel, their oral argument, and the entire record.

15 U.S.C. 1119 reads as follows:

"In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent Office, and shall be controlled thereby. July 5, 1946, c. 540 Title VI, § 37, 60 Stat. 440."

In essence, the plaintiff is seeking a review of what appears to be an interlocutory action on the part of the Patent Office. Since this action is obviously, by its very terms, not a final action, some doubt may be entertained as to whether, at this time, this Court has jurisdiction to entertain the action. Furthermore, doubt exists that, on such review, plaintiff would be entitled to go outside the record established in the Patent Office. But perhaps it could be argued that the interrogatories filed by the plain-

tiff seek to establish abuse of discretion or that the Patent Office has acted with finality. However, for reasons set out hereinbelow, it is the view of the Examiner that one need not go into this question in deciding the matter presented by defendants' motion now before the Court.

In the opinion of the Examiner, the present action fundamentally raises the question of whether or not the Commissioner of Patents exceeded his authority in suspending the Opposition proceedings in view of the pending New York litigation which, if concluded in favor of the plaintiff Goodyear, would give plaintiff complete relief by directing the Patent Office to cancel the subject registration, irrespective of any proceedings already, or to be, held in the Opposition in the U.S. Patent Office.

The Interrogatories filed inquire into the powers, duties and authority of, and operations in, the Office of the Commissioner of Patents with particular reference to the ruling of his office suspending proceedings because of the pendency of the New York District Court action.

It would appear that the United States District Court for the Southern District of New York, in the action there pending, can order the Patent Office to dismiss the Cancellation proceedings in favor of Weather-Rite if it determines that Weather-Rite is entitled to continue use of that trademark. Assuming this to be true, the Patent Office and the parties would be put to unnecessary expense, time and effort in continuing the Patent Office Cancellation proceedings since its determination is subject to modification by the decision to be rendered by the United States District Court for the Southern District of New York. See *Avon Shoe Co., Inc. v. David Crystal, Inc.*, 171 F. Supp. 293, U.S.D.C., S.D.N.Y., February 9, 1959.

This would be so even if the plaintiff in the New York case has not asked that Court for Cancellation. Thus it would seem that the pendency of the trademark litigation pending in the United States District Court for the South-

ern District of New York is sufficient ground for suspending proceedings in the United States Patent Office because that involves the same trademark which is contested in the Patent Office and thus involves ultimately the plaintiff's rights, if any, to the Cancellation sought in Trademark Cancellation 8738.

Therefore, at this time at least, the information sought by the plaintiff's interrogatories has no relevancy to the basic issue involved nor could it lead to information which would benefit plaintiff.

Therefore, it is RECOMMENDED, on this 24th day of October, 1967, that the defendants' opposition to, and motion to strike, interrogatories be sustained.

JOHN H. FINN
Pretrial Examiner

[Filed October 30, 1967]

Plaintiff's Objections to Recommendation of Pretrial Examiner on Defendants' Objections to and Motion to Strike Plaintiff's Interrogatories

The Pretrial Examiner has recommended that defendants' opposition to and motion to strike plaintiff's Interrogatories be sustained. Plaintiff objects to the recommendation of the Pretrial Examiner and prays that the Court overrule defendants' objections to plaintiff's Interrogatories and set a date by which defendants shall answer the Interrogatories.

The recitation of facts set forth in the Pretrial Examiner's recommendation is incomplete as to certain matters which are germane and essential to the merits of the case. The recitation not only omits all reference to representations made on behalf of the Commissioner of Patents in the antecedent civil action against the Commis-

sioner of Patents¹ but also omits all reference to the fact that, contrary to established (unreported and reported) precedents², proceedings were suspended in the cancellation over Goodyear's objection, while unresolved and undecided matters were in progress. Indeed, it completely ignores the fact that Weather-Rite did not move to suspend proceedings until after pretrial and discovery proceedings were initiated by Goodyear.

The recitation of facts does include the salient point that the civil suit between Goodyear and Weather-Rite does not concern the registration sought to be cancelled in the suspended cancellation proceeding in the Patent Office.

The Pretrial Examiner's recitation of the background glosses over the fact that Goodyear petitioned the Commissioner of Patents, in person, to exercise his supervisory authority over the Trademark Trial and Appeal Board and direct it to vacate its order suspending proceedings and to resume the cancellation and hear and decide it on its merits pursuant to the statutes and rules.³

The purpose of plaintiff's Interrogatories, among other things, is to ascertain the authority, if any, under which the First Assistant Commissioner of Patents acted on the petition addressed to the Commissioner of Patents, in person. Since the hearing on defendants' objections to the Interrogatories, counsel for plaintiff has caused an investigation to be made to determine from the Federal Register the extent to which, if any, the Secretary of Commerce assumed

¹ *The Goodyear Tire & Rubber Company v. The Commissioner of Patents*, 228 F. Supp. 511, *aff'd.* 355 F. 2d 109, 122 App. D.C. 398, 1966, wherein the Solicitor for the Patent Office represented to the Trial Court and the Court of Appeals that Goodyear would have remedy by way of cancellation of the registration, when issued, pursuant to Section 14 of the Trademark Act in lieu of the right to oppose issuance of the registration pursuant to Section 13 of the Trademark Act.

² *G. D. Searle v. A. H. Robins*, Opp. 41,125.

³ Certain other relief was also sought in the petition, but the principal relief sought was the resumption of proceedings.

functions of the Commissioner of Patents and the extent, if any, to which he delegated functions back to the Commissioner. As indicated in the attached Appendix A, the last reference found with respect to delegation of authority was that recited in Sections 3.01, 3.02, 3.02a, 5.01 and 5.04 of Department of Commerce Dept. Order 89-B as amended effective May 4, 1967 and published at 32 Fed. Reg. No. 95, pp. 7348 and 7349 dated May 17, 1967. Nowhere has any reference been found to the delegation by the Commissioner of Patents of the authority to the First Assistant Commissioner to act on petitions brought under Trademark Rule 2.146, albeit Rule 2.146(e) provides that such authority "may" be delegated.

Even if the authority to act on Goodyear's petition had been properly delegated to the First Assistant Commissioner, the essential facts pertaining to the inconsistency of the action of the First Assistant Commissioner in this case with actions taken in other cases must be developed to narrow the issues to be tried on the merits.

The Pretrial Examiner expressed the thought that suspension of an administrative proceeding by executive fiat over the objections of a party to the proceeding, "appears to be an interlocutory action" on the part of the agency. Not only does this observation go beyond the matter before the Pretrial Examiner, namely, a ruling on objections to Interrogatories, but also is premature since the Pretrial Examiner does not have all the facts of the case before him at this time. If, however, the defendants hold a similar view, the way is open for them to file a motion to dismiss on jurisdictional grounds.

What constitutes the "record" on which a case is to be tried under the Administrative Procedure Act and the matters which would be admissible in evidence at the trial on the merits are not determinable until the issues are defined. The present action is not ready for pretrial and is not likely to be ready until normal discovery procedures

are completed. Therefore, it is not the province of the Pretrial Examiner to prejudge the case on the merits, as he appears to have done on pages 4 and 5 of his recommendation.

It has been plaintiff's intention to bring on a Motion for Summary Judgment, at the appropriate time, and particularly after it is ascertained that there are no material facts in dispute. It is not feasible, however, to proceed in this manner if discovery of the relevant facts is thwarted by the defendants, not on the ground that the facts are not available but on the ground that they think the burden of determining the cancellation issue should be borne by the judiciary rather than by the administrative branch, as prescribed by statute.

Just to illustrate how ludicrous and inconsistent the defendants can be, the following is a description of the position taken by the Commissioner of Patents in another action where the Court *did* have a registration before it and the Patent Office, nevertheless, made the parties go through a cancellation proceeding in the Patent Office, *de novo*, after the Court action had terminated.

The District Court for the District of Maryland, in *Wembley, Inc. v. Diplomat Tie Company*, 216 F. Supp. 565 (1963) held that one of the trademark registrations of plaintiff "should have been denied" and that all that had been said applied with equal force to the second registration involved. The Court even went so far as to say that the "registration of plaintiff's marks was invalid". Nevertheless, the Court refused to "order the cancellation of [the] registrations" or to "rectify the Register with respect to the registrations" as provided in Title 15 U.S.C. 1119.

Thereafter, Diplomat Tie Company (the successful defendant) filed a petition in the Patent Office to cancel the registrations involved in the civil action. The Patent Office refused to dismiss the petition and cancellation proceeding

and insisted that proceedings go forward, notwithstanding the fact that the Court proceedings had become final and the question of validity of the registrations had been litigated "by consent".

In *Wembley, Inc. v. Commissioner of Patents*, 352 F. 2d 941 (1965), 122 U.S. App. D.C. 273, the Court of Appeals of this jurisdiction ruled that the action of the Commissioner of Patents in refusing to apply F.R.C.P. Rule 13(a) and dismiss the action was an interlocutory matter and therefore was not ripe for judicial review under the Administrative Procedure Act*.

Now, the Commissioner *suspends* proceedings in a pending cancellation on the *mere conjecture* that the action of the District Court for the Southern District of New York *may* render the cancellation moot, *even though registration to which the cancellation pertains has not been injected into the civil action by either party.*

The dilemma: Must Goodyear wait until the civil action in New York is concluded (even though the registration in question has not been injected into that case by either party) before it is entitled to due process before the Patent Office, as promised by the Solicitor in the antecedent civil action between Goodyear and the Commissioner, and as provided by Section 14 of the Trademark Act and as provided by the Commissioner's own rules?

BACK TO THE ISSUE BEFORE THE PRETRIAL EXAMINER

Having been forced, by the Pretrial Examiner's excursion into the question of jurisdiction and the merits of the action, to go so deeply into the substance of the matter, we now return to the questions before the Court:

* It will be noted that the District Court originally held in favor of Wembley but, on the motion of the Commissioner of Patents to vacate the judgment in favor of plaintiff, reversed itself and held for the Commissioner of Patents on the ground that the ruling of the Commissioner was interlocutory and that there was "no showing that injury would result from delaying judicial relief until such time as the entire proceeding of which the decision is a part can be concluded." 235 F. Supp. 704, 705.

1. Is the government (in the person of the Commissioner of Patents and the First Assistant Commissioner of Patents) immune from all discovery by way of written Interrogatories under the Federal Rules of Civil Procedure?

2. If the government is not immune, are Interrogatories proper if they are directed to:

a) The basis for the authority of the First Assistant Commissioner of Patents, in person, where such petition is filed in accordance with the Patent Office rules and there has been no published delegation of authority, as far as counsel has been able to determine;

b) The facts as to actions taken by the Patent Office in other cases involving the same issue, to determine whether the action in the present case is inconsistent, arbitrary, capricious, contrary to statute or rule, or otherwise without reasonable basis.

c) The *facts* (as distinguished from subjective judgment or department or agency policy) upon which the Patent Office acted in suspending the cancellation proceeding while discovery proceedings were in process in the cancellation according to the Patent Office rule when the suspension occurred.

d) The *facts* as to the representations made by the Solicitor on behalf of the Patent Office in the antecedent civil action to the effect that Goodyear could proceed with cancellation as soon as the registration issued.

e) The *facts* as to the representations made by the Solicitor on behalf of the Patent Office in the antecedent civil action in order that the arbitrariness and capriciousness of the action of the Patent Office in the present case may be established.

3. As the question of jurisdiction may be raised at any time, and has now been raised by the Pretrial Examiner, a ruling of the Court on that question at this time is re-

quested in order that the law of the case may be decided now rather than after lengthy proceedings and appeals. In this respect, the present case differs from *Wembley v. Commissioner, supra*, in that suspension of all proceedings is diametrically opposite from an interlocutory ruling which does not *stop* the administrative machinery in its tracks, leaving the aggrieved party without remedy to obtain the relief sought, namely cancellation of the registration by the only authority before whom the question of cancellation exists (or may ever exist).

CONCLUSION

If ever there was a situation where "justice delayed is justice denied", this is it. Goodyear has done everything lawful and proper to have its cause determined. It now stands frustrated by an agency which not only refuses to honor its commitment made in open Court but also refuses to follow the mandate of the trademark statute and its own rules of practice. The agency is acting without justification in fact, in law or common decency in its *refusal* to perform the duty which its officers duly swore they would perform.

An order of this Court compelling defendants to answer the Interrogatories will move the controversy closer to conclusion and, hopefully, shorten the pendency of what has already been proved to be too lengthy cavillacious encounter between plaintiff and the officials of the United States Patent Office over their failure or refusal to perform the duties with which they are charged by law.

Respectfully,

THE GOODYEAR TIRE & RUBBER COMPANY

By

Francis C. Browne

Counsel for Plaintiff

[Filed October 31, 1967]

Addendum to Plaintiff's Objections to Recommendation of Pre-trial Examiner on Defendants' Objections to Plaintiff's Interrogatories

Reference has been made in the third and fourth lines of page 3 of Plaintiff's Objections filed herein on October 30, 1967 to an Appendix A, which is a reproduction of Commerce Department Order 89-B, published in the Federal Register on May 17, 1967, effective May 4, 1967. The reproductions were inadvertently omitted from the paper previously filed and are submitted herewith for the convenience of the Court and defendants.

Inasmuch as the Court might, in any event, take judicial notice of the Federal Register publication of this Department Order, the addition of this reproduction at this time should not be objectionable.

There is also attached hereto for the convenience of the Court, and marked Appendix B, a copy of the sole opinion upon which the Pretrial Examiner bases his recommendation that defendants' objections to plaintiff's Interrogatories be sustained.

It will be observed that the case relied upon by the Pretrial Examiner was not cited or relied upon by either party in their memoranda, but apparently was drawn upon by the Pretrial Examiner as justification for his excursion into the merits of the case rather than confining his recommendation to the disposition of defendants' objections to the Interrogatories.

In the cited case (*loc. cit.* page 297, column 1, seventh full paragraph, subparagraph [2]), it is clear that the District Court had before it a prayer for relief under Title 15, United States Code, Section 1119 *by virtue of defendants' counterclaims*. This essential fact is *not* present in the pleadings in the civil action between Goodyear and Weather-Rite in New York. Neither is there any reference

in the Patent Office record to the civil litigation except the reference made thereto by Weather-Rite when it sought suspension of the cancellation.

The Pretrial Examiner goes far beyond the Avon Shoe case (Appendix B) and commits error in saying that the United States District Court for the Southern District of New York "can order the Patent Office to dismiss the cancellation proceedings in favor of Weather-Rite" and that the determination of the cancellation proceeding by the Patent Office "is subject to modification by the decision to be rendered by the United States District Court for the Southern District of New York."

The United States District Court for the Southern District of New York has nothing before it to even indicate that a cancellation proceeding has been instituted in the Patent Office or that the registration sought to be cancelled is even in existence. How, therefore, could that District Court possibly have cognizance or jurisdiction of proceedings in the Patent Office about which it knows nothing? Indeed, the Patent Office would be the first to object if the District Court, without basis in the pleadings and without opportunity to appear in that Court and be heard, ordered the Patent Office to do anything or refrain from doing anything.

The Patent Office insists that the Interrogatories propounded by plaintiff must be limited to matters on the Interrogatories propounded by plaintiff must be limited to matters on the record made in the cancellation. Yet the very action taken by the Patent Office which gives rise to the present suit is based on a matter outside the record of the cancellation, no reference to the pending civil action being present in the petition for cancellation or Weather-Rite's pleading in response thereto.

It therefore approaches absurdity for the Pretrial Examiner to hold that the District Court for the Southern District of New York could order the Patent Office to dis-

miss the pending (but suspended) cancellation proceeding *"even if the plaintiff in the New York case has not asked that Court for cancellation."** On the one hand, he questions the jurisdiction of this Court to entertain the present action, yet tries to confer jurisdiction on another Court to order a party not before it to do something with respect to a matter which is not even involved in or referred to in the litigation pending before it.

Plaintiff prays, therefore, that the defendants' objections to plaintiff's Interrogatories be overruled and, in the event the Court takes up the question of jurisdiction at this time or goes into the merits of the case, the law of the case regarding jurisdiction be settled and the defendants be advised or ordered to resume the cancellation proceeding without the necessity for further pretrial, discovery or interlocutory proceedings or full trial on the merits before this Court.

Respectfully,

THE GOODYEAR TIRE & RUBBER COMPANY

By

Francis C. Browne

Counsel for Plaintiff

* *Emphasis plaintiff's.*

APPENDIX A

DEPARTMENT OF COMMERCE
OFFICE OF THE SECRETARY

[Dept. Order 89-B]

PATENT OFFICE

ORGANIZATION AND FUNCTIONS

The following material supersedes the material appearing at 31 F.R. 6751-6752 of May 5, 1966; 31 F.R. 10702 of August 11, 1966; and 31 F.R. 15550 of December 9, 1966.

SECTION 1. *Purpose.* The purpose of this order is to prescribe the organization and assignment of functions within the Patent Office.

SEC. 2. *Organization structure.* The organization structure and line of authority of the Patent Office shall be as depicted in the attached organization chart.

SEC. 3. *Functions of the Office of the Commissioner.* .01. The Commissioner determines the policies and directs the programs of the Patent Office and is responsible for the conduct of all activities of the Patent Office.

.02. The Assistant Commissioners shall perform the duties pertaining to the Office of the Commissioner assigned to them by the Commissioner under his prior and continuing authority. Principal functions assigned to the Assistant Commissioner are:

a. The First Assistant Commissioner shall provide administrative and policy direction to the Office of the Solicitor, the Board of Appeals, the Board of Patent Interferences, the Trademark Trial and Appeal Board, and the Trademark Examining Operation.

b. An Assistant Commissioner shall provide administrative and policy direction to the Office of Patent Classification, Office of Patent Services, Office of Examining and

Classifying Control, and to each of three patent examining operations (Chemical, Electrical, and Mechanical).

c. An Assistant Commissioner shall provide administrative and policy direction to the Office of Information Services, the Office of Legislative Planning, and the Office of International Patent and Trademark Affairs.

.03. Administrative and policy direction of organization components of the Patent Office not delegated to an Assistant Commissioner in paragraph .02 of this section, is reserved in the Commissioner.

SEC 4. *Functions of offices reporting to the Commissioner* .01 The Office of Planning and Programing shall provide the principal assistance to the Commissioner in planning and developing the major programs of the Patent Office to accomplish its objectives and enhance its role and effectiveness in carrying out the purposes of the patent system; provide overall coordination of internal program planning in support of Office-wide objectives, preparing pertinent guidelines governing such effort including PPBS as well as immediate and extended range program stages; initiate and conduct or coordinate the conduct of special studies and analyses required for formulating, reviewing, and appraising program plans and projections of goals, making use of the Organization and Systems Analysis Division or other most appropriate available resources for this purpose.

.02 The Office of Internal Audit shall conduct a continuing program of independent, objective, and constructive comprehensive internal audits of the operating, administrative, and financial activities of the Patent Office to determine whether in the direction and execution of these activities they are being carried out effectively, efficiently, and economically and in conformance with applicable laws, administrative rules and regulations, operating procedures, policy, and sound administrative practice; report findings

and make appropriate recommendations for corrective action.

.03 The Office of Research, Development, and Analysis shall plan and conduct a comprehensive operations improvement program aimed at achieving maximum effectiveness in fulfilling the current and future objectives of the Patent Office. The responsibilities of this Office shall be carried out through the Office of the Director and the following Divisions:

a. The Research and Development Division shall identify areas of needed research, formulate approaches to research problems, conduct research (or monitor research carried out under contract), design and install experimental systems, new equipment, or other products of research, and evaluate their effectiveness after installation. Major research and development efforts are aimed at development of automated search and retrieval systems and more effective dissemination of stored information to Patent Office examiners, the patent profession, and the scientific community.

b. The Organization and Systems Analysis Division, a staff organization serving the entire Patent Office, shall provide analytical and system research for management in developing and implementing improvements in methods, procedures, systems, organization and corresponding functional alignment, and manpower and equipment utilization to resolve operational problems, achieve efficiency, economy, and effectiveness in operations, and strengthen management practices; develop information systems providing data for management in planning and programming future requirements, in exercising day-to-day operational control, and in measuring and evaluating the effectiveness of programs and policies; develop cost-benefit data and apply new system concepts; design and develop systems utilizing automatic data processing equipment; analyze and interpret systems data; and perform related activities and functions.

c. The Automatic Data Processing Division shall provide data processing services to other elements of the Patent Office. It shall be responsible for operation, support, and maintenance of all general purpose automatic data processing equipment except that which may be assigned to other elements for data collection or which is integral to process control systems of the Patent Office. Its functions shall also include writing and testing of computer programs, maintaining a comprehensive library of programs including those provided by other elements of the Office, developing special utility routines, and defining needs for new equipment or modification of existing units.

.04 The Office of Administration shall be responsible for overall Patent Office administrative functions. These functions shall be carried out, as indicated, in the following Division which constitute the Office of Administration:

a. Administrative Services Division shall provide Office-wide services including the procurement and supply of equipment, furnishings, and consumable items; the procurement of property and services through formally advertised and negotiated contracts; space and facilities management; communications; travel and transportation services; mail, messenger, and general correspondence services; procurement and supply of graphic services and administrative printing, including office forms and publications. This Division is also responsible for carrying out a comprehensive paper work management program in the Patent Office, embracing forms, reports, directives and records.

b. Budget and Finance Division and also provide staff assistance in the development, application and execution of budgetary and fiscal policies and programs; conduct accounting operations for revenue, trust funds, and the Patent Office appropriation; and administer payroll and related employee accounts.

c. Personnel Division shall administer activities relating to recruitment, placement, employee relations, training and

career development, incentive awards, performance rating, position classification and wage administration, group-management relations, and various employee benefit programs.

SEC. 5. Functions of offices reporting to the First Assistant Commissioner. .01 The Office of the Solicitor comprises the Solicitor, who is the chief legal Officer for the Patent Office and his professional associates. This Office shall handle all litigation to which the Commissioner is a party and provide all other required legal services including drafting of legislation and advice and assistance on legislative matters.

.02 The Board of Appeals shall conduct hearings and render decisions on appeals from adverse decisions of examiners rejecting claims in patent applications.

.03 The Board of Patent Interference shall conduct patent interference proceedings and make final determination in the Patent Office as to priority of invention. The Board, also, shall decide questions concerning property rights in inventions in the atomic energy and space fields brought before it under the provisions of 42 U.S.C. 2182 and 2457 (d) and (e).

.04 The Trademark Trial and Appeal Board shall be responsible for hearing and deciding adversary proceedings involving interfering applications, oppositions to registration, cancellation petitions, and concurrent use proceedings and for hearing and deciding appeals from final refusals of the trademark examiners to allow the registration of trademarks

.05 The Trademark Examining Operation shall be responsible for the classification and examination of applications for the registration of trademarks and service marks and the maintenance of the principal and supplemental register of trademarks.

Sec. 6. Functions of offices reporting to an Assistant Commissioner. .01 The Office of Examining and Classifying Control shall develop procedures and quality and quantity standards relating to the conduct of the examination function; evaluate examiner compliance with such standards; train new examiners in patent practice and procedure; formulate and provide general direction for implementing classification programs; and provide logistic support for documenting and effecting search file provisions.

.02 There are three Examining and classifying Operations, respectively stated: Chemical, Electrical, and Mechanical, each of which shall examine patent applications falling in its generic category and shall have technical responsibility for perfecting and updating the classification of patents within its cognizance, subject to overall plans and policies. An Examining Operation comprises an Office of the Director, including a division charged with the classification functions, and a number of examining groups, each representing a broad field of invention within a generic category and having jurisdiction over several examining subdivisions representing art groupings.

.03 The Office of Patent Services shall review incoming applications for compliance as to form, assign applications to appropriate examining units, issue patent grants, record instruments transferring property rights in patents and trademarks, provide drafting services, furnish copies of patents and office records, maintain a search room for public use in searching and examining patents, coordinate the mailing of examiner's actions and cited reference matter, and maintain a Scientific Library to provide pertinent technical and scientific information to patent and trademark examiners and for public reference.

Sec. 7. Functions of offices reporting to an assistant commissioner. .01 The Office of Information Services shall advise and represent the Commissioner on information matters; conduct programs fostering public understanding

of the American patent system and the functions, services and publications of the Patent Office; develop publication policies; provide direction and assistance in developing new and revised publications; and assure conformity with policies, regulations, and standards concerning publications and publication practices.

.02 The Office of Legislative Planning shall make studies and advise the Commissioner on matters which may require legislative action and, in cooperation with the Office of the Solicitor, shall plan and conduct the legislative program of the Patent Office under applicable Department and Administrative Orders.

.03 The Office of International Patent and Trademark Affairs shall make policies and advise on policy and action concerning international patent and trademark matters.

Effective date: May 4, 1967.

DAVID R. BALDWIN,
*Assistant Secretary for
Administration.*

[F. R. Doc. 67-5458; Filed, May 16, 1967; 8:45 a.m.]

[Filed November 8, 1967]

**Defendants' Answer to Plaintiff's Objections and Addendum to
Recommendation of Pretrial Examiner on Defendants' Ob-
jections to Plaintiff's Interrogatories**

The Pretrial Examiner has recommended that defendants' opposition to and motion to strike plaintiff's interrogatories be sustained. Defendants submit that the Pretrial Examiner's recommendation is sound in law, that it should be adopted, and that plaintiff's objections thereto should be overruled.

After summarizing the nature of this action and the underlying history of plaintiff's suspended trademark cancellation proceeding in the Patent Office, the Pretrial Examiner based his recommendation on the fact that the same trademark attacked by plaintiff in that proceeding is also involved in pending litigation between plaintiff and the registrant in the United States District Court for the Southern District of New York, which court has ample authority under 15 U.S.C. 1119 to "order the cancellation of registrations, . . . and otherwise rectify the register with respect to the registrations of any party to the action." As noted, "the Patent Office and the parties would be put to unnecessary expense, time and effort in continuing the Patent Office Cancellation proceedings since its determination is subject to modification by the decision to be rendered by the United States District Court for the Southern District of New York." Though this finding may go to the merits of the present action seeking resumption of the cancellation proceedings, it is nonetheless apt. The Pretrial Examiner concluded that "at this time at least, the information sought by the plaintiff's interrogatories has no relevancy to the basic issue involved nor could it lead to information which would benefit plaintiff."

The mark involved in plaintiff's Cancellation proceeding is "GOODYEAR DELUXE BY WEATHERITE," covered by Registration 811, 725, issued on July 26, 1966 to Weather-Rite Sportswear Co., Inc. A copy of this registration is appended hereto as Exhibit A.

In asking the Patent Office to suspend plaintiff's Cancellation proceeding against the foregoing registration, the registrant submitted copies of the complaint and its answer thereto in Civil Action No. 65 Civ. 476 in the United States District Court for the Southern District of New York, captioned *THE GOODYEAR TIRE & RUBBER COMPANY v. WEATHERITE SPORTSWEAR CO., INC.* In that complaint, plaintiff alleged that defendant Weather-Rite had imported specified rubber goods so labeled as to include notations

such as "GOODYEAR DE LUXE By Weatherite" (Paragraph 13) and that Weather-Rite "had falsely represented by using an encircled letter 'R' in connection with 'GOODYEAR DE LUXE By Weatherite' that such notation is or was registered as a trademark in the United States Patent Office" (Paragraph 24). As part of the relief sought, plaintiff prayed for a permanent injunction against Weather-Rite "From using GOODYEAR in any manner whatsoever . . . in the manufacture, advertising, sale, labelling, or other identification of goods not of Plaintiff's manufacture" (Prayer I-c). In its answer, Weather-Rite summarized its efforts as of then to register the mark "Goodyear Deluxe by Weatherite," as well as frustrations thereof attributable to plaintiff (paragraphs 50, 52-56, and 59-62). Weather-Rite pleaded "jurisdiction for a declaratory judgment and for an order directing the rectification of the Trademark Register of the Patent Office [arising] under Title 28 U.S.C. 2201 and the Trademark Act of 1946, 15 U.S.C. 1119 and 1121" (paragraph 69). Further, Weather-Rite counter-claimed for cancellation of at least twenty of plaintiff's registered trademarks, "and that the Trademark Register of the Patent Office be rectified accordingly" (paragraph 93, prayer C). Hence, it is evident that jurisdiction under 15 U.S.C. 1119 has been invoked in the noted suit, and that Weather-Rite's mark "Goodyear Deluxe by Weatherite" is involved therein.

Under Section 37 of the Lanham Trademark Act (15 U.S.C. 1119), "all questions in respect to a registered trademark may be determined in one proceeding, thus preventing vexatious and harassing litigation as well as saving time, expense and inconvenience to the parties and to the courts and Patent Office tribunals." *Simmonds Aero-accessories, Ltd. v. Elastic Stop Nut Corporation of America* (CA 3, 1958), 257 F.2d 485, 491; 118 USPQ 187, 191. As specified by that section, "[d]ecrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent

Office, and shall be controlled thereby." The Commissioner is not a necessary or proper party, but is nonetheless, by the express language of the statute, governed by the court's ruling under this section. *Avon Shoe Co. v. David Crystal, Inc.*, 171 F. Supp. 293, cited by the Pretrial Examiner, clearly illustrates this statutory authority. There, in Conclusion of Law XI, the Court entered judgment directing "the Commissioner of Patents (in accordance with the provisions of 15 U.S.C.A. § 1119) to dismiss and dissolve the pending opposition of plaintiff Avon Shoe Co., Inc. to the registration of the mark 'Haymaker' for items of women's sportswear and to issue registration to defendant Haymaker Sports, Inc. of said mark" (Plaintiff's Addendum . . . Ex. B, Final page). As correctly noted by the Pretrial Examiner, "the United States District Court for the Southern District of New York, in the action there pending, can order the Patent Office to dismiss the Cancellation proceedings in favor of Weather-Rite if it determines that Weather-Rite is entitled to continue use of that trademark." Alternatively, should that court rule for plaintiff, its judgment could direct the Commissioner to cancel the subject registration.

In view of the foregoing, it is clear that plaintiff had the right and might reasonably have been expected to exercise that right to seek cancellation of Weather-Rite's registration in the already pending civil action in New York upon issuance of that registration. Instead, plaintiff sought cancellation thereof in the Patent Office under 15 U.S.C. 1064, thereby opening up a needless second front against Weather-Rite. In line with its pretense that action in the administrative agency is the only avenue open to it for seeking cancellation of Weather-Rite's registration, plaintiff contends that "[t]he United States District Court for the Southern District of New York has nothing before it to even indicate that . . . the registration sought to be cancelled is even in existence." If so, then the question reasonably arises as to why plaintiff did not apprise

that court of the registration, since the trademark is certainly involved in the pending suit. Having failed to acquaint that court with that important fact, plaintiff's request for equitable relief from this court appears tainted by the withholding from another court of pertinent information.

In suspending plaintiff's Cancellation proceeding at the request of the registrant Weather-Rite, the Patent Office deferred to the broader jurisdiction of the District Court in New York, and might be said to have anticipated an injunction thereby against plaintiff's prosecution of its Cancellation proceeding. In *Dwinell-Wright Co. v. National Fruit Product Co., Inc.* (CA 1, 1942), 129 F.2d 848, the court affirmed an order enjoining a defendant in a trademark infringement action from prosecuting a later-filed Cancellation proceeding against plaintiff's registration in the Patent Office, notwithstanding the Commissioner's refusal to suspend that proceeding on plaintiff's motion. While the Cancellation proceedings had initially been suspended by the an examiner at the request of plaintiff-registrant, "the defendant petitioned that the Commissioner of Patents . . . vacate the stay of proceedings granted by the latter," and "[t]his petition was granted and the Assistant Commissioner of Patents . . . overruled and vacated the order staying the cancellation proceedings." The Commissioner's refusal to stay proceedings was in turn effectively overruled by the court's injunction. "Neither party asked the district court for affirmative relief by way of cancellation of the other's trademark registrations under 15 U.S.C.A. § 102 [now 15 U.S.C. 1119]." After noting prior judicial condemnation of needless duplicative litigation, the appellate court said "[c]learly it is just as harassing and vexatious, and there is just as much waste and duplication of effort involved in twice trying the same issue between the same parties, whether the second trial is before an administrative tribunal or before a court" The common issue,

of course, was validity of a trademark registration. An essentially parallel situation obtains here between plaintiff and Weather-Rite.

The foregoing *Dwinell-Wright Co.* case also illustrates the fact that it is established practice in the Patent Office of long standing for an Assistant Commissioner to act for the Commissioner on petitions to the latter. The authority of the Assistant Commissioner to act on such petitions cannot be circumvented or challenged by petitioning to the Commissioner "in person." *Stapleton v. Duell*, (1901) 17 App. D.C. 575. There can be no serious question that defendant Reynolds, as First Assistant Commissioner, exercised properly delegated authority under 35 U.S.C. 3 in ruling on plaintiff's petition to the Commissioner "in person." His authority is reflected by Dept. Order 89-B, 31 F.R. 6751-6752, May 5, 1966 (copy attached as Exhibit B). Under Sec. 5.04 of that order, procedural rulings in Cancellation proceedings are reviewable by the First Assistant Commissioner on petition to the Commissioner. The effective date of that order revision was April 13, 1966, and no relevant change was effected therein through February 16, 1967, when defendant Reynolds ruled in the present matter. The revision noted by plaintiff (Addendum. . . , Ex. A) is comparable, but came afterwards.

The Pretrial Examiner's comments concerning the possible lack of finality of the agency action complained of, and also whether plaintiff would be entitled in this action to go beyond the record of the Cancellation proceeding by way of admissible evidence, did not serve as bases for his recommendation. Hence, no extended discussion is deemed necessary. Should this Court consider defendants' suspension of plaintiff's Cancellation proceeding to be interlocutory in character, akin to a temporary postponement of trial in the Patent Office at the request of the respondent Weather-Rite, then jurisdiction

here under the Administrative Procedure Act may be lacking. Note *Phillips Petroleum Co. v. Brenner, Comr. Patents* (CA DC, June 29, 1967) — F.2d —, 154 USPQ 211. While defendants have not challenged this Court's jurisdiction as to Prayers A and C seeking resumption of the suspended Cancellation proceedings, defendants have and do contend that no discovery is warranted in this action under the Administrative Procedure Act, where at most the Court should consider the record made before the agency. This is in line with observations made concerning judicial review under that Act in *United States v. Bianchi & Co.*, 373 U.S. 709, 715-716. Review limited to the agency record is particularly appropriate here, where Weather-Rite is not a party and its motion for suspension would actually be reviewed. Where no new evidence may be admitted, interrogatories have been held irrelevant. *Walled Lake Door Co. v. U. S.*, (DC Mich., 1962) 31 F.R.D. 258.

The Pretrial Examiner made no comment on defendants' specific objections to plaintiff's interrogatories, as represented by defendants' Points 8-19. Hence, no discussion thereof would be warranted here.

Respectfully submitted,

JOSEPH SCHIMMEL, *Solicitor*
U. S. Patent Office,
Attorney for Defendants

November 8, 1967

EXHIBIT A

UNITED STATES PATENT OFFICE

S11,725

Registered July 26, 1966

Principal Register
Trademark

Ser. No. 172,441, filed July 3, 1963

GOODYEAR DELUXE
By WEATHERITE

Weather-Rite Sportswear Co., Inc. (New York corporation)
657 Broadway
New York 12, N.Y.

For: Rainwear—Namely, Raincoats, Rainsuits, Rainhats, Ponchos, and Waterproof Fishing Shirts, Hunting Shirts, Vests and Jackets, Sport Jackets, Boots, Shoes and Overshoes, and Ground Cloths—in Class 39.

First use in or about February 1958; in commerce in or about February 1958.

Applicant disclaims the words "Goodyear Deluxe By" separate and apart from the mark.

EXHIBIT B

[Dept. Order 89-B]

PATENT OFFICE

ORGANIZATION AND FUNCTIONS

The following material supersedes the material appearing at 30 F.R. 11152-11153 of August 28, 1965.

SECTION 1. *Purpose.* The purpose of this order is to prescribe the organization structure and to assign functions within the Patent Office.

Sec. 2. *Organization.* The Patent Office shall consist of the following organization units:

- a. Office of the Commissioner of Patents.
 - 1. Commissioner of Patents.
 - 2. First Assistant Commissioner of Patents.
 - 3. Assistant Commissioner of Patents (2) (Officers reporting to the Commissioner).
- b. Office of Internal Audit.
- c. Office of Research, Development, and Analysis.
- d. Office of Administration (Offices reporting to the First Assistant Commissioner).
- e. Office of the Solicitor.
- f. Board of Appeals.
- g. Board of Patent Interferences.
- h. Trademark Trial and Appeal Board.
- i. Trademark Examining Operation (Offices reporting to an Assistant Commissioner).
- j. Office of Patent Classification.
- k. Office of Patent Services.
- l. Office of Examining Control.
- m. Chemical Examining Operation.
- n. Electrical Examining Operation.
- o. Mechanical Examining Operation.
- p. Office of Information Services.
- q. Office of Legislative Planning.
- r. Office of International Patent and Trademark Affairs.

Sec. 3. *Functions of the Office of the Commissioner.*
.01 the Commissioner determines the policies and directs

the programs of the Patent Office and is responsible for the conduct of all activities of the Patent Office.

.02 The Assistant Commissioners shall perform the duties pertaining to the Office of the Commissioner assigned to them by the Commissioner under his prior and continuing authority. Principal functions assigned to the Assistant Commissioners are:

a. The First Assistant Commissioner shall provide administrative and policy direction to the Office of the Solicitor, the Board of Appeals, the Board of Patent Interferences, the Trademark Trial and Appeal Board, and the Trademark Examining Operation.

b. An Assistant Commissioner shall provide administrative and policy direction to the Office of Patent Classification, Office of Patent Services, Office of Examining Control, and to each of three patent examining operations (Chemical, Electrical, and Mechanical).

c. An Assistant Commissioner shall provide administrative and policy direction to the Office of Information Services, the Office of Legislative Planning, and the Office of International Patent and Trademark Affairs.

.03 Administrative and policy direction of organization components of the Patent Office not delegated to an Assistant Commissioner in paragraph .02 of this section, is reserved in the Commissioner.

SEC. 4. Functions of offices reporting to the Commissioner. .01 The Office of Internal Audit shall conduct a continuing program of independent, objective, and constructive comprehensive internal audits of the operating, administrative, and financial activities of the Patent Office to determine whether in the direction and execution of these activities they are being carried out effectively, efficiently, and economically and in conformance with applicable laws, administrative rules and regulations, operating procedures, policy, and sound administrative

practice; report findings and make appropriate recommendations for corrective action.

.02 The Office of Research, Development and Analysis shall plan and conduct a comprehensive operations improvement program aimed at achieving maximum effectiveness in fulfilling the current and future objectives of the Patent Office. The responsibilities of this office shall be carried out through the Office of the Director, which shall also be responsible for providing mechanized data processing services, and the following Divisions:

a. The Research and Development Division shall identify areas of needed research, formulate approaches to research problems, conduct research (or monitor research carried out under contract), design and install experimental systems, new equipment, or other products of research, and evaluate their effectiveness after installation. Major research and development efforts are aimed at development of automated search and retrieval systems and more effective dissemination of stored information to Patent Office examiners, the patent profession, and the scientific community.

b. The Organization and Systems Analysis Division, as a staff organization serving the entire Patent Office, provides analytical and system research resources for management in developing and implementing improvements in methods, procedures, systems, organization, and manpower and equipment utilization to resolve operational problems, achieve improved efficiency, economy, and effectiveness in operations, and strengthen management practices; develops information for management planning, evaluation, program budgeting, and control; aids in planning to meet future requirements; develops cost-benefit system applications of new technology; and performs related functions.

.03 The Office of Administration shall be responsible for overall Patent Office administrative functions. These func-

tions shall be carried out, as indicated, in the following Divisions which constitute the Office of Administration:

a. Administrative Services Division shall provide office-wide services including the procurement and supply of equipment, furnishings, and consumable items; the procurement of property and services through formally advertised and negotiated contracts; space and facilities management; communications; travel and transportation services; mail, messenger, and general correspondence services; procurement and supply of graphic services and administrative printing, including office forms and publications. This Division is also responsible for carrying out a comprehensive paperwork management program in the Patent Office, embracing forms, reports, directives and records.

b. Budget and Finance Division shall provide staff assistance in the development, application and execution of budgetary and fiscal policies and programs; conduct accounting operations for revenue, trust funds, and the Patent Office appropriation; and administer payroll and related employee accounts.

c. Personnel Division shall administer activities relating to recruitment, placement, employee relations, training and career development, incentive awards, performance rating, position classification and wage administration, group-management relations and various employee benefit programs.

SEC. 5. *Functions of offices reporting to the First Assistant Commissioner.* .01 The Office of the Solicitor comprises the Solicitor, who is the chief legal officer for the Patent Office and his professional associates. This Office shall handle all litigation to which the Commissioner is a party and provide all other required legal services including advice and assistance on legislative matters.

.02 The Board of Appeals shall conduct hearings and render decisions on appeals from adverse decisions of examiners rejecting claims in patent applications.

.03 The Board of Patent Interferences shall conduct patent interference proceedings and make final determination in the Patent Office as to priority of invention. The Board, also, shall decide questions concerning property rights in inventions in the atomic energy and space fields brought before it under the provisions of 42 U.S.C. 2182 and 2457 (d) and (e).

.04 The Trademark Trial and Appeal Board shall be responsible for hearing and deciding adversary proceedings involving interfering applications, oppositions to registration, cancellation petitions, and concurrent use proceedings; and for hearing and deciding appeals from final refusals of the trademark examiners to allow the registration of trademarks.

.05 The Trademark Examining Operation shall be responsible for the classification and examination of applications for the registration of trademarks and service marks and the maintenance of the principal and supplemental registers of trademarks.

SEC. 6. *Functions of offices reporting to an Assistant Commissioner.* .01 The Office of Examining Control shall develop procedures and quality and quantity standards relating to the conduct of the examination function; evaluate examiner compliance with such standards; and train new examiners in patent practice and procedures.

.02 The Office of Patent Classification shall be responsible for developing a system for the classification of patents in the various useful arts and insuring the effective use of this system in the classification of issued patents.

.03 The Office of Patent Services shall review incoming applications for compliance as to form, assign applications to appropriate examining units, issue patent grants, record instruments transferring property rights in patents and trademarks, provide drafting services, furnish copies of patents and office records, maintain a search room for public use in searching and examining patents, coordinate

the mailing of examiner's actions and cited reference matter, and maintain a Scientific Library to provide pertinent technical and scientific information to patent and trademark examiners and for public reference.

.04 There are three Examining Operations respectively the Chemical, Electrical, and Mechanical each of which shall examine patent applications falling in its generic category. An Examining Operation comprises a number of groups, each representing a broad field of invention within a generic category and having jurisdiction over several examining subdivisions representing are groupings.

SEC. 7. Functions of offices reporting to an Assistant Commissioner. .01 The Office of Information Services shall advise and represent the Commissioner on information matters; conduct programs fostering public understanding of the American patent system and the functions, services and publications of the Patent Office; develop publication policies; provide direction and assistance in developing new and revised publications; and assure conformity with policies, regulations, and standards concerning publications and publication practices.

.02 The Office of Legislative Planning shall make studies and advise the Commissioner on matters which may require legislative action and, with advice and assistance of the Solicitor, prepare necessary legislation and supporting reports.

.03 The Office of International Patent and Trademark Affairs shall make studies and advise on policy and action concerning international patent and trademark matters.

Effective date. April 13, 1966.

DAVID R. BALDWIN,
*Assistant Secretary for
Administration.*

[F.R. Doc. 66-4927; Filed, May 4, 1966; 8:50 a.m.]

NOTICES

[Dept. Order 11]

STAFF AND SUPPORT OFFICES FOR ECONOMIC
DEVELOPMENT ACTIVITIES*Organization and Functions*

The following order was issued by the Secretary of Commerce on April 6, 1966.

SECTION 1. *Purpose.* The purpose of this order is to establish the staff and support offices necessary for the efficient conduct of economic development activities of the Department, and to prescribe their organizational structure and functions.

SEC. 2. *Organization.* The following staff and support offices, which shall report directly to the Assistant Secretary of Commerce and Director of Economic Development, and hereby established and designated as constituent operating units of the Department of Commerce:

- a. The Office of Economic Research.
- b. The Office of Administration.
- c. The Office of Program Plans and Analyses.
- d. The Office of the Chief Counsel.
- e. The Office of Public Affairs.
- f. The Office of Congressional Affairs.

SEC. 3. *Functions.* Staff and support offices established herein shall carry out the following functions and responsibilities in providing staff services and administrative support to the Economic Development Administration and the Office of Regional Economic Development:

.01 The Office of Economic Research shall:

Direct and conduct a program of research to meet the needs of the Assistant Secretary, the Economic Develop-

ment Administration, and the Office of Regional Economic Development as authorized by sections 301(c) and 505(a) of the Public Works and Economic Development Act and section 302(a)(2) of the Appalachian Regional Development Act. In so doing, the Office shall:

- a. Perform in-house research;
- b. Arrange for the performance of research by other Government agencies or by private organizations, and monitor the performance of such research;
- c. Review on-going research both in and out of Government which is pertinent to economic development, and compile and make available reports on the progress of such research;
- d. Advise on the state of the art in economic development research and related fields;
- e. Encourage and stimulate research on economic development by other Government agencies and by nongovernment organizations;
- f. Maintain liaison with all research organizations working in the field of economic development or related areas;
- g. Plan, develop, and organize seminars, institutes, workshops, training sessions, etc., to stimulate interest in and increase knowledge of economic development;
- h. Perform special studies and research projects as requested by the Assistant Secretary;
- i. Recommend new areas of research which are worthy of further investigation and study; and
- j. Perform other assignments as directed by the Assistant Secretary.

.02 The Office of Administration shall:

- a. Develop, promulgate, and administer administrative management policies, programs, and standards;

b. Review and coordinate budget requirements and prepare and control fiscal plans and programs;

c. Plan and conduct comprehensive audit of all activities and programs;

d. Plan and conduct an investigations program;

e. Conduct organization and management studies and surveys;

f. Plan and conduct a program for maximum economy, effectiveness, efficiency, and personnel utilization;

g. Provide office services for the headquarters and Field Offices;

h. Develop and conduct a program for the efficient management of all official records and the design and control of official forms;

i. Plan, arrange for, and coordinate any personnel, procurement, fiscal, or other administrative management services obtained through the staff offices of the Department;

j. Plan and conduct comprehensive employee development programs to meet the training needs of assigned staff;

k. Provide administrative support for institutes and other training activities for State, local and other economic development personnel, and assist in the planning and conduct of such activities;

l. Develop a list of business firms, within redevelopment area, desirous of obtaining Government contracts and provide such data to appropriate Government procurement offices;

m. Carry out such liquidation of the affairs and functions conducted under the Area Redevelopment Act as directed by the Administrator; and

n. Maintain liaison with counterpart offices reporting to the Assistant Secretary for Administration.

.03 The Office of Program Plans and Analyses shall:

a. Develop measures of resource utilization and methods of characterizing resource limitations and availabilities to provide quick and accurate answers to questions about the cost and feasibility of various alternative programs for economic development and the alleviation of economic distress, projected over a period of several years;

b. Develop consolidations of, and present, economic development programs to show the total financial implication of currently approved, new, or alternate programs, so as to clarify the problems of choice;

c. Establish and implement a Program Planning and Budgeting System by identifying objective oriented program categories and developing an eight-year program budget for these categories;

d. Develop cost benefit studies, to aid the Assistant Secretary in making choices and decisions, employing advanced techniques of operations research analysis, econometrics, and mathemati-

TRANSCRIPT OF PROCEEDINGS

Friday, November 17, 1967

MOTIONS

[2] The above-entitled matter came on for hearing on Objections of Plaintiff to Recommendations of the Pretrial Examiner, before The HONORABLE JOHN J. SIRICA, United States District Judge, at approximately 10:00 a.m.

APPEARANCES:

For the Plaintiff:

FRANCIS C. BROWNE, Esq.

For the Defendants:

JERE SERES, Esq.

[2] PROCEEDINGS

The Court: This is an objection to the Pretrial Examiner's recommendations. I will hear you, Mr. Browne.

Mr. Browne: May it please the Court, my name is Francis C. Browne. I represent the Plaintiff, The Good-year Tire and Rubber Company.

The Court: I have not had an opportunity to read this whole file, so I wish you would enlighten me on the issues in the case.

Mr. Browne: This particular hearing is directed to the objections of the Plaintiff to the recommendation of the Pretrial Examiner who recommended that the Defendants' objections to interrogatories served by Plaintiff be sustained.

Up until Wednesday of this week we thought that this was a case of first impression before this Court, but on Wednesday of this week we found an unpublished decision—what we considered to be a controlling precedent in this Court—in *Horizons Titanium v. Muller and Watson*.

The Court: What is the picture here first of all?

Mr. Browne: All right. First of all, this case arises out of a proceeding initiated by Plaintiff, The Goodyear Tire and Rubber Company, in the Patent Office to cancel a registration of a trademark issued to Weather-Rite Sportswear Company, Inc., of New York.

[3] The cancellation proceeding was initiated under Title 15 USC, Section 14 of the Trademark Act of 1946. The antecedent history is of some relevance here because before the registration was issued by the Commissioner of Patents, according to the usual regulations and statutes the Commissioner of Patents caused the mark in question to be published in the Official Gazette of the Patent Office, allowing a 30-day period within which any member of the public might object to the issuance of the registration.

That 30-day period, through inadvertence on the part of Plaintiff's house counsel, had expired and shortly after the 30-day period expired, and upon examination of the file, it was found there were several reasons why that application was not eligible for registration at the time it was published by the Patent Office. Therefore, Goodyear petitioned the Commissioner to publish the mark, or to re-examine the application first. It was reexamined and rejected, and amended by the applicant under oath. And then the Commissioner of Patents was about to issue the registration forthwith, without publishing it a second time to afford the members of the public a chance to oppose a validly published application.

We came in and got a temporary restraining order on the day before the registration was to issue, to hold the status quo in order that we might be heard on the merits [4] of whether or not a second publication was required. The District Court dismissed our complaint. On appeal the District Court was affirmed, saying this was premature. And this is the most important point of all: before the District Court, the Solicitor for the Patent Office—before this District Court—the Solicitor for the Patent Office represented there would be no difference between opposing

the application before the issuance of the registration or petitioning to cancel the day it issued, or thereafter. The District Court agreed and the Court of Appeals agreed that we would have our remedy under Section 14 of the Trademark Act by way of cancellation instead of Section 13, by way of opposition before issuance.

So under that mandate the registration issued, and the day after it issued Goodyear petitioned to cancel. The petition for cancellation was properly received by the Commissioner and given a cancellation number. The registrant was called upon to answer; the registrant answered. Goodyear then served notice of taking discovery depositions on the president of the registrant company in accordance with the Patent Office rules and the Federal Rules of Civil Procedure.

At that juncture the registrant moved to suspend all further proceedings in the Patent Office in the cancellation on the theory that the registration sought to be cancelled was involved in a civil action then pending between Goodyear and [5] Weather-Rite in the Southern District of New York. The Trademark Trial Appeal Board, before whom the motion to suspend proceedings came initially, granted the motion and suspended proceedings on the theory that there was private litigation going on between the parties in the Southern District of New York; that the mark which was the subject of the registration sought to be cancelled was involved in that civil action; and that ipso facto the registration was involved; and that the decision of the District Court for the Southern District of New York would be ultimately dispositive of this issue, or perhaps might make it moot, and so on. And they pointed out that the Title 15, Section 1119 of the Trademark Act gives a Federal Court in which any action is pending which involves a registration, the right to cancel the registration, to rectify the register of the Patent Office, and take such other action as may be necessary with respect to that registration.

Section 1116 of Title 15 provides that the Clerk of the District Court in which such action is filed, or in which any subsequent pleading by way of amendment, or answer, or otherwise, brings into that action a registration, shall notify the Patent Office.

I think Your Honor may be familiar with that procedure because this Court follows the same procedure in any action involving a registered mark, and in fact involving a registration. I should say.

[6] There has been no notice given to the Patent Office to this very date by the United States District Court for the Southern District of New York of any action pending in that Court or any amendment or answer or other pleading filed by any party in any action in that Court affecting the registration sought to be cancelled by Goodyear in the Patent Office cancellation proceeding.

Weather-Rite, in support of its motion to suspend proceedings, attached a copy of the complaint and answer. Nowhere in the complaint or answer is any reference made to Registration 811,725—the registration sought to be cancelled.

In order to exhaust its administrative remedy Goodyear petitioned the Commissioner of Patents, in person, from the ruling of the Trademark Appeal Board and asked the Commissioner to do a number of things—most important of which was to resume the proceedings in accordance with the statute and rules, because we were being denied due process because there is no provision in the rules for suspending proceedings.

Now, I realize certain matters come within the discretion of the Commissioner. We contend this is not one of those. We say if the Court should feel it is, then the action of the Commissioner was arbitrary, capricious, contrary to law, contrary to precedent. Therefor he should have directed [7] the Trademark Trial and Appeal Board to resume proceedings.

We wanted this case heard by the Commissioner in person because we felt it was of major importance since a representation had been made on his behalf by his attorney in this very Court when we had the previous action against the Commissioner, that when the registration issued Goodyear would have the right to petition for cancellation.

Now they worded it very cagely, I admit. They said we'd have a right to petition for cancellation. Now they take the position: "well, we didn't say you could go ahead and have it without any hindrance or without any suspension, we said you could file your petition to cancel, you filed it, now we suspended proceedings." So I say the representation upon which this Court acted in refusing to require second publication (which would have given us the right to oppose and would have maintained the status quo at that stage),—the very representation which was made is now being denied to us. So we thought it important the Commissioner himself, not the First Assistant, or some "flunky" he might pass the paper along to act on it—but we wanted the Commissioner himself to decide this. We wanted him to constitute himself a member of the Trademark Trial Appeal Board, because it is a matter of major importance—. I won't go into the facts and background—but it is a significant private importance as well as public concern.

[8] To be short, the defendant is using the trademark Goodyear on rainwear, raincoats, boots, liferafts, articles of that sort imported from Japan, and we have had twenty different civil actions across the country. We have gotten temporary restraining orders, preliminary injunctions, final judgments enjoining use by retailers, and the main action is pending against the importer in New York.

But in the meantime, in order to aid this importer in getting his goods through customs he had to have—or wanted to have—a registration from the Patent Office to wave around. That is why we were so intent on trying

to prevent the registration from issuing in the first place, because we felt it would do irreparable harm to Goodyear if a registration—which is *prima facie* evidence of the validity of the registration, *prima facie* evidence for exclusive right to use, etc.—was not determined,—whether or not the validity was determined,—whether it was entitled to registration before it issued, not after the fact.

In any event, the Commissioner, when the petition was presented to him to review the action of the Trademark Trial and Appeal Board, did not act on the petition. Goodyear received a paper signed by the First Assistant Commissioner of Patents saying he had been—I have forgotten the exact [9] wording—but in any event, he was acting on the petition in lieu of the Commissioner. That is why the First Assistant Commissioner is co-defendant in this case—because he is the one who signed the order which sustained the action of the Trademark Trial and Appeals Board and denied our petition to exercise supervisory authority.

Now, with that posture of the case, there are quite a few issues involved procedurally and technically since this case is under the Administrative Procedure Act. This isn't review on the merits—this is whether we are being denied due process which is guaranteed by the Statute and the Rules, and the decided precedents. Since this is under the Administrative Procedures Act there are certain facts of which the defendants have knowledge which are material and relevant and, if admitted, would probably constitute an adequate basis for motion for summary judgment. It would eliminate all issues of fact that would be in dispute otherwise, and put the case in posture for disposition on motion for summary judgment instead of letting it go to trial later on, and furthermore, would be more expeditious.

So plaintiff, in its efforts to expedite proceedings, filed and served interrogatories on the defendants, asking them three or four categories of questions. First of all, as

the Court knows, the statute provides that the function of [10] the Commissioner of Patents are vested in the Secretary of Commerce, or he may vest them in himself, according to the Statute. We are led to believe he has vested himself with some of those functions, or all of them. The Statute also provides that he may redelegate those functions to the Patent Office or the Commissioner.

Now, what we are trying to find out is whether or not, first of all, the Secretary of Commerce took over the functions of the Commissioner, and whether he redelegated them to the Commissioner.

Second, did the Commissioner redelegate those functions to anyone such as the First Assistant Commissioner? If so, what was his authority? And then we might want to test the legality of redelegation of a delegation. In any event, if we got to that point, we might prove that the Commissioner, in fact the Patent Office, never did act on the petition and therefor we'd have to go back and get another ruling and come back up. That would be foolish.

So we are trying to crystallize all these things and get it down to a point as to who had authority to act? What was their authority for such action?

Second group: we wanted to know what actions were taken in comparable cases so we could establish arbitrariness and capriciousness in action he took [11] in this case, as compared to actions in other cases—many of which are unpublished. Indeed, the very case upon which we are relying this morning in this very Court—in which the Patent Office was the defendant—is an unpublished decision. If that had been published we would have made short work of it before the Pretrial Examiner, I think. Unfortunately, the Pretrial Examiner didn't have this precedent.

The Court: What was that opinion about, the one you just mentioned? What did that say?

Mr. Browne: It was a situation where, again, the Plaintiff sought discovery by interrogatories, or filed and served

interrogatories against the Secretary of Commerce and Commissioner of Patents in the matter in the Patent Office to which the plaintiff was not then a party. It was in an interference. After the interference was dissolved and they were out, they wanted to know why they were out of it and what actions were taken by various officials of the Patent Office, and the basis for it, etc. The Patent Office, as in this case, objected to the interrogatories. The objections were overruled. The Patent Office answered the first set of interrogatories. Another set of interrogatories were filed and served and objection was made to the second set and that was overruled, and the plaintiff had to apply to the Court in order to compel answers.

[12] The Court: I think I understand. Now let me ask a question. Isn't there a case pending now in New York?

Mr. Browne: That is right, Your Honor.

The Court: Didn't the Pretrial Examiner say answers to the interrogatories ought to be delayed until that case is disposed of?

Mr. Browne: Well, actually his ruling did not say the answers to these interrogatories should be delayed. His ruling was that the objections to the interrogatories would be sustained because he thought the ruling of the Commissioner on the merits, in sustaining the Trademark Trial Appeal Board suspension of proceedings, was correct. He went to the merits of the case as I said in my original memorandum before this Court, (I am willing to stand on that too), if that is going to be the law of this case, then I'd like to have it so stated and made a part of the opinion. No matter what comes out of this, it is going to be the law of this case from this point forward, as I see it.

Now, the Pretrial Examiner did not have before him copies of the complaint and answer in the Southern District. He was going on the basis of conclusions represented to him by the Patent Office, and he bought the proposition that the [13] Patent Office shouldn't be bothered

with this sort of thing. In fact, he even went so far as to take up the argument used by the Patent Office in its memoranda here, that is, "why should Goodyear want to fight cancellation proceedings in the Patent Office against Weather-Rite when they could seek that same remedy in a civil action in New York?" Well, the fact of the matter is, the Patent Office is in no position to tell us how to litigate our cases, where we seek our remedies, or how we seek them. If they have a statutory duty to perform, it is up to them to perform it and we ask the powers of this Court to compel them to perform it.

Why doesn't Weather-Rite put it [the registration] in issue in the case in New York? They were furnished a copy of the complaint filed in this present action. They know what is going on. They know we are trying to get the Patent Office to go forward with the proceedings. They knew the proceedings which were antecedent to this against the Commissioner to try and get publication. Never once did they appear in this Court to intervene or take any other part in it. Now if they were an interested party they could do either one of two things: they could have intervened in this action today or they could have gone to the District Court in the Southern District of New York and sought an injunction. That case up there, by the way, is assigned for all purposes to [14] a single judge, Chief Judge Ryan, as a matter of fact. They could have applied there for an injunction against Goodyear proceeding in the Patent Office if they saw fit. They haven't done so.

So, the Patent Office is taking upon its shoulders to determine how private parties are going to litigate their matters instead of performing their statutory duties in accordance with their own rules and precedents, and above all, in accordance with precedents established in this Court.

I don't think I would need to go any further into the support for the Plaintiff's position.

The Court: What is the name of the case you have before you?

Mr. Browne: Horizon Titanium v. Muller, Secretary of Commerce, and Watson, Commissioner of Patents.

The Court: What is the opinion referred to?

Mr. Browne: It was simply an order, no written opinion.

The Court: Order by whom?

Mr. Browne: Order by Judge McGarraghy, initial order overruling the Patent Office—

The Court: What was the date of it?

Mr. Browne: May 10, 1960, an appeal was taken from the second order overruling the Patent Office's objections to a second set of interrogations. Judge McGarraghy was very accommodating. He did his best to frame an appealable order. The Patent Office [15] took an appeal. There was a motion to dismiss the appeal and the Court of Appeals dismissed it.

The Court: Certified under 1292B, US Code?

Mr. Browne: That's right. Nevertheless, the Court of Appeal threw it out. So this would not be an appealable order here.

The Court: Would be if the Court of Appeals wanted—

Mr. Browne: It would be if the Court of Appeals wanted to accept it, if they would accept it, yes, but under the precedent there was not a sufficient showing.

The Court: What is the file number? You ought to have this in the record.

Mr. Browne: 3079-59. I filed a supplemental memorandum and served a copy by hand on the Patent Office yesterday, and a copy was filed in this Court calling attention to this precedent. It is part of this file now. I brought the file up in case the Court wants to have reference to it.

The Court: Let me hear from other counsel.

I think the important thing in this case is to determine whether or not the Court should overrule the recommendation of the Pretrial Examiner. That is the only thing before me.

What objection does the Commissioner of Patents have to answering these interrogatories?

[16] Mr. Seres: Basically the Commissioner takes the view that in this type of action under the Administrative Procedures Act it should be a review on the record of this cancellation proceeding has everything in it necessary to the Commissioner's suspension of the cancellation proceeding. In other words, if Plaintiff has some further facts which might alter that ruling by the Commissioner, he is certainly free to go back to the Commissioner and renew his petition from the Trademark Trial and Appeal Board members' initial ruling.

Now the Pretrial Examiner based his recommendation on the merits undeniably, and Mr. Browne this morning has spoken mostly with regard to the merits of the civil action here, and mention has been made of the suit in the Federal Court in New York state as between the Goodyear Tire and Rubber Company and the Weather-Rite Sportswear. Now that particular New York suit was filed, I believe, in February of '65. The representation by the member of the Solicitor's office that Mr. Browne has referred to in the earlier litigation here had been made the prior December. Mr. Roeming (phonetic spelling), then a member of our staff, did indicate that the Plaintiff could seek cancellation of the registration as soon as it issued as a remedy to Plaintiff. He could not have had any knowledge of the suit in New York at that time.

[17] Now the Statute, the '46 Trademark Statute, provides alternate remedies to a person seeking cancellation of registration. They may proceed in the Patent Office by petition or possibly as an ancillary matter they can seek it in a Federal Court involving the trademark.

Now let me read that portion, Section 1119. I believe the Pretrial Examiner set it forth in full in his recommendation. In any action involving a registered mark—now mind you, at the time the New York case was filed the particular mark had not been registered, that would not come about for another year and a half. However, the mark was very much involved in that suit. The particular mark is "Goodyear Deluxe by Weather-Rite", not simply "Goodyear". In

that suit the Plaintiff, same plaintiff here, sought an injunction against Weather-Rite's use of the word "Goodyear" for any purpose unless Plaintiff OK'd it. Supposing that injunction were granted. That would deny the present registrant, Weather-Rite, to use the particular mark because Goodyear is a necessary part of that mark. On the other hand Weather-Rite in the New York case counter-claimed for cancellation of a host of Goodyear's marks involving the word "Goodyear."

According to our information, as indicated by Mr. Browne, we only know of that suit through copies of complaints [18] and answers filed by Weather-Rite in the cancellation proceedings.

On that basis we can see that the defendant there, Weather-Rite, has invoked the Court's jurisdiction under Section 1119. Now that section indicates that the Court may rectify the register, that the register in the Patent Office, with respect to the registration of any party to the action. It has very broad jurisdiction under 1119, and the Patent Office says the Commissioner needn't be a party to such an action. This is clear from the second sentence of Section 1119: "Decrees and orders shall be certified to the Commissioner, who shall make appropriate entry upon the records of the Patent Office and shall be controlled thereby." The Commissioner performs administrative record-keeping function here. In other words, he will abide by what the Court tells him as far as the registration.

Now, recognizing that, the Patent Office felt that it wouldn't make good sense to go on with the cancellation proceedings before it which were filed well after the New York case in view of the real issue involved in that New York case because whatever happens up there could have a material bearing on what the Patent Office might do should it have to persist in considering the cancellation matter.

[19] Now, nobody can tell the New York court to cancel any particular registration. There is a possibility it might

if it becomes aware of it. Incidentally, it doesn't appear that either party to the New York case has informed that Court of the fact that this mark has been registered. This is very puzzling, but that seems to be the situation.

Now, later if the New York Court does not order cancellation of the particular mark, then it would time enough for the Patent Office to resume the cancellation proceedings. That is the position of the Commissioner in a nutshell.

We have some authority for suspending cancellation proceedings, at least by inference. In the Commissioner's answer to Plaintiff's present objections we have cited the Dwinell-Wright Company v. National Fruit Products Company case out of the First Circuit. In that particular case—

The Court: Excuse me. This is in your memorandum?

Mr. Seres: Yes, it is, Your Honor.

The Court: Now I might save you some time. I try, of course it is almost impossible, especially on this particular assignment of long motions, for a judge—the number of motions we have had, and I have heard over a hundred, I think, since the 1st of October—to actually go through every paper in the file. I try to read as much as I can before coming on the Bench [20] so that I get a feel of the case and understand the issue. As I indicated in the beginning I have not had an opportunity because of the pressure of other work and business to read this file like I would like to read it, so I will take this matter under advisement before I rule on it, so I can read it completely, the file and memoranda, and I will rule on the matter as soon as I can. I have other matters to take up too.

Mr. Seres: Could I say a few words about the new case that Plaintiff discovered this week, the Horizon Titanium—Muller and Watson case? The particular order that Plaintiff referred to in the paper we received yesterday, of course overruled the objections filed by the Commissioner answering interrogatories in that matter. That case would have been under the Administrative Proce-

dures Act. The background is somewhat unusual. Two applications for patent have been involved in interference and one application was stricken because it developed in the course of the interference that someone had altered the application after the inventor executed it. And that suit was brought against the Commissioner to reinstate the application, get it back into the interference. There was a davoring of fraud involved in the situation. Also, there wasn't any collateral litigation between the interested parties, at least no litigation that would have reinstated the application before the Commissioner. There was a case between the parties [21] in the state of Massachusetts but I think it was addressed mainly to gaining information that might help the Plaintiff.

The Court: I understand you. Now what I am going to do in this case is this: I know it is a very important matter to both sides. If I determine and believe after giving the matter further thought and study that there might be room for difference of opinion in this matter, I might, if I rule in favor of the Plaintiff, I might—I don't say I will—depends on what conclusion I come to after studying the matter further, I might certify this matter to the Court of Appeals if I rule in favor of the Plaintiff, if I think the question is that close and there is room for difference of opinion as set forth in Title 28, Section 1292B, which you are familiar with, then let the Court of Appeals take a good look at it, let them rule on the matter. But I have that in mind, the matter is that close.

Mr. Seres: Could I interject this thought, Your Honor? Mr. Finn, the Pretrial Examiner based his recommendation on the broad view of the crux of the whole problem, he didn't go into the specific objections that defendants had lodged against the 54 interrogatories in the subsection, so there might be some basis for remand, if you will, to him if Your Honor felt that plaintiff had prevailed on the major points.

[22] The Court: Well, I don't know. I don't want to burden him with anymore work. I would rather take a look at it myself and then decide what I think should be done. All right.

Mr. Browne: May it please the Court. In the absence of a published decision we had started preparation of a rather lengthy memorandum in reply to defendants' paper.

The Court: How much time do you need, five days, ten days?

Mr. Browne: We can file it this afternoon, as a matter of fact, or Monday morning would be more convenient.

And another thing, I just would like to mention something on this matter that counsel for the Patent Office has raised with regard to judicial review. The Patent Office proceedings generally, and more specifically as to cancellation proceedings there is a point that hasn't been mentioned to the Court yet; that is that Section 21 of the Trademark Act provides for judicial review of the holding of the Trademark Trial and Appeal Board in a cancellation proceeding. Now ordinarily the civil courts defer to the expertise of the Patent Office and they want to know the decision of the experts before they rule. The Patent Office in this case takes the opposite view. They say their opinion is only advisory and therefore the District Court should rule [23] first and then the Patent Office will, as they did in the Wembley case, go into the cancellation, sitting on the merits. So actually, there will be opportunity for judicial review of the cancellation proceeding in the normal course if they go ahead with the cancellation now and it probably will catch up with the civil action before the civil action is disposed of.

Mr. Seres: Your Honor, could I ask for a little time to reply to the paper received yesterday if plaintiff is going to file papers?

The Court: How many papers were filed here? If you keep on replying we will never terminate this matter.

Mr. Browne: Actually the paper which I propose to file,

which I have almost finished and had ready—this is in reply to his previous memorandum.

The Court: Now isn't that enough? Don't you think I have enough to read?

Mr. Seres: Yes, Your Honor, if you will keep in mind what I said about the Titanium case.

Mr. Browne: As a matter of fact, Your Honor, I will withdraw the request for leave to file this paper so the matter can be disposed of more expeditiously and we will stand, at present, on the papers filed.

The Court: All right.

[23-a] (Thereupon the hearing on motion in the above-entitled cause was concluded.)

[Filed Jan. 5, 1968]

Order

Upon consideration of plaintiff's objections to the recommendations of the pretrial examiner, the reply in opposition of the defendant, and oral argument in open court, and the Court being of the opinion that the recommendations of the pretrial examiner were based on improper considerations, it is, by the Court, this 5th day of January, 1968,

ORDERED, that the objections of the plaintiff are sustained, and it is

FURTHER ORDERED, that the original objections to interrogatories filed by the defendant be referred to the pretrial examiner so that he might rule on the merits of each interrogatory, and it is

FURTHER ORDERED, that, the Court being of the opinion that a controlling question of law is involved herein as to which there is substantial ground for difference of opinion

and that an immediate appeal from this order may materially advance the ultimate termination of the litigation, this question be certified to the Court of Appeals under 28 U.S.C. § 1292(b) (1964).

JOHN J. SIRICA
United States District Judge

[Filed February 28, 1968]

**Pretrial Examiner's Further Recommendation on Defendants'
Opposition To and Motion To Strike Interrogatories**

This action having been referred again to the Examiner following the recommendation of October 25, 1967 by the Order of Court entered January 5, 1968, and a review of the entire file having been had as well as of the citations of authority in the various memoranda of the parties, filed both before and after the previous recommendation of October 25, 1967, and having in mind the further argument of counsel on February 23, 1968, it is this 28th day of February, 1968.

RECOMMENDED: that the defendants' objections to the following interrogatories filed by the plaintiff be sustained: 1, 5, 6a, 8, 9, 10, 11, 17, 18, 19, 20, 21, 23, 25, 26, 28, 33, 34, 35, 36, 37, 38, 39, 40, 42d, 43, 44, 45, 46, 47, 49a, 50, 51, 52, 53 and 54 on the basis that these interrogatories either involve a question of law or of interpretation of a law in whole or in part; they call for an expression of opinion or for the mental processes of heads of a government agency; that insofar as the questions are directed to delegation of authority such delegations are, if such there may be, set out in the Federal Register and answers to such interrogatories would serve no useful purpose in the litigation as well as setting out opinion as to meaning and thus being questions of law.

Further, since in an action under the Administrative Procedures Act, such as this, the Court would have no trial function and must act on the record of the Patent Office, the foregoing questions would be irrelevant and would not lead to discovery of relevant information, and it is further

RECOMMENDED: that the defendants' objections otherwise be overruled, and it is further

RECOMMENDED: that the defendants may have until March 25, 1968, within which to respond to those interrogatories with respect to which it is herein recommended that their objections be overruled.

JOHN H. FINN
Pretrial Examiner

[Filed March 5, 1968]

Plaintiff's Objections to Further Recommendation of Pretrial Examiner on Defendants' Objections To and Motion To Strike Plaintiff's Interrogatories

I. SUMMARY OF ACTION OF PRETRIAL EXAMINER

1. In a recommendation dated February 28, 1968, the Pretrial Examiner recommended that:

- (a) Defendants' objections to plaintiff's Interrogatories 1, 5, 6a, 8, 9, 10, 11, 17, 18, 19, 20, 21, 23, 25, 26, 28, 32, 34, 35, 36, 37, 38, 39, 40, 42d, 43, 44, 45, 46, 47, 49a, 50, 51, 52, 53 and 54 be sustained;
- (b) Defendants' objections otherwise be overruled; and
- (c) Defendants have until March 25, 1968 to respond to the Interrogatories as to which it is recommended that defendants' objections be overruled.

2. The grounds for the Pretrial Examiner's recommendation that defendants' objections to the foregoing Interrogatories be sustained were that:

- (a) These Interrogatories involve either a question of law or of interpretation of law in whole or in part;
- (b) These Interrogatories call for an expression of opinion or the mental processes of heads of a government agency;
- (c) The answers to these Interrogatories, insofar as they are directed to delegations of authority, would serve no useful purpose in the litigation as well as setting out opinion as to meaning and thus are questions of law since such delegations, if any, are set out in the Federal Register;
- (d) The Interrogatories would be irrelevant and would not lead to discovery of relevant information since the court has no trial function in an action, such as this, under the Administrative Procedure Act, but must act solely on the record of the Patent Office.

II. PLAINTIFF'S OBJECTIONS TO RECOMMENDATIONS OF PRETRIAL EXAMINER

1. Plaintiff objects to the Pretrial Examiner's recommendation that defendants' objections to plaintiff's interrogatories 1, 5, 6a, 8 to 11, inclusive, 17 to 21, inclusive, 23, 25, 26, 28, 33 to 40, inclusive, 42d, 43 to 47, inclusive, 49a and 50 to 54, inclusive, be sustained and prays that the court sustain plaintiff's objections to the aforementioned recommendation of the Pretrial Examiner and that defendants' objections to the aforementioned Interrogatories be overruled. Copies of the aforementioned Interrogatories are appended hereto as Annex A.

2. In addition, plaintiff objects to and prays that the court overrule and strike from the Pretrial Examiner's recommendation the paragraph which reads:

"Further, since in an action under the Administrative Procedures Act, such as this, the court would have no

trial function and must act on the record of the Patent Office, the foregoing questions would be irrelevant and would not lead to discovery of relevant information, and it is further"

III. GROUNDS FOR PLAINTIFF'S OBJECTIONS TO RECOMMENDATION OF PRETRIAL EXAMINER

1. Interrogatory 1 should be answered by defendants inasmuch as their very jurisdiction over the subject matter of the cancellation proceeding which gave rise to the present complaint depends upon Title 35, United States Code, Section 3 which provides that the Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees and to authorize their performance by any other officer or employee.

It is essential, therefore, to know whether or not defendants have been divested of their statutory duties or authority by the Secretary of Commerce and, if so, to whom the Secretary has delegated the vested functions.

The Interrogatory does not call for a conclusion or opinion nor does it involve a question of law. There is no assurance that notice of any vesting or delegation of functions, if any, were published in the Federal Register. Whether or not published, defendants should be required to state by a "yes" or "no" answer, whether or not the Secretary of Commerce has vested in himself any of their functions.

2. Interrogatory 5 merely asks defendant Brenner whether or not he, in person, ever acted on any petition to the Commissioner under his rules.

This is a question of fact which can be answered by "yes" or "no".

If the answer is "yes", it may be that the Commissioner arbitrarily and capriciously avoided acting on plaintiff's petition and abdicated this function to a subordinate.

If the answer is "no", it may be that the Commissioner is denying plaintiff due process since his rules provide for petitions to "The Commissioner".

3. Interrogatory 6(a) is dependent upon the answer to Interrogatory 6, the defendants' objection as to which was overruled.

If, as it is expected, the Commissioner will answer Interrogatory 6 by saying that he has never designated himself a member of the Trademark Trial and Appeal Board to hear any case, he should at least identify the "Patent Office employees designated by the Commissioner" to serve as members of the Trademark Trial and Appeal Board in order that it can be determined whether or not such employees possess the qualifications for appointment by the Commissioner.

This Interrogatory is directed to a question of fact and does not involve a conclusion, opinion or question of law. The name and title of each person designated will fully answer the question.

4. Interrogatory 8 merely calls upon defendant Brenner to specify the date on which he saw the file of the cancellation proceeding in question, if at all.

If, as it is expected, the answer is that he has never seen it, plaintiff will wish to show that it has not had due process and the Commissioner has acted arbitrarily and capriciously in that the Commissioner acted, if at all, without even seeing the file of the Patent Office upon which its refusal to conduct the cancellation proceeding is based.

5. Interrogatory 9 is intended to establish, as a fact, whether or not a written statement of policy or guidelines exist with respect to the criteria for suspending contested proceedings which have been duly initiated in the Patent Office.

If, in the discharge of his statutory duties or those reposed in him by the Secretary of Commerce, the Commissioner has laid down statements of policy or guidelines under which the matter in question was decided, plaintiff is entitled to know not only if such statements of policy or guidelines have been laid down but also what they are.

Only in this way can plaintiff establish whether or not such policies or guidelines are contrary to law or are arbitrary and capricious. If there are such, they are records of the Patent Office and should be made available under the Public Information Act, in any event.

6. Interrogatory 10 is directed to whether or not the substance of any statement of policy or guidelines referred to in Interrogatory 9 or any other statute or rule is relied upon by defendants as their authority for suspending proceedings in the cancellation in question.

7. Interrogatory 11 is intended to determine what precedent there is, if any, for the Patent Office to suspend cancellation proceedings under the facts in the present case, since the defendants normally contend that actions such as this are based upon long standing precedent where they are unable to find a basis for their action in the statutes or the rules.

8. Interrogatories 17 to 21, inclusive, and 23 correspond, in substance, to Interrogatories 6a, 8, 9, 10 and 11, except that Interrogatories 17 to 21, inclusive, and 23 are directed to defendant Reynolds, whereas the earlier numbered Interrogatories were directed to defendant Brenner.

Defendant Reynolds purported to act in the name of the Commissioner of Patents in denying plaintiff's petition to the Commissioner of Patents, in person. Accordingly, plaintiff is entitled to know how it happened that defendant Reynolds acted on the petition instead of defendant Brenner and what authority did defendant Reynolds have, if any, over the Trademark Trial and Appeal Board or the cancellation proceeding pending before it.

9. Interrogatories 25, 26 and 28 are directed to matters involving the registration which is the subject of the cancellation proceeding here involved, but relate back to the time when it was in the form of a pending application, during which time the Patent Office refused to suspend

proceedings on the application in the absence of a court order.

If the answer to Interrogatory 25 is in the negative, it follows that the registration in question should not have issued without publication of the mark in the Official Gazette at a time when the application was in compliance with all requirements of the statutes and rules.

If the answer to Interrogatory 28 is in the affirmative, plaintiff will wish to show that the refusal to suspend ex parte proceedings pending the outcome of civil litigation is inconsistent with suspension of cancellation proceedings based on a registration issued on such application and resulted in immediate and irreparable damage to plaintiff.

10. Interrogatories 33 to 38, inclusive, are the most important interrogatories in the set since they go directly to the merits of the controversy.

Defendants went outside the record in the Patent Office in suspending the cancellation proceedings in that they relied on hearsay as to the matters in issue or in the pleadings in the civil action between plaintiff and its adversary. Now defendants want to avoid answering Interrogatories directed to the representations made to this court in an action between plaintiff and defendant Brenner which caused the court to dismiss plaintiff's complaint to cause the application to be republished for opposition.

If, as plaintiff contends, defendant Brenner authorized his counsel to represent that plaintiff could have a remedy by way of cancellation of the registration when it issued, such representation is binding on defendant Brenner to the extent that he is now estopped to suspend the cancellation proceeding, such proceeding having been duly instituted and in progress at the time of suspension.

11. Interrogatories 39 and 40 are intended to establish that the defendants are responsible for the conduct of cancellation proceedings under the statute since the Memoranda heretofore filed by them and the decision of which judicial review is sought in the present action seem to

thrust the burden of conducting the cancellation proceeding on the court in New York instead of defendants bearing that burden themselves.

Moreover, their answers to the Interrogatories regarding vesting, revesting and delegation of authority to conduct cancellation proceedings lead directly to the question of whether or not they are carrying out the statutory or delegated functions, i.e., whether or not they are affording plaintiff due process.

12. Interrogatory 42(d) is intended to elicit from defendants an answer as to a procedural step in the Patent Office, there being no rule or statute from which the answer may be derived. If the Patent Office does not inform the Bureau of Customs of the cancellation of a registration, it will be incumbent upon plaintiff to go through another administrative proceeding to have the Bureau of Customs strike the cancelled registration from its records.

When plaintiff sought to prevent issuance of the registration unless there was a republication of the application for opposition, counsel for defendant Brenner represented that there would be no difference between remitting plaintiff to a remedy by way of cancellation and republishing the application so that plaintiff could oppose issuance of the registration. Nevertheless, shortly after the registration issued (and after the cancellation proceeding was instituted) the registration was recorded with the Bureau of Customs and the Patent Office didn't even apprise the Bureau of Customs that the registration was the subject of a pending cancellation proceeding.

The least defendants can do now is to say whether or not they will inform the Bureau of Customs of cancellation if plaintiff prevails in the cancellation proceeding.

13. Interrogatory 43 is intended to ascertain whether or not defendants are keeping Weather-Rite Sportswear Co., Inc. (the registrant) informed of the progress of the present action to encourage Weather-Rite to intervene in this action or to encourage Weather-Rite to keep defendants

informed of the status of the civil action upon the basis of which defendants suspended proceedings in the cancellation pending in the Patent Office.

Since defendants went outside the records of the Patent Office as a basis for its action which gave rise to the present complaint, it is proper to continue to follow up on the matters outside the Patent Office record to determine whether the condition which caused suspension still exists, if it ever did.

14. Interrogatory 44 is directed to a paper which misrepresents the statutory basis for the present action against defendants. No rule or statute known to counsel for plaintiff provides for the inclusion of such a paper in the file, whereas Section 34 of the Trademark Act (Title 15, United States Code, Section 1116) provides that the Clerk of a court in which an action is filed under the Trademark Act must notify the Commissioner of Patents of the number or numbers of registrations involved in the action.

In fulfilling this statutory requirement, the Clerk of the court in New York would have given notice to the Commissioner if Registration 811,725 was involved in the civil action upon which the Patent Office based its action in suspending the cancellation proceedings with respect to that registration. The fact is that the registration is not involved in the civil action and, therefore, there is no basis for the Clerk to give such notice.

Since a notice of one pending suit is incorporated in the record of the Patent Office (albeit an incorrect notice), plaintiff is entitled to know the basis for including a reference to one suit in the record and not including a reference to the other, particularly where defendants rely upon such other suit to justify its actions. The answer to this question will further support plaintiff's contention that defendants have acted inconsistently, arbitrarily and capriciously, as well as without statutory authority in suspending the cancellation proceedings.

15. Interrogatories 44, 45, 46, 47, 49(a), 50, 51 and 52 are all directed to the relationship, if any, between the civil action which defendants have relied upon as a basis for suspension of the cancellation proceeding, and the issue to be determined in the suspended cancellation proceeding.

It would thwart the ends of justice to deny plaintiff the right to hear defendants' answers to the questions pertaining to the civil action on the ground that these Interrogatories pertain to matters outside the Patent Office record.

If, as appears to be the case, the Patent Office action was predicated upon matters outside the Patent Office and outside the records of the Patent Office (except as relayed by paraphrase and hearsay), plaintiff should be entitled to explore and discover all other matters outside the Patent Office record which could, in any way, have contributed to the inconsistent, arbitrary, capricious and lawless acts complained of herein.

16. Interrogatory 53 is intended to elicit the facts as to what work which the Patent Office would avoid which would be "unnecessary work" by suspending the cancellation proceeding.

It is clearly established by Patent Office precedents that it may be required to conduct cancellation proceedings even after civil actions between the parties have been concluded. Thus there is no escaping the work which the statutes and rules prescribe in conducting cancellation proceedings. It cannot be said, therefore, that any "unnecessary" work would be avoided merely by suspending the proceedings. Otherwise the Patent Office might as well go all the way and dismiss the proceeding. This it obviously could not do.

17. Interrogatory 54 is intended to show inconsistent action on the part of the Patent Office.

Had this Interrogatory been framed as a request for admission, defendants would have had to admit that it re-

fused to suspend proceedings in one case in the Patent Office while a contested proceeding involving the matter was going forward. It is utterly inconsistent for the defendants to stay or refuse to stay one proceeding or another, according to its whim or fancy.

IV. TRIAL FUNCTION OF COURT

The Pretrial Examiner, both in his original ruling of October 24, 1967 on defendants' wholesale objection to plaintiff's Interrogatories and in his ruling of February 28, 1968 on the specific objections pursuant to the order of the court dated January 5, 1968, went beyond his function of ruling on the defendants' objections to the Interrogatories and expressed a view on the merits of plaintiff's case-in-chief to the extent of expressing a doubt as to the jurisdiction of the court to entertain the present action and suggesting that "the court would have no trial function" since it "must act on the record of the Patent Office" even though the basis for the Patent Office action lies upon matters which are outside the Patent Office and outside the Patent Office record.

If defendants wished to contest the jurisdiction of the court to entertain the action or if it felt that the undisputed facts as embodied in the Patent Office record leaves nothing for the court to try, they could have done so by way of appropriate motion more than a year ago. (The complaint was filed February 24, 1967, answer was filed, and the case was calendared April 25, 1967.) Under the circumstances, it is requested that there be stricken from the Pretrial Examiner's "Further Recommendation" dated February 28, 1968, the paragraph which reads:

"Further, since in an action under the Administrative Procedures Act, such as this, the Court would have no trial function and must act on the record of the Patent Office, the foregoing questions would be irrelevant and would not lead to discovery of relevant information, and it is further".

In the alternative, plaintiff requests the court to overrule all of the Pretrial Examiner's recommendations set forth in the aforementioned paper and, in lieu thereof, requests entry of an order overruling all of defendants' objections to plaintiff's Interrogatories and allowing defendants fifteen days within which to answer the Interrogatories. A proposed Order to that effect is submitted herewith.

As of the time of preparation of the plaintiff's present objections to the Pretrial Examiner's "Further Recommendations", no notice has been received of any objections thereto on behalf of defendants. However, in the event defendants present objections, plaintiff reserves its right to answer such objections in the manner and within the time prescribed by the local rules of the court.

V. CONCLUSION

In conclusion, plaintiff requests that the foregoing objections be heard by the Court and the recommendations of the Pretrial Examiner be overruled to the extent sought herein.

Respectfully,

THE GOODYEAR TIRE & RUBBER COMPANY

By

Francis C. Browne

Counsel for Plaintiff

CERTIFICATE OF SERVICE

Two copies of the foregoing "Plaintiff's Objections to Further Recommendation of Pretrial Examiner on Defendants' Objections to and Motion to Strike Plaintiff's Interrogatories" are being served this 5th day of March, 1968 on Joseph Schimmel, Solicitor, United States Patent Office, Washington, D. C. 20231, Attorneys for Defendants.

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ANNEX A

1. Has the Secretary of Commerce ever vested in himself any function conferred on the Commissioner of Patents or the Trademark Trial and Appeal Board by statute under Title 15, United States Code?

5. Has defendant, Edward J. Brenner, in his capacity as Commissioner of Patents, ever, since the date given in answer to Interrogatory 2, acted, in person, upon a petition of a party addressed to the Commissioner of Patents under Rule 2.146(a) of the Trademark Rules of Practice of the Patent Office?

6. Has Edward J. Brenner, in his capacity as Commissioner of Patents, ever, since the date given in answer to Interrogatory 2, designated himself a member of the Trademark Trial and Appeal Board to hear a case within the meaning of Section 17 of the Trademark Act of 1946 (15 USC 1067)?

6a. If the answer to Interrogatory 6 is in the affirmative, identify each such case and state the names and title of each person other than the Commissioner of Patents designated to hear the respective cases.

8. On what date, if at all, did defendant, Edward J. Brenner, personally first see the Patent Office file of Cancellation 8,738?

9. Has Edward J. Brenner, in his capacity as Commissioner of Patents, ever, since the date given in answer to Interrogatory 2, issued or caused to be issued by any person acting under his authority, any Rule of Practice, regulation, or oral or written statement of policy setting forth guidelines to be followed by members of the Trademark Trial and Appeal Board or the Assistant Commissioner of Patents with respect to suspension of cancellation proceedings in the United States Patent Office pending the outcome of a civil action between the parties to such cancellation proceeding?

10. Under what statute, rule, regulation or statement of policy do the defendants contend the Commissioner of Patents or anyone acting under his authority may suspend all action in a trademark cancellation proceeding in the Patent Office in the absence of consent or stipulation between all parties that such proceedings may be suspended?

11. What is the Cancellation Docket Number of each cancellation proceeding in the United States Patent Office (except Cancellation 8,738) in which action in such proceeding was suspended by the Patent Office pending the outcome of a civil action between the same parties, in the absence of a stipulation between or consent of one or more of each of the parties that such proceeding should be suspended.

16. Has defendant, Edwin L. Reynolds, in his capacity as First Assistant Commissioner of Patents or Acting Commissioner of Patents ever, since the date given in answer to Interrogatory 12, been designated, designated himself, or served as a member of the Trademark Trial and Appeal Board to hear a case within the meaning of Section 17 of the Trademark Act of 1946 (15 USC 1067)?

17. If the answer to Interrogatory 16 is in the affirmative, identify each such case and indicate the disposition thereof.

18. On what date, if at all, did Edward J. Brenner first see plaintiff's Petition to the Commissioner of Patents, in person, in Cancellation 8,738?

19. Did Edward J. Brenner authorize or direct Edwin L. Reynolds to render a decision on plaintiff's petition to the Commissioner of Patents, in person, in Cancellation 8,738?

20. Under what authority did defendant, Edwin L. Reynolds, act on plaintiff's Petition to the Commissioner of Patents, in person, in Cancellation 8,738, on February 16, 1967?

21. Has defendant, Edwin L. Reynolds, acted on any petition to the Commissioner of Patents under Trademark Rule 2.146, other than the petition in Cancellation 8,738?

23. Does defendant, Edwin L. Reynolds, in his capacity as First Assistant Commissioner of Patents, have supervisory authority over the Trademark Trial and Appeal Board or the members thereof?

25. Did Application Serial No. 172,441 comply with all requirements of the statutes and rules prerequisite to issuance of a registration thereon at the time it was published in the Official Gazette on May 12, 1964?

26. Was Application Serial No. 172,441 ever published in the Official Gazette for opposition anytime other than on May 12, 1964?

28. Did the defendants, or either of them, or anyone acting under their authority, refuse to withhold issuance of a registration on Application Serial No. 172,441 after being apprised of the fact that a civil action was then pending in the United States District Court for the Southern District of New York between The Goodyear Tire & Rubber Company and the applicant, Weather-Rite Sportswear Co., Inc.?

33. Is the registration sought to be cancelled in Cancellation 8,738 involved in Civil Action 65C476, pending in the United States District Court for the Southern District of New York between The Goodyear Tire & Rubber Company and Weather-Rite Sportswear Co., Inc.?

34. Did Mr. Roeming, on behalf of the Commissioner of Patents in Civil Action 2894-64, in this Court on December 11, 1964, represent to the Court that "... if this Court should dismiss this complaint, the plaintiff can just, by the asking, find out on what day the registration of Weather-Rite would be issued and it would be possible for him to file a petition to cancel it on the very day it was issued ..." and that "... he clearly has his remedy

by petition to cancel" and that "the complaint should clearly be dismissed as to Prayer A"?

35. Did Mr. Roeming, on behalf of the Commissioner of Patents in Civil Action 2894-64, in this Court on December 11, 1964, represent to the Court that Congress provided a remedy for plaintiff in this situation under Section 14 of the Trademark Act of 1946?

36. Did either defendant authorize Mr. Roeming to state before the United States District Court for the District of Columbia in Civil Action 2894-64 on December 11, 1964 that plaintiff "... clearly has his remedy by petition to cancel ..." the registration which was about to be issued by the Commissioner of Patents on Application Serial No. 172,441?

37. Did the United States District Court for the District of Columbia hold, in an opinion filed February 23, 1965 in Civil Action 2894-64 between The Goodyear Tire & Rubber Company and The Commissioner of Patents that the plaintiff still has open to it the remedy of having the registration to be issued on Application Serial No. 172,441 cancelled by the Patent Office after registration?

38. Did the Patent Office remit plaintiff to a remedy under Section 14 of the Trademark Act of 1946 (15 U.S.C. Sec. 1064) for cancellation of Registration No. 811,725, as held by the United States Court of Appeals for the District of Columbia Court on December 29, 1965 in Appeal 19276?

39. Do the defendants have a duty under Section 14 of the Trademark Act of 1946 to conduct cancellation proceedings?

40. Are defendants conducting cancellation proceedings under Section 14 of the Trademark Act of 1946 at this time with respect to Registration No. 811,725?

42c. Has Registration 811,725 been recorded with the Bureau of Customs under Section 42 of the Trademark Act of 1946?

42d. If the answer to Interrogatory 42c is in the affirmative, state whether the Bureau of Customs will be informed of cancellation of Registration 811,725 by the Commissioner of Patents if the registration is ordered cancelled in Cancellation 8,738.

43. Was a copy of defendants' Answer to Complaint in the present action furnished Weather-Rite Sportswear Co., Inc. or their attorneys of record in Cancellation 8,738?

44. What is the authority for including Paper No. 12 in the Patent Office file of Registration 811,725?

45. Will the Commissioner of Patents be bound by the final decision in Civil Action 65C476 in the United States District Court for the Southern District of New York in any respect whatever?

46. If the answer to Interrogatory 44 is in the affirmative, state in what respect the Commissioner of Patents would be bound.

47. Does the Commissioner of Patents have any basis in fact or law upon which he could intervene in Civil Action 65C476 in the United States District Court for the Southern District of New York?

49. Has either of the defendants or anyone acting under their authority read any of the pleadings of record in Civil Action 65C476 in the United States District Court for the Southern District of New York?

49a. If the answer to Interrogatory 49 is in the affirmative, identify and quote each pleading which refers to Registration 811,725.

50. Do any of the pleadings in Civil Action 65C476 in the United States District Court for the Southern District of New York seek cancellation of Registration 811,725?

51. Would the final action by the Patent Office in Cancellation 8,738 be subject to judicial review in the United

States District Court for the Southern District of New York?

52. Does the Commissioner of Patents have the right to intervene in a civil action in which judicial review is sought of the final action of the Patent Office in a trademark cancellation proceeding conducted in accordance with Section 14 of the Trademark Act of 1946 (15 U.S.C. 1064)?

53. What "unnecessary work" on the part of the Patent Office is or would be avoided by suspending action in Cancellation S,738 under the circumstances of this case?

54. Did defendants or any person acting under their authority refuse on February 20, 1967 to suspend ex parte proceedings in Application Serial No. 226,675 upon request of the applicant pending the outcome of ancillary concurrent use proceedings?

ANNEX B

Text of Statutes and Rules

I. Title 35. United States Code. Sections 3 and 6

Sec. 3. *Officers and employees*

A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and not more than fifteen examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate. The assistant commissioners shall perform the duties pertaining to the office of commissioner assigned to them by the Commissioner. The first assistant commissioner, or, in the event of a vacancy in that office, the assistant commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

The Secretary of Commerce may vest in himself the functions of the Patent Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee. The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each examiner-in-chief in the Patent Office at not in excess of the maximum scheduled rate provided for positions in grade 17 of the General Schedule of the Classification Act of 1949, as amended. (Amended September 6, 1958, Public Law 85-933, sec. 1, 72 Stat. 1793; September 23, 1959, Public Law 86-370, sec. 1(a), 73 Stat. 650; and August 14, 1964, Public Law 88-426, sec. 305(26), 78 Stat. 425).

Sec. 6. Duties of Commissioner

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

II. Rule 2.146(a)

Petition to the Commissioner. (a) Petition may be taken to the Commissioner (1) from any repeated action or requirement of the Examiner of Trademarks, not subject to appeal under rule 2.141, in the *ex parte* prosecution of an application; (2) in cases in which the statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed

and the action requested. Any brief in support thereof should accompany or be embodied in the petition; in contested cases any brief in opposition shall be filed within fifteen days after service of the petition. Where facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits or declarations in accordance with rule 2.20 (and exhibits, if any) must accompany the petition.

(c) An oral hearing will not be held except when considered necessary by the Commissioner.

(d) The mere filing of a petition will not stay the period for replying to an Examiner's action, nor stay other proceedings.

(e) Authority to act on a petition may, when appropriate, be delegated by the Commissioner.

(f) No fee is required for a petition to the Commissioner.

III. Title 15, United States Code, Section 1067

Sec. 17. *Interference, opposition, concurrent use application, cancellation—Procedure*

In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Commissioner shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration. The Trademark Trial and Appeal Board shall include the Commissioner, the Assistant Commissioners, and such Patent Office employees designated by the Commissioner and whose qualifications have been approved by the Civil Service Commission as being adequate for appointment to the position of examiner in charge of interferences. Each case shall be heard by at least three members of the Board the members hearing such case to be designated by the Commissioner (Amended Aug. 8, 1958, 72 Stat. 540).

IV. Title 15, United States Code. Section 1116**Sec. 34. Remedies—Injunctions**

The several courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent Office. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

Enforcement by other courts. The said courts shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted.

Notice of suit to Commissioner. It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding arising under the provisions of this Act to give notice thereof in writing to the

Commissioner setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the Commissioner, and within one month after the decision is rendered, appeal taken or a decree issued the clerk of the court shall give notice thereof to the Commissioner, and it shall be the duty of the Commissioner on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

[Filed March 6, 1968]

Request by Defendants for Clarification of "Pretrial Examiner's Further Recommendation on Defendants' Opposition To and Motion To Strike Interrogatories"

By his indicated further recommendation dated February 28, 1968, the Pretrial Examiner has recommended that defendants' objections to certain enumerated interrogatories be sustained, and that defendants' objections otherwise be overruled. With regard to the interrogatories embraced by the latter, recommendation was further made "that the defendants may have until March 25, 1968, within which to respond." However, no recommendation was made as to who should answer, the defendants personally or their attorney.

At the hearing held on February 23, 1968, counsel for defendants called attention to an order by this Court in *Horizons Titanium Co. v. Mueller, Secretary of Commerce, and Watson, Commissioner of Patents* (Civil Action No. 3079-59), dated May 16, 1960, whereby defendants' op-

positions to interrogatories *inter alia* were overruled, with the concluding proviso that "answers may be made on behalf of Defendants by their attorney under oath." The same leave was sought for defendants' attorney here, to facilitate answering of any interrogatories. Clarification on that point is requested.

Respectfully submitted,

JOSEPH SCHIMMEL

Solicitor,

United States Patent Office

Attorney for Defendants

March 6, 1968

[Filed March 6, 1968]

Objections by Defendants to "Pretrial Examiner's Further Recommendation on Defendants' Opposition To and Motion To Strike Interrogatories"

Pursuant to Rule 9(i)(2), defendants hereby object to the indicated further recommendation by the Pretrial Examiner dated February 28, 1967, to the extent that the Pretrial Examiner thereby implicitly recommends denial of defendants' motion to strike "PLAINTIFFS FIRST SET OF INTERROGATORIES TO DEFENDANTS" and recommends that defendants' specific objections to certain interrogatories be overruled—viz. all those interrogatories not enumerated in the second paragraph of the recommendation.

The Pretrial Examiner has expressly agreed with the position taken by defendants concerning the limited nature of this civil action (defendants' points 2 and 5), by finding that " * * * in an action under the Administrative Procedure Act, such as this, the Court would have no trial function and must act on the record of the Patent Office, * * *." Of course, this is in line with the view of the Supreme Court as indicated in *United States v. Bianchi*, 373 U.S. 709, 715-716, where judicial review under the Administrative Procedures Act was relied upon as a prime

example of "review limited to the administrative record," in construing the proper scope of review under the "Wunderlich Act." Moreover, the appeal aspect of the Court's review under the Administrative Procedures Act has been recognized by this Court in *Winkler v. Ladd*, Comr. Pats., 221 F. Supp. 550, 138 USPQ 666 (aff'd. 143 USPQ 172). This being the case, none of the posed interrogatories could be relevant, or lead to the discovery of relevant information, as recognized by the Court in ruling on objections to producing documents and answering interrogatories in *Walled Lake Door Company v. United States et al.* 31 FRD 258 (DC Mich., 1962). After finding that in this civil action "the Court would have no trial function and must act on the record of the Patent Office," the Pretrial Examiner fell short in concluding that only "the foregoing [enumerated] questions would be irrelevant and would not lead to discovery of relevant information." Clearly, this reasoning should have applied to all the interrogatories. For that fundamental reason, as well as another posed in defendants' point 6, defendants' motion to strike the entire set of interrogatories should be granted.

Additionally, regarding the fourth paragraph of the recommendation, wherein the Pretrial Examiner recommends "that the defendants' objections otherwise be overruled," defendants rely upon their specific points 8, 9, 11, 11b, 11c, 11e, 12, 13, 15, 16 and 19, as to which the Pretrial Examiner made no specific comment. The objections represented by these points are meritorious, it is submitted, and should not have been overruled.

Defendants' points referred to hereinabove are reproduced in the accompanying Appendix.

Respectfully submitted,

JOSEPH SCHIMMEL

Solicitor,

United States Patent Office

Attorney for Defendants

March 6, 1968

March 6, 1968

I hereby certify that two copies of the foregoing REQUEST BY DEFENDANTS FOR CLARIFICATION OF "PRETRIAL EXAMINER'S FURTHER RECOMMENDATION ON DEFENDANTS' OPPOSITION TO AND MOTION TO STRIKE INTERROGATORIES" and OBJECTIONS BY DEFENDANTS TO "PRETRIAL EXAMINER'S FURTHER RECOMMENDATION ON DEFENDANTS' OPPOSITION TO AND MOTION TO STRIKE INTERROGATORIES" were mailed today, March 6, 1968, to Mr. Francis C. Browne, c/o Browne, Schuyler & Beveridge, 1815 H Street, N.W., Washington, D. C., 20006, attorney for plaintiff.

JOSEPH SCHIMMEL
Solicitor

APPENDIX

2. Plaintiff, as a party to the indicated cancellation proceeding, is fully informed of the reasons for suspension. *There simply is no need to elicit any further facts.* The nature of the present suit is one for review of the record in the cancellation proceeding, as though on appeal. *Winkler v. Ladd*, Comr. Pats., 221 F. Supp. 550, 138 USPQ 666 (affd. 143 USPQ 172).

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3. In line with original point 2, the Court's review should be limited to consideration of the written record in the suspended cancellation proceeding, thus obviating any proper roll for discovery here. The Supreme Court has cited the Administrative Procedure Act, particularly former section 1009 of Title 5 U.S.C., as a foremost example of "review limited to the administrative record," in *United States v. Bianchi & Co.*, 373 U.S. 709, 715-716. This is the very jurisdiction plaintiff pleads. [Note *Sikora v. Brenner*, Comr. Pats. (CA DS, May 8, 1967), 379 F. 2d 134.

153 USPQ 385, f.n. 3, where the Court explained that "5 U.S.C. §§ 702-04, as codified by Public Law 89-554, 80 Stat. 378, . . . takes the place of what was formerly 5 U.S.C. § 1009." Also, as recognized in *Seagram et al. v. Dillon* (CA DC, 1965) 344 F. 2d 497, "[t]he doctrine of 'exhaustion of administrative remedies' . . . encompasses the principle that a ruling of an administrative officer . . . will not be set aside by a court upon evidence which was not before that officer." Thus, plaintiff's interrogatories are not relevant to the subject matter of the action and cannot lead to the discovery of facts pertinent here, and are therefore improper and objectionable as "irrelevant." See *Walled Lake Door Company v. United States*, (DC Mich, 1962) 31 F.R.D. 258, where the Court sustained objections by ICC as to production of documents as "irrelevant, since in reviewing an administrative order the Court must base its decision solely on the evidence in the record." The only interrogatories that might be warranted in this kind of action would be those directed to the procurement of simple facts to clarify or narrow the issues involved in the agency's decision, e.g. were reliance had therein on "long standing practice" of the agency, without any amplification. That is not the case here. However, should plaintiff demonstrate the need for any facts to clarify or narrow the issue, then defendants stand ready to answer appropriate relevant interrogatories, as indicated in original point 4.

While it is probably obvious, one further reason why review in this action should be limited to the administrative record merits consideration. In a real sense, the merit of registrant Weather-Rite's request for suspension of the Cancellation proceeding is to be reviewed in this action, although Weather-Rite is not a party to the present action. Should the Court grant either of plaintiff's Prayers A or C, Weather-Rite would be adversely affected. Hence, in fundamental fairness to Weather-Rite, the Court should not consider any evidence beyond that considered by defendants in suspending the Cancellation proceeding, as to

which Weather-Rite has had an opportunity to state its position.

6. Defendants' suspension of plaintiff's Cancellation proceeding, at the request of the registrant Weather-Rite, is comparable to a judge's postponement of a trial, upon motion of a defendant. Where the administrative proceeding has the quality resembling that of a judicial proceeding, those responsible for the administrative determination should not be subjected to examination. *United States v. Morgan*, 313 U.S. 409, 422. "Just as a judge cannot be subjected to such a scrutiny . . . so the integrity of the administrative process must be equally respected." Accordingly, plaintiff's interrogatories are improper here.

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8. Interrogatories 1-5, 8, 12-15, 18-21 and 23, calculated to elicit information upon which plaintiff at most might hope to challenge the authority of defendant Reynolds in rendering the agency action complained of here, are clearly irrelevant. That authority cannot be questioned in this action. In paragraph 5 of its complaint, plaintiff alleged as a jurisdictional basis the pertinent part of the Administrative Procedure Act, 5 U.S.C. 701-706, and defendants admitted jurisdiction under 5 U.S.C. 704 as to Prayers A and C [see original answers 4 and 5 as well as proposed amended answers 4 and 5], the only prayers of any substance [see following point 9 as to remaining Prayer B]. However, an essential prerequisite for any jurisdiction under that Act is that the agency action complained of be *final*, as specified by 5 U.S.C. 104. Any questioning by plaintiff of defendants for the purpose of challenging defendant Reynolds' authority to render the agency action complained of could only impeach its finality, and hence the very jurisdiction plaintiff has pleaded. Consequently, these interrogatories are irrelevant and to force answers thereto would be pointless.

9. Interrogatories 6, 7, 16 and 17 only pertain to Prayer B, and therefore are irrelevant to the only real subject matter before this Court—viz. defendants' suspension of the Cancellation proceeding instituted by plaintiff. The Court has no jurisdiction where Prayer B is concerned, because there has been no final agency refusal to include defendants as members of the particular Trademark Trial and Appeal Board to eventually consider the merit of plaintiff's Cancellation petition, and also because the empaneling of any particular board is by law committed to agency discretion. Attention is directed to the paragraph beginning at the bottom of page 2 of defendant Reynolds' decision of February 16, 1967 (Exhibit D, forming part of defendants' recent Motion For Leave To Amend Answer), where it was held that in view of suspension of the Cancellation proceeding "the petitioner's request that the Commissioner designate himself a member of the panel hearing this case is moot at the present time." As for inclusion of defendant Reynolds in that panel, plaintiff made no such request, apart from eliciting no final refusal. The fundamental need for finality of agency action is emphasized by recent Court of Appeals decisions, e.g.:

Sikora v. Brenner, Comr. Patents (CA DC, May 8, 1967) 379 F. 2d 134, 153 USPQ 585

Phillips Petroleum Co. v. Brenner, Comr. Patents (CA DC, June 29, 1967) — F. 2d —, 154 USPQ 211

No petitioner for cancellation of a trademark can be permitted to pick his own particular board, any more than plaintiff could demand that any particular judge hear this action. However, by Prayer B, plaintiff would enlist the aid of the court to achieve the former, in clear violation of the constitutional principle of separation of powers. Manifestly plaintiff's Prayer B is a transparent sham, devoid of any substance. Consequently, the indicated interrogatories, pertaining only to service by defendants on

prior boards and empaneling of a board for plaintiff's Cancellation petition, are irrelevant.

11. Interrogatories 18, 22, 29, 30, 32, 33, 40, 49, 50, 53 and 54 require no answers since defendants have already provided plaintiff with the desired information. In *United States v. General Motors* (DC Ill. 1942) 2 F.R.D. 528, the Government asked "May interrogatories be used as a substitute for a bill of particulars, and may a party having voluntarily given specifications be required again to give them by interrogatories?" The Court replied "[t]he answer to both questions is no."

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11b. Interrogatory 22 asks if defendants denied plaintiff's request for an oral hearing on its petition to the commissioner. However, defendants have admitted the allegation in paragraph 23 of the complaint which concerns defendant Reynolds' "refusing to hold an oral hearing." Obviously, this interrogatory requires no answer.

11c. Interrogatories 29 and 30 require no answer. These request information about the issuance of Registration 811,725, the very registration plaintiff seeks cancellation of in the Patent Office! However, defendants have admitted paragraph 7 of the complaint which alleges the filing by plaintiff "[o]n or about July 28, 1966" of its "verified petition to cancel United States Trademark Registration 811,725, which issued July 26, 1966 to Weather-Rite Sportswear Co., Inc." The same admission embraces interrogatory 32 as well. As plaintiff well knows, the precise date of filing the cancellation petition was July 28, 1966, a matter of no material significance here.

11d. Interrogatory 33 inquires whether the "registration sought to be cancelled in Cancellation S. 738," i.e. Registration 811,725, is "involved in Civil Action 65C476," and what basis defendants might have for believing so. However, since defendants have admitted paragraph 17

of the complaint, which alleges recognition by the ruling member of the Trademark Trial and Appeal Board "that the civil suit is not concerned with the cancellation of respondent's registration here involved," answering this interrogatory is deemed unnecessary. Of course, defendants have no more of the pleadings in that suit than did the Board member then, whereas plaintiff is a party to that suit and therefore better informed. The position of defendants remains the same on that matter, and has been comprehensively stated by the ruling Board member in his decisions of December 9, 1966 and January 19, 1967, and by defendant Reynolds in his decision of February 16, 1967 (Exhibits B-D accompanying defendants' recent "Motion For Leave To Amend Answer"). Moreover, since these are essential components of the record which the Court will review, in accordance with 5 U.S.C. 706, "final sentence, these facts will be before the Court.

11e. Interrogatories 49 and 50 are subordinate to 33 discussed above, and appear to have been included only for their nuisance value. The same objection applies.

12. Interrogatories 10, 25, 31, 37-39, 44-47, 51, and 52 are clearly improper, in soliciting legal conclusions or opinions instead of facts. As stated by the Court in *United States v. General Motors* (DC Ill, 1942) 2 F.R.D. 528, "[i]t was never intended that a party should by interrogatories compel the adverse party to submit every item of evidence he expects to produce on the trial of the case [, n]or is a party expected in answer to interrogatories, to state his opinions on matters of law or fact." Interrogatory 25 is particularly unwarranted, since Weather-Rite (the owner of Application S.N. 172,441 which issued as Registration 811,725) is not a party here and plaintiff is fully informed of the position taken by the Patent Office concerning republication in S.N. 172,441, which plaintiff unsuccessfully sought in *Goodyear Tire & Rubber Co. v. Commissioner of Patents*, 238 F. Supp. 509, 144 USPQ

526; *affd.* 355 F. 2d 109, 148 USPQ 124; *cert. denied* 384 U.S. 941; 149 USPQ 906.

13. Interrogatory 11 is irrelevant, since the final clause excludes situations where any party consented to suspension. Here, the registrant specifically asked for the suspension (see Exhibit A accompanying defendants' "Motion For Leave To Amend Answer," particularly part b). However, it should be clear to plaintiff from the decisions of the ruling Board member and defendant Reynolds (Exhibits B-D accompanying that same motion) that no prior instances of suspending cancellation proceedings as such are relied upon. Hence, interrogatory 11 would be unwarranted even if "one or more" did not appear in its final clause.

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15. Interrogatory 24 is unreasonable on its face, since it is not limited to communications pertaining to Cancellation 8,738, the only record that is relevant to this action. Indeed, the interrogatory extends to any and all communications from Weather-Rite, regardless of the business at hand. However, plaintiff may be assured that all communications from Weather-Rite pertaining to Cancellation 8,738 are of record therein.

16. Interrogatories 25-28 and 34-38 are irrelevant to the only real issue before this Court, viz, whether or not defendants' suspension of the Cancellation proceedings, at the specific request of the registrant, was warranted on the record in the Cancellation proceeding. These interrogatories merely relate to events prior to issuance of Registration 811,725, or to the merits thereof. Mr. Roeming's representations in this Court on behalf of the Commissioner of Patents in Civil Action 2894-64 (corresponding to the case cited in point 12) are matters of judicial record, well known to plaintiff. Moreover, plaintiff has already been apprised of defendants' position concerning those representations, as having no bearing on suspension of

the Cancellation proceeding (see Exhibits C and D accompanying defendants' "Motion For Leave To Amend Answer," particularly the second and third paragraphs of Exhibit C, and the second paragraph on p. 2 of Exhibit D). Defendants therefore should not be compelled to repeat themselves needlessly (see authority cited in point 11). It might be added, however, that when Mr. Roeming made such representations, plaintiff had not even filed Civil Action 65 C-476 against Weather-Rite. The persistence of that suit and its issues, as represented to defendants in the record of the Cancellation proceeding, constitute the very basis for the suspension.

17. Interrogatories 41 and 42 are irrelevant, inasmuch as plaintiff has never so much as alleged that any of its imported goods have been impounded by the Bureau of Customs, or that its business has in any other way been interfered with, by reason of Registration 811,725 having been recorded with the Bureau of Customs under 15 U.S.C. 1124. The mere recording of that registration could not affect plaintiff adversely. Consequently, this line of questioning is clearly pointless. However, plaintiff should realize that the Patent Office plays no direct role in recording registrations with the Bureau of Customs (see 19 C.F.R. 11.15). Also, that recording would probably have entailed securement by the registrant Weather-Rite of a status copy, as provided for by Trademark Rule 2.6(a). It is evident from that rule that such a copy would not indicate the filing of a cancellation petition, as distinguished from actual cancellation.

OFFICIAL TRANSCRIPT OF PROCEEDINGS

Date: April 24, 1968

[1] Washington, D. C.
April 24, 1968.

The above cause came on for hearing of motions before
THE HONORABLE ALEXANDER HOLTZOFF, United States
District Judge.

Appearances:

For the Plaintiff:

FRANCIS C. BROWNE, Esq.
RICHARD C. BROWNE, Esq.

For the Defendants:

JERE SEARS, Esq.
Solicitor, Patent Office

[2] PROCEEDINGS

The Deputy Clerk: Goodyear Tire & Rubber Co. v.
Edward J. Brenner, Commissioner of Patents, Civil Action
445-67.

The Court: You may proceed.

Mr. Francis Browne: May it please the Court, my name
is Francis Browne. I represent the Goodyear Tire &
Rubber Company, the plaintiff in an action against the
Commissioner of Patents and the First Assistant Commis-
sioner of Patents acting in the name of the Commissioner.

This action is under the Administrative Procedures Act.

The particular matter before Your Honor this morning—

The Court: First tell me what the action is about.

Mr. Francis Browne: The action involves a cancellation
proceeding in the Patent Office with respect to a trademark
registration.

The Court: You say what it involves, but what is the cause of action?

Mr. Francis Browne: The gravamen of the action is that the Commissioner of Patents is not following the statutes and the rules—

[3] The Court: What are you trying to accomplish?

Mr. Francis Browne: This morning I am trying—

The Court: No, no; what are you trying to accomplish by the action?

Mr. Francis Browne: Compel the Commissioner to proceed with the cancellation which he has suspended.

The Court: What has the Commissioner done?

Mr. Francis Browne: The Commissioner has suspended all action on the cancellation proceeding which Goodyear Tire & Rubber Company has brought to obtain cancellation of a registration of Goodyear DeLuxe by Weather-Rite in the name of Weather-Rite Sportswear Co., Inc.

The Court: Just a moment. Let me get my bearings.

Who brought the proceeding for cancellation?

Mr. Francis Browne: The Goodyear Tire & Rubber Company, Your Honor.

The Court: To cancel a trademark issued to somebody else?

Mr. Francis Browne: That is correct, Your Honor, according to Section 14 of the Trademark Statute.

The Court: And the Commissioner has refused to proceed with the proceeding, is that it?

Mr. Francis Browne: He formerly instituted the [4] proceeding and then suspended it by motion of the registrant, Weather-Rite Sportswear Company.

The Court: On what ground did he suspend it?

Mr. Francis Browne: On the ground that there is a civil action pending between the Goodyear Tire & Rubber Company and Weather-Rite Sportswear in the Southern District of New York involving the registration, which is not true.

The Court: What do you mean, involving the registration? An action to do what?

Mr. Francis Browne: The action in the civil suit in New York between Goodyear and Weather-Rite is to enjoin Weather-Rite from using a trademark. There is no relief sought with respect to the registration in that proceeding.

The Court: Now tell me what is before me this morning.

Mr. Francis Browne: In order to develop the facts, first of all, the authority of the Commissioner to—

The Court: First tell me what is before me this morning.

Mr. Francis Browne: Before you this morning are exceptions to the Pretrial Examiner's recommendations on a set of interrogatories propounded by the plaintiff to the Commissioner of Patents.

[5] There was an objection, at first, by the Patent Office, to the whole set, on the ground that you could not serve interrogatories on the Commissioner under the Administrative Procedures Act, but that was held to be overruled by Judge Sirica and it was sent back to the Pretrial Examiner for a ruling on the specific interrogatories.

On the specific ruling the Pretrial Examiner overruled some of the objections and sustained others.

The plaintiff is here to review that action.

The Court: Those were interrogatories filed by the plaintiff against the Commissioner?

Mr. Francis Browne: That is correct.

The Court: Very well.

Mr. Francis Browne: The folder which I have handed up to Your Honor, the part to which I have turned sets forth the specific interrogatories which the Pretrial Examiner held need not be answered by the defendants.

The Court: The Pretrial Examiner held that they should be answered?

Mr. Francis Browne: Those are the ones that he held need not be answered. That is why the plaintiff is here asking—

The Court: Where are the interrogatories themselves?

[6] Mr. Francis Browne: The interrogatories themselves, the full set will be found on the tab which is marked 5, above the tab marked 5.

The Court: Is it the document entitled Plaintiff's First Set of Interrogatories to Defendants?

Mr. Francis Browne: That is correct, Your Honor, that is the complete set as submitted to the Pretrial Examiner.

The Court: Very well.

Mr. Francis Browne: The defendant made objections to all of the interrogatories seriatim.

The Court: What is before me are those interrogatories to which objections were sustained by the Pretrial Examiner, is that it?

Mr. Francis Browne: That is correct.

And the Pretrial Examiner's recommendation, which is before Your Honor, is tab 15. Tab 15 is the last page of the Pretrial Examiner's recommendation.

The Court: If you will pardon me a moment, I want to read the Pretrial Examiner's ruling.

(Pause.)

The Court: Now you may proceed, sir.

Mr. Francis Browne: The interrogatories which the Pretrial Examiner sustained objections to are recapitulated in the appendix to the plaintiff's objection, which is tab 23. Following page 13 of that material is an annex A, which sets forth the specific interrogatories on which the plaintiff asks a ruling.

The Court: Where are the specific interrogatories involved in this motion?

Mr. Francis Browne: If Your Honor is with me at tab 23, Plaintiff's Objections to Further Recommendations of Pretrial Examiner—

The Court: What I want is a copy of the interrogatories that are involved on this motion.

Mr. Francis Browne: I have appended those as appendix A to that paper, Your Honor, following page 13 of that paper.

The Court: What tab number?

Mr. Francis Browne: Tab 23. If Your Honor will start from the bottom and work up—

The Court: Tab 23?

Mr. Francis Browne: Appendix A. They are interrogatories numbered 1 through 54, but not all consecutively.

The Court: I see the interrogatories but I want only those which are involved in this motion.

Mr. Francis Browne: Those are the ones involved [8] in this motion for the plaintiff.

The Court: They are not all the interrogatories?

Mr. Francis Browne: Not all of them, no, Your Honor.

The Court: Very well, you may proceed.

Mr. Francis Browne: Taking the first interrogatory, there is a question of jurisdiction here of the Commissioner to perform the act that he did, of suspending the cancellation proceeding.

The statute provides the Secretary of Commerce may vest in himself any and all functions which are assigned by statute to the Commissioner. What we want to know is whether the Secretary of Commerce has ever vested such functions in himself.

The Court: I think all functions relating to patents which are reposed in the Secretary of Commerce have been delegated to the Commissioner of Patents. I am not going to investigate that.

Mr. Francis Browne: The Court would take judicial notice of the fact that they have? I would be satisfied with that, the Court taking judicial notice of the fact that the Secretary of Commerce has vested in himself and has redelegated to the Commissioner.

[9] The Court: I will inquire of counsel for the Patent Office is that the fact, Mr. Sears?

Mr. Sears: Where this case is concerned, yes.

The Court: No; the question is, has the Secretary of Commerce delegated his powers to the Commissioner of Patents?

Mr. Sears: That is correct.

The Court: Has he or hasn't he?

Mr. Sears: Yes.

The Court: Very well. The Court will take judicial notice of that.

Mr. Francis Browne: Interrogatory No. 5, the question is directed to the defendant Edward J. Brenner as to whether he has ever acted in person on a petition to the Commissioner of Patents under Rule 2146(a) of the Trademark Rules.

The Court: How is that relevant?

Mr. Francis Browne: It is relevant, Your Honor, because of the fact that the rules say that an aggrieved party may petition the Commissioner, and the Commissioner has not, to our knowledge, ever acted on any such petition; he has delegated it to another party.

The Court: Petitioning the Commissioner does not [10] mean that he has to act in person.

That is the difference between the administrative process and the judicial process. A judge can't have a subordinate act for him. But when it comes to the administrative process, that is one of the very essences of the administrative process, namely, that the head of the agency may delegate certain authorities to his subordinates.

Of course. I am quite sure that the Commissioner of Patents can't individually pass on all the petitions that are presented to the Commissioner of Patents.

Mr. Francis Browne: That is right, Your Honor. There is precedent, however, for a previous Commissioner having acted in person.

The Court: How is that relevant?

Mr. Francis Browne: It is relevant here, Your Honor, because the Commissioner himself is not only the administrative official but he, by statute, is a member of the Trademark Trial and Appeal Board, which is the tribunal before which this cancellation proceeding is pending. So he is in the unique situation of not only being the person to whom the petition is directed but he is a member of the body whose action is sought to be reviewed on that petition.

The Court: I think this interrogatory is too far afield.
[11] Mr. Francis Browne: Then the next interrogatory, No. 6, whether or not the Commissioner has ever designated himself as a member of the Trademark Trial and Appeal Board.

The Court: What is the answer to that, Mr. Sears?

All you had to do is to telephone and find out, Mr. Browne.

Mr. Sears: To my knowledge, Mr. Brenner has not, but Mr. Reynolds has, the other defendant.

The Court: Mr. who?

Mr. Sears: Mr. Reynolds, the First Assistant Commissioner.

We have two defendants here, Mr. Brenner, the Commissioner of Patents, and Mr. Reynolds, the First Assistant Commissioner of Patents.

Now the specific interrogatory here was whether Mr. Brenner had ever served on a Trademark Trial and Appeal Board, and to my knowledge he has not.

The Court: Very well. You have the information.

Mr. Francis Browne: Then—

The Court: A great deal of information sometimes required by interrogatories can be obtained by a telephone call and it isn't necessary to do superfluous paperwork or to trouble the Court with it.

[12] Mr. Francis Browne: We tried that, Your Honor, but defendant wouldn't stipulate what the facts were or answer them.

The Court: Very well.

Mr. Francis Browne: 6(a) then becomes moot because the answer was in the negative.

The Court: Very well.

Mr. Francis Browne: 8, on what date did the Commissioner of Patents, Edward Brenner, personally first see the Patent Office file of the cancellation in question?

In other words, I presume that in view of Your Honor's ruling the Commissioner isn't personally expected to look at all of these things—

The Court: No, of course not.

Mr. Francis Browne: Can we obtain a statement from the defendants as to whether he saw it or not?

The Court: No, I don't think so. He is entitled to see every file in the Patent Office, being the head of the Patent Office, and whether he has seen a particular file or not, he might not remember, in the first place.

It is like asking me whether I have ever seen a particular file in a particular case in this Court. I couldn't tell you.

[13] But in any event, it is irrelevant, even if the information exists.

Mr. Francis Browne: In the present case the First Assistant Commissioner represents that he was acting under direction of the Commissioner and—

The Court: I think this is all shadow boxing, if I may use the vernacular, Mr. Browne.

Mr. Francis Browne: All right. Then let's move on to No. 9. The question is whether the Commissioner of Patents has ever issued any regulations or caused to be issued by any person acting under his authority, any rules of practice, regulation or oral or written statement of policy setting forth guidelines to be followed by members of the Trademark Trial and Appeal Board or the Assistant Commissioner of Patents with respect to suspension of cancellation proceedings in the United States Patent Office pending the outcome of a civil action between the parties to such cancellation proceedings.

The Court: Now so far as this refers to rule or regulation, you can find that in the printed book of rules of the Patent Office.

When it comes to intramural communications between the Commissioner and his subordinates, you are not entitled [14] to see them.

Mr. Francis Browne: Your Honor, that may be one of the issues to be tried on the merits, as to whether we are entitled to know what instructions are given with respect to administration of the statute and the rules.

The Court: Well, it may be that would be one of the issues, but I am not going to determine now that you are entitled to it.

Mr. Francis Browne: All we need as an answer to this is whether any such have been issued, not what they are.

The Court: No.

Mr. Francis Browne: If the answer is that the only things that have been issued are those which are in print, we would accept that as an answer, because we don't know how to conduct proceedings before the Patent Office, Your Honor, unless we know what rules we are supposed to follow.

The Court: You are a patent lawyer, I presume.

Mr. Francis Browne: Yes, and I have read every rule and I don't find one which gives the Commissioner the authority to suspend cancellation proceedings.

The Court: It doesn't have to. That is a matter of discretion. Just as I don't know of any rule of civil [15] procedure which expressly authorizes the Court to stay proceedings, yet we stay proceedings constantly.

That is part of the discretion of the administrative tribunal.

Mr. Francis Browne: That is exactly the point I want to reach, is it discretionary. If it is discretionary, then we can go to the merits of whether he abused this discretion.

The Court: No, no, I don't think I am going to require an answer to such an interrogatory.

Mr. Francis Browne: No, 10, under what statute, rule or regulation or statement of policy did the defendants contend the Commissioner of Patents or anyone acting under his authority may suspend all action in a trademark cancellation proceeding in the Patent Office.

The Court: That is an argumentative question. I think the Pretrial Examiner was quite correct in sustaining an objection to that.

Mr. Francis Browne: I would just like to make of record the fact that the Commissioner cited no such authority in

his suspension and the Pretrial Examiner didn't cite any, either.

The Court: He doesn't have to. A judge very [16] often doesn't cite authorities for his action, sometimes he does, but there is no compulsion to do it.

Mr. Francis Browne: Again I say, Your Honor, we will take the position that that is another difference between the judicial process and the administrative process. The administrator has to be bound by published rules.

The Court: Why don't you confine yourself to trying this case instead of trying to conduct an investigation of the Patent Office?

Mr. Francis Browne: I am only trying to find out the facts, Your Honor.

The Court: Let's pass on to the next.

Mr. Francis Browne: 11, what is the cancellation docket number of each cancellation proceeding in the Patent Office, except the one in suit, in which action such proceeding was suspended by the Patent Office pending the outcome of a civil action between the parties?

The Court: That is an improper interrogatory.

Mr. Francis Browne: The Commissioner says that this is consistent with previous actions and he hasn't said what previous actions he is talking about.

The Court: That doesn't make any difference.

Mr. Francis Browne: 16, has defendant Reynolds [17] in his capacity as First Assistant Commissioner of Patents, ever been designated, or designated himself—

The Court: You have the answer to that.

Mr. Francis Browne: That has been answered.

And if the answer is in the affirmative, under 17, identify each such case and indicate the disposition thereof. This is to test the inconsistencies of the action of the First Assistant Commissioner, arbitrary, capricious, and inconsistent.

The Court: I am reminded of Ralph Waldo Emerson, who said that a foolish consistency is the hobgoblin of small minds, or words to that effect.

Suppose you prove that he has been inconsistent. No two cases are alike that are within the discretion of the judicial or quasi-judicial officer.

No, I think you will have to confine yourself to this particular case.

Mr. Francis Browne: Then the next question, No. 18, on what date, if at all, did Edward J. Brenner, the Commissioner, see the cancellation petition?

The Court: I see no relevancy to that.

Mr. Francis Browne: Then the next question, 19, did Edward J. Brenner, the Commissioner, authorize and [18] direct Edward L. Reynolds, the First Assistant Commissioner, to render a decision on plaintiff's petition to the Commissioner, in person?

The Court: I don't think you are at liberty to make that inquiry.

Mr. Francis Browne: No. 20, under what authority did defendant Reynolds act on plaintiff's petition to the Commissioner of Patents, in person, in cancellation so-and-so on February so-and-so?

The Court: That is an argumentative question.

Mr. Francis Browne: 21, has defendant Reynolds acted on any petition to the Commissioner of Patents under the trademark rules?

The Court: I will sustain the Pretrial Examiner's ruling.

Mr. Francis Browne: No. 23, does defendant Reynolds, in his capacity as First Assistant Commissioner of Patents, have supervisory authority over the Trademark Trial and Appeal Board or the members thereof?

The Court: I will disallow every interrogatory that doesn't deal with the particular case to which you are a party.

Mr. Francis Browne: Well, this does pertain to [19] a case to which we are a party.

The Court: No, I will sustain the Pretrial Examiner.

Mr. Francis Browne: 25, did Application Serial No. 172,441—that is, the application on which the registration

in question is in ultimate issue—comply with all requirements of the statute and rules prerequisite to issuance of registration thereon at the time it was published in May of '64?

The Court: That is not a proper interrogatory. You are asking for a ruling on a question of law by an interrogatory.

And No. 26 is likewise inappropriate.

You can search the Official Gazette.

Mr. Francis Browne: May I interject at this point, Your Honor, the reason for these particular questions goes back to a case which was before the District Court here and the Court of Appeals, where we sought to compel the Commissioner of Patents to publish this mark a second time for opposition because it was not in condition for registration, and he represented to this Court, Your Honor, that the day the registration would issue we could petition to cancel. We petitioned to cancel and then he turns around and suspends [20] the proceedings. That is why we are here.

The Court: He doesn't dismiss the proceedings; he stays it during the pendency of a civil action between the parties.

Mr. Francis Browne: Meanwhile we are denied due process.

The Court: I am not going to ask you to read every interrogatory. I can read them myself. I have them before me.

Mr. Francis Browne: I think 33, Your Honor, is a proper question. That goes right to the heart.

The Court: Let me read that.

Mr. Francis Browne: 33, is the registration sought to be cancelled in Cancellation 8,738 involved in Civil Action 65C476, pending in the United States District Court for the Southern District of New York?

The Court: I think you can answer that yourself by looking at the file in that case.

Mr. Francis Browne: The Commissioner, on the other hand, has acted in this case without any evidence to support himself, and I wanted to get an admission of fact, really.

The Court: You haven't got the right to inquire [21] into the workings of the Commissioner's mind.

Mr. Francis Browne: This isn't pertaining to his mind, Your Honor.

The Court: I have ruled. I won't allow that interrogatory.

Mr. Francis Browne: Numbers 34 and 35 and 36 and 37 and 38 are grouped together on the question of whether or not the Commissioner did represent to this Court, as a basis for his dismissing our previous complaint, that he would allow a cancellation proceeding to be conducted.

The Court: All you need do is to order a transcript of what was said in this Court.

Mr. Francis Browne: Then 39, there is a question as to whether, do the defendants have a duty, under Section 14 of the Trademark Act of 1946, to conduct cancellation proceedings. That is a question they can answer yes or no.

The Court: Those are questions of law that you can argue one way or the other.

Mr. Francis Browne: Well, he could say whether he has the duty or not, because I contend that he is derelict in his duty in not conducting the cancellation proceeding.

The Court: 49, I think, if I may say so, is an impertinent question, did either of the defendants or anyone [22] acting under their authority read any of the pleadings of record in Civil Action number so-and-so.

Mr. Francis Browne: Does Your Honor hold that is pertinent?

The Court: I think that it is not allowable and in addition to that, it is impertinent and discourteous.

Mr. Francis Browne: Well, if Your Honor please, this is the basis—

The Court: I know you did not mean to be discourteous

but it is discourteous to the Commissioner to say to him did you read the pleadings in such-and-such an action.

Mr. Francis Browne: This is the very thing upon which he based his suspension of the proceedings, Your Honor. I think I am entitled to know whether he did read them or not.

The Court: No, you are not.

You are entitled to contest his action, his decision, but you are not entitled to pry into his office and ascertain how he did his work.

Mr. Francis Browne: I think I would be entitled to know whether or not there is any reference in the records of the Patent Office from the Clerk of the Southern District of New York to the pendency of the action.

The Court: You didn't ask that.

[23] Mr. Francis Browne: I believe that was allowed by the Pretrial Examiner.

The Court: That is No. 50.

Mr. Francis Browne: 50 says do any of the pleadings seek cancellation.

The Court: Well, you can find that out for yourself because the pleadings in the United States District Court are in the public files.

Mr. Francis Browne: And then again going to what recourse we would have to show that we have—

The Court: 51 asks a question of law.

The same as to 52.

53 is obviously inappropriate. It is like asking a judge why did he make such-and-such a decision, on what did he base it. You can't do that, Mr. Browne.

Mr. Francis Browne: Well, I was under the erroneous impression, Your Honor, that in the administrative process you can inquire into the basis for the administrative officer refusing to act.

The Court: When an administrative officer acts in a quasi-judicial capacity he is not subject to being questioned, any more than a judge is.

Mr. Francis Browne: Then I am mistaken in my [24] understanding of the purpose of the Administrative Procedures Act, Your Honor.

The Court: I think you are wasting your time, Mr. Browne. I think you ought to confine yourself to trying to show that the action was erroneous, but this is not the way to do it.

Mr. Francis Browne: Our problem here, Your Honor, the defendant takes the position—

The Court: I have ruled. I am not going to allow these.

Mr. Francis Browne: All right, Your Honor.

The Court: Do you care to be heard, Mr. Sears?

Mr. Sears: May it please the Court, defendants have also filed objections to this very same further recommendation of the Pretrial Examiner.

In our original folder the Pretrial Examiner's recommendation is tabbed as D.

The Court: Yes, I have read it. I have read it during Mr. Browne's argument.

Mr. Sears: In the third paragraph of the recommendation, Mr. Finn, the Pretrial Examiner, seemingly agrees with the position defendants have consistently taken in this action that under the Administrative Procedures Act [25] discovery simply has no proper place, that review by the Court would be on the written record made in the Patent Office.

The Court: Well, I am going to overrule the objections to the Pretrial Examiner's recommendations. You may submit an order accordingly.

Mr. Sears: Does this mean, Your Honor, that the defendants will not have to answer any of the interrogatories?

The Court: The defendant doesn't have to answer any of the interrogatories that were before the Court on this motion.

Mr. Sears: There is a second motion before this Court. I am mistaken, Your Honor.

The Court: I am taking one at a time.

Now what is the next motion?

Mr. Sears: The next motion is brought by defendants. It is really objections to that part of Mr. Finn's recommendation that would have defendants answer the other interrogatories not already discussed.

The Court: Where are the other interrogatories to be found in the folder?

Mr. Sears: I can refer to the other interrogatories, Your Honor, in their full text. This is tab A of the original folder.

[26] We have to figure out from deduction just what interrogatories Mr. Finn thought the defendant should answer because he doesn't enumerate them.

The first one would be No. 2.

The Court: No. 2 you don't have to answer.

Now what is next?

Mr. Sears: The next one would be No. 3.

The Court: I don't think that is a proper interrogatory.

Mr. Sears: The next is 4.

The Court: What is the objection to 4?

Mr. Sears: The objection there is that we have virtually conceded as much through our answer. We don't contend otherwise. He was Commissioner.

The Court: Very well. Then No. 4 is superfluous.

Mr. Sears: That is true. It is assumed by the very nature of the suit. He wouldn't be a party here.

The Court: What is next?

Mr. Sears: No. 6. I have already answered that orally this morning. He is not.

The Court: I wish you had a set typed out separately as to the interrogatories to which you are objecting.

[27] Mr. Sears: Yes, I regret that, Your Honor. I thought one text would suffice.

The Court: What is next?

Mr. Sears: No. 7. This question is premature.

The Court: Why is No. 7 objectionable?

Mr. Sears: For the simple reason no board has been impaneled, I can say that much, no board has been impaneled to—

The Court: I think you should answer No. 7. That is just a routine question relating to a particular action.

Mr. Sears: 7(a), I suppose that would go along with 7.

The Court: Yes.

Mr. Sears: No. 12. It's on page 4. This inquires when Assistant Commissioner Reynolds assumed office.

The Court: That is a matter of record. Why don't you telephone the Patent Office and find out, Mr. Browne?

Mr. Francis Browne: I have asked Mr. Sears to tell me informally and he won't.

The Court: What is the date?

Mr. Sears: Personally, I don't know the answer. I will have to ask Mr. Reynolds.

The Court: Well, you find out and telephone Mr. [28] Browne. The Court's time oughtn't to be wasted this way, you know.

Mr. Sears: 13, has Mr. Reynolds continuously held the office from that date.

The Court: I don't see any reason for allowing that.

Now what else?

Mr. Sears: 14.

The Court: Yes.

What else?

Mr. Sears: 15.

The Court: You can answer that. That is a matter of record. While the question shouldn't be asked because all you have to do is, as I say, telephone and find out, but it is there and you can answer it.

Mr. Sears: 16. This inquires whether the First Assistant Commissioner Reynolds has ever designated himself or served as a member of the Trademark Board.

The Court: Very well, what is next?

Mr. Sears: 22. It is on page 5. 22 is really answered in the record.

The Court: Very well, what is next?

Mr. Sears: 24.

[29] The Court: Why do you object to 24?

Mr. Sears: 24. Your Honor, is not confined to the matter at hand. In other words, it is conceivable—

The Court: If 24 is limited to this case would there be any objection to it?

Mr. Sears: We could give the answer here. The answer is no, there is no other correspondence not found in the respective files.

The Court: Very well, you have your answer.

Mr. Francis Browne: I think that probably answered it. I don't see why he objected.

The Court: What is next, Mr. Sears?

Mr. Sears: 27. did a registration ever issue under Registration No. 780649—

The Court: What is the objection to that?

Mr. Sears: It is not relevant to the particular cancellation matter here. I think this refers to a number applied to an imminent registration that was recalled.

The Court: Registration 780649, is that the matter involved in this case?

Mr. Sears: No, the registration here is 811725, a different number.

The Court: But what is 780649, what is its connection with this case?

Mr. Sears: At one time, I believe, the application of Weather-Rite for registering their mark was about to issue as a registration, and I believe this number was applied, but then it was revoked.

The Court: Then what is the objection to the interrogatory?

Mr. Sears: I suppose if we answer any interrogatories we could answer that.

The Court: I think you can answer that. I think 27 is all right.

Mr. Sears: 29.

The Court: Isn't that the same as 27? I mean it is ruled by the same point.

Mr. Sears: Well, it is related to it, yes.

The Court: I think I will allow 29.

What is next?

Mr. Sears: 30. That is the very registration they seek to cancel.

The Court: I think you can answer that.

Anything else?

Mr. Sears: 31, on what date was registration, so forth, first subject to cancellation under Section 14 [31] of the Trademark Act of 1946.

The Court: That is a mixed question of law and fact.

What is next?

Mr. Sears: 32, on what date did the defendants receive the petition of plaintiff to cancel that prior registration.

The Court: Why shouldn't that be answered?

Mr. Sears: We could answer it. They already know the information, though. They already know when it was filed. They did the filing.

The Court: Is it in the public file?

Mr. Sears: Yes, it's public.

The Court: They did the filing?

Mr. Sears: Plaintiffs actually filed it.

The Court: I see. Very well.

What is next?

Mr. Sears: We go over to page 9. Interrogatory 41, has the Commissioner of Patents furnished status copies of registration, so forth, to anyone.

The Court: Very well.

What is next?

Mr. Sears: Should that be answered or not?

[32] The Court: What is next?

Mr. Sears: Of course, 41(a), if the answer to 41 is in the affirmative, did such copies include a reference to the fact that such registration is the subject of pending cancellation.

The Court: Very well.

Anything else?

Mr. Sears: 42. have the defendants received any communication, either orally or in writing, from the Bureau of Customs, with respect to that given registration.

The Court: Very well.

Mr. Sears: 42(a) is, of course, contingent on 42.

The Court: Very well.

Mr. Sears: 42(b), (c).

The Court: I see the entire 42 group is really one and the same.

Anything more?

Mr. Sears: 48, on page 10, has the Commissioner of Patents taken any steps to—

The Court: Very well.

What is next?

Mr. Sears: 49, has either of the defendants or anyone acting—I think we have already discussed 49.

[33] The Court: I think I passed on that.

Mr. Sears: I think so.

The Court: What is next?

Mr. Sears: And that is all.

The Court: I will allow interrogatories 7, 15, 27, 29 and 30.

I will hear you, Mr. Browne, as to the other interrogatories, if you wish to be heard.

Mr. Sears: Could I make one further comment, Your Honor, before I sit down?

The Court: Yes, surely.

Mr. Sears: The defendant sought clarification from the Pretrial Examiner as to who should answer, the counsel for the defendants, Mr. Schimmel, say, or the defendants personally, Mr. Brenner and Mr. Reynolds, and we have precedent from the District Court here.

The Court: What is your point?

Mr. Sears: A question of who personally should do the answering, Mr. Brenner or Mr. Reynolds—

The Court: It doesn't make any difference. One of them should swear to the answers.

Mr. Sears: Would it be sufficient if Mr. Schimmel, the Solicitor—

[34] The Court: Oh, I think so.

Mr. Sears: —could answer, to give the information?

The Court: Oh, yes, provided he wants to swear to the answers.

Mr. Sears: All right, he will swear to them.

The Court: Now do you wish to be heard, Mr. Browne?

Mr. Francis Browne: Nothing further, Your Honor.

The Court: Then I will allow interrogatories 7, 15, 27, 29 and 30, and disallow the balance.

Counsel may submit an order accordingly. I suggest it is better to have a single order on both motions.

(The hearing stood concluded.)

Order

The respective objections of plaintiff and defendants to the "Pretrial Examiner's Further Recommendation on Defendants' Opposition to and Motion to Strike Interrogatories" having come on for hearing, it is this 2nd day of May 1968, ORDERED

(1) that plaintiff's objections are overruled:

(2) that defendants' objections are overruled insofar as they pertain to interrogatories 7, 15, 27, 29 and 30 (and all subdivisions thereof), but are otherwise sustained; and

(3) that defendants may have fifteen (15) days from this date to file answers to the foregoing enumerated interrogatories, which answers may be made under oath by their attorney, the Solicitor of the United States Patent Office.

.....
Judge

Approved as to Form:

FRANCIS C. BROWNE

Attorney for Plaintiff

[Filed May 15, 1968]

Answers to Interrogatories

Pursuant to the order dated May 2, 1967, defendants, through their attorney under oath, answer interrogatories 7, 15, 27, 29 and 30 of "Plaintiff's First Set of Interrogatories to Defendants" as follows:

7. No.

7a. [No answer required in view of negative answer to 7.]

15. Yes.

27. No. [Registration No. 780,649 was withdrawn on the very day it would have issued, in compliance with a court restraining order obtained by plaintiff the day before. See CA DC Appeal No. 19,276, JA-74, 75 and 168, also Brief for Appellant, p. 4].

29. Yes.

29(a). 811,725; July 26, 1966.

30. Yes.

JOSEPH SCHIMMEL
Joseph Schimmel,
Solicitor,
United States Patent Office,
Attorney for Defendants

STATE OF VIRGINIA }
COUNTY OF ARLINGTON } S.S.

Signed and sworn to before me on May 15, 1968.

VIRGINIA J. SIGMON
Notary Public

My Commission Expires October 5, 1971.

Plaintiff's Exhibit 4**Plaintiff's First Set of Interrogatories to Defendants**

Plaintiff requests that each defendant answer, under oath, in accordance with Rule 33 of the Federal Rules of Civil Procedure, each and all of the following Interrogatories:

7. Has the Commissioner of Patents designated the members of the Trademark Trial and Appeal Board who are to hear Cancellation 8,738?

Answer: No.

7a. If the answer to Interrogatory 7 is in the affirmative, state the names and titles of each person thus designated and the date on which such designation was made.

Answer: [No answer required in view of negative answer to 7.]

15. Was defendant, Edwin L. Reynolds, First Assistant Commissioner of Patents on February 16, 1967?

Answer: Yes.

27. Did a registration ever issue under Registration No. 780,649?

Answer: No. [Registration No. 780,649 was withdrawn on the very day it would have issued, in compliance with a court restraining order obtained by plaintiff the day before. See CA DC Appeal No. 19,276, JA74, 75 and 168, also Brief for Appellant, p. 4].

29. Did the Commissioner of Patents issue a registration to Weather-Rite Sportswear Co., Inc. on application Serial No. 172,441?

Answer: Yes.

29a. If the answer to Interrogatory 29 is in the affirmative, state the number of the registration and the date of issue.

Answer: 811,725; July 26, 1966.

30. Did a registration issue under Registration No. 811,725?

Answer: Yes.

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OFFICIAL TRANSCRIPT OF PROCEEDINGS

Before: JUDGE ALEXANDER HOLTZOFF

Washington, D. C.

October 24, 1968.

• • • • •

[0] The above-entitled action came on for trial before the HONORABLE ALEXANDER HOLTZOFF, United States District Judge.

APPEARANCES

On behalf of the plaintiff:

FRANCIS C. BROWNE, Esq.

On behalf of the defendant:

JERE SEARS, Esq.

PROCEEDINGS

[3] The Deputy Clerk: The case of Goodyear Tire & Rubber Company versus Edward J. Brenner, Commissioner of Patents and Edwin L. Reynolds, First Assistant Commissioner of Patents, Sub Nomine, the Commissioner of Patents.

The Court: You may proceed.

Mr. Browne: May it please the Court. My name is Francis Browne. I represent the plaintiff, Goodyear Tire & Rubber Company in this action against the Commissioner of Patents and First Assistant Commissioner of Patents, Mr. Brenner and Reynolds, respectively.

I would like to move the admission for the purpose of this case, Mr. Alan Cooper of Tennessee. He will not participate in oral argument, but I would like to have him seated at counsel table.

The Court: Mr. Cooper, it gives the Court a great pleasure to admit you.

Mr. Browne: Also at counsel table is Mr. Richard C. Browne, a member of the Bar of this Court.

This is an action brought under the Administrative Procedure Act to compel the Commissioner of Patents to go forward or allow to go forward a cancellation proceeding in regard to a trademark registration, [4] this cancellation proceeding having been suspended now for over two years. This matter was before this Court and the Court of Appeals in a previous posture, namely, before issuance of the registration which is now involved in the cancellation.

The Court: There is a proceedings before the Commissioner. That is a proceeding to cancel registration of trademarks, is that it?

Mr. Browne: That's correct, Your Honor.

The Court: And you're seeking relief in the nature of mandamus?

Mr. Browne: That is correct, Your Honor, for administrative action unlawfully withheld or unreasonably delayed, or if it is a matter of discretion, we contend that discretion has been abused and the action in arbitrary, capricious, without reasonable basis, contrary to the statute and in excess of statutory jurisdiction. Before the registration was issued the plaintiff sought to require the Commissioner to publish the trademark after the applicant considerably amended his application.

The Court: I'm curious to know just what is the trademark.

Mr. Browne: The trademark, (I hesitate to use the word trademark) what is shown in the registration sought to be [5] cancelled, is Goodyear Deluxe by Weatherite, for a line of rainwear and boots and shoes, things of that nature. And the registrant's name is Weather-Rite Sportswear Company, Inc., New York.

The Court: But the registrant doesn't use the name Goodyear, does it?

Mr. Browne: The registrant uses "Goodyear Deluxe by Weatherite" on the goods which it sells, and they obtained a registration of "Goodyear Deluxe by Weatherite" from the Commissioner who refused to publish the mark a second time after the applicant had amended his application and because it was refused registration. But the Commissioner refused, and this Court refused to compel him to publish it a second time so we could file an opposition to maintain the status quo.

The Court of Appeals affirmed the judgment of this Court and remitted us to our remedy under Section 14—

The Court: Section 14 of what?

Mr. Browne: Section 14 of the Trademark Act of 1946.

The Court: No. Please refer to the code. You know, I can't possibly have every statute that has ever been passed by Congress in my library. We always ask for citations.

[6] Mr. Browne: It is Title 15 United States Code, 1064. At the time we sought to have the Commissioner publish the mark again so we could oppose under Title 15 United States Code 1063 this Court and the Court of Appeals said we had an adequate remedy by way of petition for cancellation under Title 15 of the United States Code 1064 on the day the registration would be issued, therefore we would not be irreparably damaged by allowing the mark to be registered, because we had adequate remedy at law by way of a petition for cancellation.

Two days after the registration was issued, the plaintiff filed a petition for cancellation pursuant to Title 15 United States Code 1064, and the procedures were duly instituted in accordance with that section of the statute and the trademark rules and practice in the patent office. The registrant answered. Discovery was begun by way of subpoena to take the discovery deposition of a vice-president of the registrant company. At that juncture, the registrant moved to suspend proceedings in the cancellation on the ground that there was a civil action pending in the United States

District Court for the Southern District of New York between the plaintiff, The Goodyear Tire & Rubber Company and registrant, the Weather-Rite Sportswear Company, Inc. [7] The Court: Before you proceed. I would like to inquire of both counsel, in order that I may make my schedule accordingly, are you going to offer any testimony or are you going to submit the matter on oral arguments?

Mr. Browne: The matter will be submitted on the record of the Patent Office and other documentary evidence. I don't intend to call any live witnesses.

The Court: How long will your argument take?

Mr. Browne: I would suspect that my opening statement plus my trial brief would take care of all argument necessary, and I would simply put in the record to constitute the evidence in the case.

The Court: I assume the Patent Office is not going to offer any testimony, is that correct?

Mr. Sears: No, Your Honor. Just parts of the cancellation file.

The Court: I mean you're not going to call any witnesses?

Mr. Sears: No, Your Honor.

The Court: Thank you.

Well, suppose we take our luncheon recess at this time.

(Whereupon, the Court recessed to reconvene at 1:45 p.m.)

[8] AFTERNOON SESSION

1:47 p.m.

Judge Holtzoff: You may proceed.

**Opening Statement on Behalf of Plaintiff
by Francis C. Browne**

(Resumed)

Mr. Browne: Thank you, Your Honor.

In this action, as I stated just before the lunch recess, we are seeking to compel the Commissioner of Patents to

allow a cancellation proceeding to go forward, in other words, it is in the nature of a mandamus action. Because—

Judge Holtzoff: You didn't state in your memorandum on what ground the Commissioner stayed the proceedings. That is the important thing, isn't it?

Mr. Browne: The facts are, Your Honor, there is a civil action pending between The Goodyear Tire and Rubber Company and the Weather-Rite Sportswear Company, Incorporated, in the United States District Court for the Southern District of New York.

Judge Holtzoff: Oh, that doesn't appear in the memorandum.

Mr. Browne: Oh, I thought it did. I am sorry. It certainly is a fact.

[9] Judge Holtzoff: And did the Commissioner stay the proceedings pending that action?

Mr. Browne: Our point is, Your Honor, the action does not involve the registration.

Judge Holtzoff: I understand but I want to know what reason the Commissioner had or gave, whether it is good or bad, for staying the proceeding.

Mr. Browne: In order that I will not misquote the Commissioner, in paper number 22 dated February 16, 1967, in the Patent Office file—

Judge Holtzoff: I haven't got the file before me.

Mr. Browne: That is correct. I would go as directly as possible to the critical paragraph which says—this is the Assistant Commissioner Reynolds speaking for the Commissioner:

“It may be conceded that there is nothing which requires this office to suspend proceedings in a situation such as is here involved. But there is certainly nothing to preclude such suspension and it is in accordance with the practice which has been consistently followed in similar cases for many years. This practice, it may be noted, was recently approved by the United States District Court for the Southern District of New York in an opinion dated January 19,

1967, in *Tuvache Emilio Pucci, International, Incorporated, et al*, 65 Civil 3730, in which the [10] court declined to suspend action pending determination of a related case by the Trademark Trial and Appeal Board and clearly indicated that the court case should take precedence."

Judge Holtzoff: Well, now, who are the parties to the action of the court?

Mr. Browne: The parties to the action in the court in New York are The Goodyear Tire and Rubber Company and Weather-Rite Sportswear Company, Incorporated, the same parties involved in the cancellation in the Patent Office.

Judge Holtzoff: And what relief is asked in the New York Case?

Mr. Browne: The plaintiff seeks injunction against all use of Goodyear by the defendant.

Judge Holtzoff: Well, isn't it sensible to suspend or to stay proceedings in one tribunal or another instead of both going on at the same time?

Mr. Browne: It didn't work out that way, Your Honor, in the *Diplomat Tie, Webley versus Diplomat Tie* case, in the District Court for the District of Maryland. They went through that whole trademark infringement and unfair competition case and at the conclusion Judge Watkins refused to do anything regarding cancellation of the registration which, in his opinion, he said had really been litigated by [11] consent in the action, and yet he refused to do anything. He said that is the province of the Patent Office.

Judge Holtzoff: Yes, I know, but isn't it sensible for the Patent Office to stay action until the litigation is determined and then to act?

Mr. Browne: Not necessarily, Your Honor.

Judge Holtzoff: No, not necessarily, but I say isn't it sensible?

Mr. Browne: Not in this case, Your Honor. No. We say it is an abuse of discretion in this case because two years ago the Patent Office suspended the cancellation pro-

ceeding and the litigation in New York Still isn't out of the pretrial stage.

Now, when we applied for relief at the request—at the suggestion of the courts of the District of Columbia by way of petition for cancellation, the Administrative Procedure Act entitled us to a speedy remedy and we say the Commissioner of Patents has no right to hold up for two years a cancellation pending disposition of a case in a Federal court which doesn't involve the registration sought to be cancelled.

Judge Holtzoff: Well, you brought a suit against the opposing party for infringing your trademark, is that it?

Mr. Browne: Our common law trademark, Goodyear.

[12] Judge Holtzoff: Yes. Well, now, if you prevail, then that would be res judicata, wouldn't it, that you are entitled to cancellation of the other trademark?

Mr. Browne: No, Your Honor. The Court of Appeals of this Circuit last said that rule 13(a) as to the compulsory counterclaims doesn't apply in the Patent Office and wouldn't be res judicata because the right to register is not the same as the right to use.

Judge Holtzoff: That wasn't my question. I am not talking about compulsory counterclaims. I say as between the parties that would be res judicata, wouldn't it?

Mr. Browne: No, Your Honor, not as to the right to maintain a registration because this registration has a disclaimer of the words Goodyear Deluxe, and—

Judge Holtzoff: Oh.

Mr. Browne: The registrant would argue that he could still retain that registration even though he doesn't have a right to use Goodyear.

Judge Holtzoff: Well, what are you seeking to cancel?

Mr. Browne: We are seeking to cancel the entire registration because it includes the words Goodyear Deluxe by Weatherite. Now, Goodyear is one factor, Deluxe is another, [13] and Weatherite is another.

Judge Holtzoff: Suppose the word Goodyear was out of that trademark. You wouldn't object, would you?

Mr. Browne: If it was out of the trademark we would still have the problem of the Deluxe and Weatherite combination but I think if the thing would be settled on that basis we probably would settle. As a matter of fact, Weatherite has a separate registration of just the word Weatherite alone and we have not attacked that. Weatherite alone.

Judge Holtzoff: Anybody has a right to use the word deluxe. I say anyone has a right to use the word deluxe. I can see very well how you would object to somebody else using the word Goodyear.

Mr. Browne: And we certainly do.

Judge Holtzoff: And what I don't understand offhand is how the Patent Office ever registered a trademark in the first place with the word Goodyear in it.

Mr. Browne: Well, the courts in this circuit told us that we could have it cancelled after it issued.

Judge Holtzoff: No, they didn't say that.

Mr. Browne: Pardon me. I am sorry. They said we could petition to cancel, I am sorry.

Judge Holtzoff: No. I am asking you—perhaps I [14] ought to ask Mr. Sears after he—when he addresses the court, on what theory the Patent Office would register a trademark for, say, John Smith with the name Goodyear in it.

Mr. Browne: I am amazed that they did, Your Honor, but that is why this is so important to us and why we want a determination by the Patent Office, the one who issued the registration, to come first and then the courts in New York—

Judge Holtzoff: You practically brought two proceedings against two different people.

Mr. Browne: No, same people.

Judge Holtzoff: Involving the same issue.

Mr. Browne: No. The same person involving the same mark. Goodyear Deluxe by Weatherite.

Judge Holtzoff: Oh. Very well. Now, I think it is good judicial administration to stay one or the other until one

comes to conclusion instead of letting two cases in two different tribunals proceed at the same time.

Mr. Browne: Well, that is why we are here, Your Honor. We don't feel that way because the issues are different. The issue of right to retain this registration is not before the civil court. Now, the civil courts have taken the position that they are entitled to the expertise of the Patent Office before they pass on a case. There is a presumption of correct- [15] ness that attaches to the Patent Office action and now we have the Patent Office saying, as in the Emilio Pucci case, we have the Gaston Alphonse act. The court in that case said, on trademark cases we don't have to wait.

Judge Holtzoff: When was the New York action filed?

Mr. Browne: February of 1965.

Judge Holtzoff: 1965.

Mr. Browne: That is right, Your Honor.

Judge Holtzoff: You say it isn't at the pretrial stage yet.

Mr. Browne: That is correct, Your Honor, and that is why we are complaining about the Patent Office holding up two years on our cancellation.

Judge Holtzoff: Well, I understood that the civil calendar in New York was pretty well up to date.

Mr. Browne: Well, the fact is that under the pretrial procedure it has been assigned to former Chief Judge Ryan, personally to him, and the defendant took 14 months from just this current month in which to come up with findings of fact which they would like to have the plaintiff stipulate. The plaintiff prior to that time had nine months in which to prepare proposed findings to see if the defendant would stipulate. That is where the case stands right now and there [16] is not much prospect of it coming to trial in any immediate future. The Patent Office could have decided this case and had it out and up in the court by that time.

Judge Holtzoff: You are not required to take nine months, are you? You are only permitted. If you want expedition, you can submit whatever papers you have to the court.

Mr. Browne: This took nine months for the plaintiff to get its material together and it resulted from eight volumes of proposed facts going back to 1898 when the company was first founded and going product line by product line to show the good will it had in Goodyear and all the facts to support it, so it took nine months for the plaintiff to do all that and yet the defendant came in this month with two little booklets about an inch thick which it took them 14 months to compile and they have been, only been in business since 1957.

Judge Holtzoff: Well, now, that is water under the bridge, isn't it? Now—

Mr. Browne: It is not under the bridge yet, Your Honor. That is the trouble. The thing is pending up there and we don't know when it is going to be decided.

Judge Holtzoff: Well, why don't you apply to the judge in the Southern District of New York for—to grant the case?

Mr. Browne: We are handling it as expeditiously as [17] the judge will permit us. He has given the people the time. Each time that—in fact, they were supposed to have had this material in six months ago and they kept getting extensions of time and they are doing the same delaying tactic there that they did in the Patent Office in getting this proceeding stayed.

Judge Holtzoff: They didn't get the proceedings stayed. They made a motion and the stay was granted by the Commissioner.

Mr. Browne: On the representations made by the registrants, Weather-Rite. It was on the basis of their representation about what the civil action contained in New York that the Commissioner stayed it and I think the Commissioner was taken in by it, and that is why we would—

Judge Holtzoff: What do you mean by taken in?

Mr. Browne: Because the representations made by the registrants were less than candid, Your Honor.

Judge Holtzoff: I beg pardon?

Mr. Browne: The representations made by the registrants were less than candid, Your Honor.

Judge Holtzoff: I beg pardon?

Mr. Browne: The representations made by the registrants—

Judge Holtzoff: I don't like to see slang used in the courtroom by members of the Bar, Mr. Browne.

Mr. Browne: I am sorry that I have to use it.

[18] Judge Holtzoff: You mean they misrepresented things to Judge Ryan?

Mr. Browne: Pardon?

Judge Holtzoff: Do you mean—you mean that they misrepresented things to the Commissioner? What did they misrepresent?

Mr. Browne: I didn't say they misrepresented. I said they placed an interpretation on what was before the court in New York such that it caused the Commissioner of Patents to think that the registration rights would be decided in the New York case, and that is not so. Just as in the Wembley versus Diplomat case, the District Court in Maryland didn't decide the registration rights. Neither do we think the court will decide them in New York because the registration isn't before them in the court in New York.

Judge Holtzoff: I think your—this impresses me as being quite right, but don't you think that if you prevail in the New York action, it will then follow the Commissioner would cancel the registration of the trademark?

Mr. Browne: This goes to the question of damage in the interim. Your Honor. The registrant has registered his mark with the Bureau of Customs and we can't get the Bureau of Customs to strike that from the register during the pendency of [19] of this cancellation. They said no, we will have to wait until the Patent Office cancels it before we can cancel it. We are being damaged every day.

Another thing, if I may say, there is a publication put out here recently which shows registrations which are

presently in force. Included in there are not only the registration we seek to cancel but two other numbers which were never issued to Weatherite for the same mark.

Now, this is how we are damaged and that is why we don't feel we should be made to wait disposition of the action in New York.

Judge Holtzoff: Just a moment. Let me take this one step at a time. I am not familiar with this registration in the Bureau of Customs. What is that registration for?

Mr. Browne: That is to first of all, prevent importation of goods into the United States bearing any mark which is confusingly similar to the mark recorded with Customs. It has to be registered in the Patent Office first. Likewise, if that registration is granted by the Patent Office, and is recorded with Customs, the owner of the registration uses that at the port of entry to say: "I have a registration. I can bring my goods in under this mark but nobody else can bring in goods under a similar mark."

[20] Judge Holtzoff: Well, is anybody importing any goods into the United States under this trademark?

Mr. Browne: They have been previously. Your Honor, and as of the moment we are in the discovery stage, still in the Southern District of New York and I can't answer that question. We think there are because there have been. We know there have been and that has been established as a fact. Whether they are today or not I can't say.

Judge Holtzoff: Well, now, actually how are you being damaged—the opposing concern is probably a very small concern, isn't it?

Mr. Browne: Well, They were doing over \$5 million worth of business a year while they were importing these things from Japan.

Judge Holtzoff: Oh.

Mr. Browne: No little concern. But they are certainly hurting Goodyear because in the record, Your Honor will find, there are letters that come in from all over the country complaining about their rainwear and they are sent to Good-

year Tire and Rubber Company, not to Weather-Rite, and every day that registration is out Weatherite represents that the Patent Office has seen fit to issue them a registration, and therefore, they have prima facie evidence of exclusive [21] right to use Goodyear Deluxe by Weatherite and they have represented that to some of the largest chain syndicates in the country.

So we are being damaged every single day, that anything remains in the hands of Weather-Rite which tends to give them any color of right to use Goodyear or to register it and we feel, having complied with the statute after having been before this very court once before and remitting us to a remedy under Section 14 of the Trademark Act, Title 15, U.S. Code 1064, that we should be entitled to expeditious disposition of the administrative proceeding as prescribed by statute and rules and withholding of that action and a delay of that action for more than two years is, if it is discretionary even, is an abuse of discretion because it seems to me, six months' delay might have been excusable, but a year, a year and a half, two years, is unconscionable on the part of any administrative official and I refer to the Fifth Circuit case in the Longshoremen and also refer to Deering Milliken and a number of other cases in my brief which say that to unduly delay or to withhold action is to deny due process.

Now, we are not asking this court to tell the Commissioner how to decide this case. We don't go to the merits. It is only to compel him to let the proceeding go forward in [22] accordance with his rules and the statute.

Now, the evidence that we will put in will be simply the record of the Patent Office to show what transpired but frankly, I don't think there will be anything that will be very startling by way of the evidence beyond what I have said.

I think Your Honor may be interested in reading the pleadings in the Southern District of New York to satisfy Your Honor registration 811725 is no where involved and

if it was, the clerk of the Southern District is required by statute to notify the Commissioner of the pendency of such action and the Commissioner puts such a notice in the file of the registration involved.

There is no such notice in the Patent Office now. So the evidence will tend to show a negative, really, show a lack of basis for the Commissioner's action rather anything to justify the action, and that is where we stand right at the moment.

I will offer the respective exhibits in evidence after the Patent Office has opened.

Judge Holtzoff: Mr. Sears.

**Opening Argument on Behalf of the Defendants
by Mr. Jere Sears**

Mr. Sears: May it please the court, Mr. Browne has [23] indicated generally what the nature of the New York action is. Your Honor earlier asked him what the mark is, Goodyear Deluxe by Weatherite. That mark is involved in the New York action.

He has also indicated that the registration is not involved. To the Patent Office's knowledge based upon the original pleadings in that cause, the registration is not. The reason for that is.

Judge Holtzoff: In other words, you gentlemen agree that the registration is not involved in the New York action.

Mr. Sears: To my knowledge it is not.

Judge Holtzoff: Well, you represent the Patent Office.

Mr. Sears: We agree.

Judge Holtzoff: You gentlemen are agreed it is not involved.

Mr. Sears: I speak only from knowledge in the original pleadings in that case.

Judge Holtzoff: Well—

Mr. Sears: The reason I take it that the—

Judge Holtzoff: The court expects unequivocal statements from Government counsel.

Mr. Sears: Again, I only have knowledge of the original pleadings. Your Honor.

[24] Judge Holtzoff: Well, you are supposed to bring your knowledge up to date.

Mr. Sears: The office action is based solely upon those original pleadings.

Judge Holtzoff: Well, the registration—then the office action is based upon an action in which the registration is not involved.

Mr. Sears: That is correct, Your Honor.

Judge Holtzoff: Very well.

Mr. Sears: I would point out in that connection that the New York action was filed in February of 1965 and the registration did not issue until July of 1966. The registration was not in being at the time the New York action was filed.

Judge Holtzoff: Now, will you explain why the proceeding was stayed by the Commissioner of Patents?

Mr. Sears: All right. The proceeding was stayed, Your Honor, at the request of Weather-Rite Sportswear Company, the registrant. They called—

Judge Holtzoff: You mean at their motion?

Mr. Sears: Yes, on their motion. To that motion Weather-Rite coupled copies of the original pleadings in the New York action and based on those pleadings, the trademark examiner, or if you will, the member of the Trademark [25] Trial and Appeal Board that handles interlocutory matters, could clearly see that the mark was involved, that Goodyear complained about Weather-Rite's use of the mark, that Goodyear sought a permanent injunction against Weather-Rite from using the word Goodyear in almost any context, and also on the basis of an affirmative counterclaim by Weather-Rite, the Trademark Trial and Appeal Board member passing on this matter could also see that Weather-Rite had invoked that court's jurisdiction under Section 1119, Title 15, United States Code.

Under that provision, the New York Court could overhaul the register for the Commissioner, could resurrect cancelled registrations, cancel registrations from the register, do almost anything to make the registration record of the Patent Office right.

Now, Weather-Rite sought cancellation from the New York court on no less than, say, 20 odd registrations of Goodyear. Hence, the jurisdiction of that court where the register is involved has already been invoked by Weather-Rite.

Judge Holtzoff: Well, now, Mr. Sears, is it your thought or is it not your thought that the Federal Court in New York has a right to order the Commissioner to cancel the registration?

Mr. Sears: Very definitely. But—

[26] Judge Holtzoff: Very definitely what, yes or no?

Mr. Sears: Yes. The New York court could, if it ever learns about the registration.

Judge Holtzoff: Well, but the registration is not involved in the pleadings.

Mr. Sears: It could not have been on file on the basis of the original pleadings and Mr. Browne represents to the Patent Office, and I believe also to this court, that to date the New York court has not been apprized of the fact that the mark in that suit has been registered.

Judge Holtzoff: Well, I suppose it is no secret. You will have to enlighten the court on this. Can a trademark be—can a registration of a trademark be cancelled in any proceeding to which the Commissioner of Patents is not a party?

Mr. Sears: Oh, yes. I refer to Section 1119.

Judge Holtzoff: Yes, I have it before me. Oh, yes.

Mr. Sears: The Commissioner need not be a party.

Judge Holtzoff: As a matter of curiosity, Mr. Sears, I would like to ask you, if you can enlighten me, how the Patent Office would register the name Goodyear at the request of somebody whose name is not Goodyear, when

the name—when [27] a man by the name of Goodyear has already registered it.

Mr. Sears: I am not here really to represent Weather-Rite or justify the registration on the merits, Your Honor.

Judge Holtzoff: I understand but you can—you are counsel for the Government and you can inform the court as an *amicus curiae*.

Mr. Sears: All right. As best I can, there is a Supreme Court decision at about the turn of the century—

Mr. Browne: 1888.

Mr. Sears: 1888 involving the use of the expression Goodyear Rubber, I believe. And at the time the Supreme Court believed that this expression was descriptive of rubber that had been processed according to the invention of Charles Goodyear, who didn't give any other name to his process. It carried his own surname. So Goodyear rubber was rubber that had been vulcanized. It was descriptive.

Since there couldn't be any proprietary right in descriptive expressions or marks, then anybody is free to use it.

Now, that would be part of the argument Weather-Rite would make.

Judge Holtzoff: I am not asking you about what [28] argument Weather-Rite might make. I am asking you in the name of common sense and ordinary substantial justice how could they, the Patent Office, register the name Goodyear at the request of somebody whose name is not Goodyear? You know, there are lots of people making—lots of concerns making vulcanized rubber. Could Firestone register the name Goodyear or could Goodyear register the name Firestone, for example?

Mr. Sears: Well, I believe Your Honor is suggesting that today people might have lost sight of Charles Goodyear's invention as such but they do associate Goodyear with the Goodyear Tire and Rubber Company.

Judge Holtzoff: They do.

Mr. Sears: Yes.

Judge Holtzoff: With the Goodyear Tire and Rubber Company. But not with Weather-Rite.

Mr. Sears: Now, assuming that the Supreme Court was correct on the descriptiveness aspect, then registration might be had today, for instance, if secondary meaning had been acquired. But this is not a—

Judge Holtzoff: That was back in 1888, I believe, you said.

Mr. Sears: Yes. There is a more recent ruling, Your Honor, by the Federal Trade Commission, I believe, in the mid- [29] fifties, to the effect that the expression Goodyear rubber might be still used provided the manufacturer of whatever the article is has his name right next to it. In other words, Goodyear rubber by Ajax, of Oshkosh, something like that. So, it has been updated to that extent.

Now, excuse me one minute. Judge Blumenfeld of the District Court, Federal District Court in Connecticut had something to say on this very point in a recent suit, the Goodyear Tire and Rubber Company versus Topps of Hartford.

Now, Topps of Hartford is a retailer of Weather-Rite's. Suits had been brought against Topps by Goodyear to enjoin them from peddling rain coats saying with the mark Goodyear Deluxe by Weatherite on it, say. Now, this particular opinion by the judge goes off on the motion for a preliminary injunction. This was denied. And one of the criteria the judge considered was the probability of success in the action, the major action, and on that point the judge specifically commented that this was a very sticky or involved mixed question of fact and law. The judge acknowledged the Supreme Court ruling. I believe he also acknowledged the FTC involvement more recently. He wouldn't—he couldn't bring himself to agree that the success of the suit was that probable.

[30] Incidentally, in this same action the judge looked into the question of irreparable harm and he has a very interesting discussion on that point. He noted, for instance, that the Goodyear Tire and Rubber Company had been suing a succession of Weather-Rite's customers across

the land, gaining these injunctions, and this had been going on for some time and on that basis he couldn't conclude that irreparable harm would result if he didn't grant the injunction.

Judge Holtzoff: Well, I think if Weather-Rite manufactures defective merchandise under the name Goodyear, that certainly would hurt Goodyear if as Mr. Browne says Weather-Rite does \$5 million worth of business. I thought perhaps it was some little bit of a concern.

Mr. Sears: Well, I think that is still small by comparison to Goodyear's business.

Judge Holtzoff: Oh, yes, of course. But I think 1888, that is 80 years ago, conditions have changed.

Mr. Sears: Well, again—

Judge Holtzoff: And you wouldn't—do you mean that the Patent Office would register a trademark which anybody applied for with the name Goodyear in it, Goodyear Rubber by John Jones?

Mr. Sears: I can't say, Your Honor, I know what [31] occurred in this case. I will not attempt to justify it further. I have merely indicated a position.

Judge Holtzoff: In other words, this was not an inadvertence.

Mr. Sears: It might possibly have been inadvertent, yes.

Judge Holtzoff: Well, I would think if it was an inadvertence, the Patent Office would act expeditiously to cure it.

Well, you may proceed. You have answered my question. It does seem to me—

Mr. Sears: Excuse me one minute.

Judge Holtzoff: —it is absurd as well as unfair that anyone who sells rubber products could get a trademark Goodyear because the average person never heard of the Goodyear patent issued a 100 years ago. We think of Goodyear rubber as rubber manufactured by Goodyear, Firestone tires as tires manufactured by Firestone, and so on.

Mr. Sears: That may be but, of course, Weather-Rite is not a party in this action.

Judge Holtzoff: Well, I just—no, but it seems to me—I am not referring to that. It seems to me to be a bit absurd that a person can go ahead and procure a registration at [32] the Patent Office under those circumstances. However, I am not here to review that.

Mr. Sears: All right. As far as the Patent Office cleaning its own house, a Commissioner once took that view in a cancellation matter. He said in effect if we made a mistake, if we registered this mark in error, well, for heaven sakes, we will correct it and we can do it more readily than the court where the parties were involved in litigation.

I would like to hand up a copy, Your Honor, of that opinion. It is a First Circuit—

Judge Holtzoff: Whose opinion?

Mr. Sears: Of the First Circuit Court of Appeals. That circuit affirmed an injunction granted by the lower court against a defendant in prosecuting a trademark registration cancellation proceeding in the Patent Office. It has a very interesting background to it. Initially suit was brought for a trademark infringement. The defendant came to the Patent Office and instituted a cancellation proceeding against the registration. The plaintiff asked or moved for a suspension of that proceeding pending the outcome of the infringement cause. The trademark examiner at the time agreed. He didn't see the sense in duplicative efforts and he also saw that the outcome in the earlier filed equity action, the court action, [33] might well control the outcome of his proceeding.

Now, the defendant who had brought this cancellation proceeding petitioned to the Commissioner and this is the occurrence I speak of. The Commissioner overruled his trademark examiner and said, well, get on with this proceeding. We can do it more readily, whereupon the plaintiff registrant went back to the court and sought an injunction against the defendant from prosecuting this cancellation matter before the Commissioner, before the Patent Office. And this injunction was sustained by the First Circuit Court of Appeals.

That decision is the Dwinell-Wright Company versus National Fruit Products Company, 1942. And there are some very interesting statements.

Judge Holtzoff: You haven't given me the citation.

Mr. Sears: This is 129 Federal Reporter 2nd, 848, Your Honor.

I think the Commissioner could well have cited this precedent in this very situation because a cancellation proceeding was involved, the propriety of suspending it. Both views are given through the trademark examiner and the Commissioner, and in effect, the court overruled the Commissioner.

Judge Holtzoff: The court enjoined—

Mr. Sears: The party from prosecuting before the [34] Commissioner.

Judge Holtzoff: Until when?

Mr. Sears: As I understand it, until the suit was terminated, the earlier filed equity suit.

Judge Holtzoff: Very well.

Mr. Sears: Now, I would like to pursue this matter of irreparable harm, Your Honor. Mr. Browne has mentioned the recordation of Weather-Rite's mark with the Customs Bureau but he has not even asserted that any of Goodyear's goods have been impounded or that the importation of any goods of theirs has been interfered with in any way.

Judge Holtzoff: Well, I personally think that the real harm would come from a matter referred to by Mr. Browne. Mr. Browne said that a lot of complaints have been received by Goodyear against the quality of the goods. The purchaser is assuming they were made by Goodyear.

Now, I think that is a serious matter.

Mr. Sears: That may be, Your Honor, but the cancellation of the registration would not stop Weather-Rite from using that mark. Only the New York action could stop that. In other words, you do not have to have a registered trademark to use the mark. Use precedes registration.

Judge Holtzoff: Now, let me ask you this. Suppose [35] Goodyear prevails in the New York action. What effect will that have on the registration—on the proceeding to cancel the registration?

Mr. Sears: The member of the Trademark Trial and Appeal Board who ruled on Weather-Rite's motion indicated that he would abide by any injunction that precluded Weather-Rite's use of the word Goodyear in this sense. He recognized that use of the word Goodyear was essential to use of the mark. It is a composite mark, Goodyear Deluxe by Weatherite, and registration, of course, should conform to use.

Judge Holtzoff: Well, now, you said that the member of the Patent Office Board indicated he would follow the ruling of the court. Will that be regarded as res judicata or would it be followed on the theory of comity?

Mr. Sears: It is res judicata as to right to use and I can explain that by referring to the Dunhill case of the Court of Customs and Patent Appeals.

Judge Holtzoff: There is no question about the fact that it would be res judicata on Weather-Rite's right to use the trademark. I am going to repeat my question. My question is, would the Trial Board in the Patent Office regard it as res judicata for the purposes of cancellation of the trademark or would they merely regard it as persuasive and on the theory [36] of comity?

Mr. Sears: Might I introduce our exhibits and I can read the very words—

Judge Holtzoff: No, no. Can't you tell me?

Mr. Sears: The statements made by that member of the Trademark Trial and Appeal Board as I recall, was that it would control or words to that effect.

Judge Holtzoff: I see. They didn't indicate whether it would control on the theory of res judicata or on the theory of comity.

Mr. Browne: It says here "may well have a bearing". are the words the Board used, Your Honor.

Judge Holtzoff: I beg your pardon?

Mr. Browne: "May well have a bearing."

Judge Holtzoff: Now, do I understand you, Mr. Sears, that the New York action was brought before the cancellation proceeding?

Mr. Sears: Yes. The New York action was filed in February of 1965. The cancellation proceeding was filed in July of 1966, about a year and a half.

Judge Holtzoff: I am surprised that they have not been able to bring the New York action to trial. However, there must be some reason for it because the New York Court would [37] not have just delayed. What do you say about the jurisdiction or power of this court to grant the relief prayed for?

Mr. Sears: The complaint had three prayers, Your Honor. We have—the Patent Office has admitted jurisdiction as to prayers A and C.

Judge Holtzoff: A and C. Let me see. In other words, that order admits that this court has jurisdiction to order or direct the Commissioner to vacate the stay and resume the proceedings.

Mr. Sears: That is correct.

Judge Holtzoff: And C—well, C is the same thing.

Mr. Sears: In B, however, the plaintiff sought to select a particular panel of the Trademark Trial and Appeal Board to consider the merits. This is premature and it is also a matter of discretion with the Commissioner.

Judge Holtzoff: Well, if I correctly construe Mr. Browne's argument, he is not asking for the relief specified in the prayer B. He is asking for relief in the nature of the mandamus to require the Commissioner of Patents to vacate the stay and proceed with the cancellation proceeding.

Mr. Sears: However, he hasn't explicitly dropped B. He hasn't withdrawn prayer B, to my knowledge.

[38] Judge Holtzoff: No, he hasn't withdrawn but he hasn't mentioned it in his argument and I always assume

that anything that isn't mentioned by counsel in oral argument is not being pressed and is being abandoned.

Mr. Sears: All right. Now, Mr. Browne has volunteered one statement by the member of the Trademark Trial and Appeal Board as to what would ensue following the New York action. Here is another statement. This appears in his decision of December 9, 1966, paper 14. "Although it is indicated by petitioner"—he is referring to Goodyear here, the plaintiff—"the civil suit is not concerned with the cancellation of respondent's registration here involved, the injunctive relief which petitioner is seeking therein in respect to respondent's use of the term Goodyear will unquestionably have a direct bearing on the question of respondent's right to maintain its registration of a composite mark which includes said term as a salient feature thereof."

Now, Mr. Browne has indicated that in the registration, Weather-Rite has disclaimed the words "Goodyear Deluxe by", I believe, or something to that effect, exclusive of the composite mark. Now, this doesn't mean that Goodyear isn't part of that mark whatsoever. The Court of Customs and Patent Appeals is quite clear on that point. [39] Judge Holtzoff: Well, of course, that disclaimer wouldn't help Goodyear. They don't want the name Goodyear used even as part of anything else.

Mr. Sears: On the other hand, if Weather-Rite is precluded or enjoined from using the term Goodyear, how in the world could they use this particular composite mark?

Judge Holtzoff: They couldn't. They would have to use the name Weather-Rite and I don't think it ought to be allowed to use the name Goodyear.

Mr. Sears: Well, again that goes to the merits.

Judge Holtzoff: Yes.

Mr. Sears: I am not prejudging what might occur on that merit. Now—

Judge Holtzoff: You know, it does seem to me to be a terrible imposition for somebody to go in and register somebody else's name as part of a trademark. Now, I can

understand if another—if a namesake of Goodyear registered the name Goodyear, he would have a right to do that providing he didn't imitate the Goodyear design, and so on, but here, would John Smith have a right to come into the Patent Office and register the name Goodyear? I shouldn't think so.

Mr. Sears: Well, of course, he would have to use the term and my point is that—

[40] Judge Holtzoff: Well, suppose—

Mr. Sears: Registration—

Judge Holtzoff: —he used it this way. Suppose John Smith was a dealer in tires and he advertised that I sell Goodyear tires and he kept advertising along that line. Would he have the right to register the name Goodyear as part of his trademark?

Mr. Sears: As part of his trademark? Again, I hesitate to say.

Judge Holtzoff: Of course, I understand that. I shouldn't think he would.

Mr. Sears: All right. May I submit the Patent Office Exhibit?

Judge Holtzoff: Yes, you may hand it up.

Mr. Sears: All right. Any objection?

Mr. Browne: I understand these are simply for the convenience of the court. I understand these matters that are being handed up are simply for the convenience of the court because they are matters which plaintiff intends to introduce in evidence as plaintiff's exhibits.

Judge Holtzoff: Don't just hand up exhibits. I think they ought to be offered in evidence.

Mr. Sears: I offer them in evidence.

[41] Judge Holtzoff: What are you offering?

Mr. Sears: I offer, sir—

Judge Holtzoff: Let's proceed in order. I think Mr. Browne should offer his evidence first, unless he yields to you.

Mr. Sears: All right. Do you want to offer yours in evidence?

Mr. Browne: Not yet. I will wait until you close your opening argument. If we start putting in our evidence—

Judge Holtzoff: Is there anything you wish to add to your remarks at this time?

Mr. Sears: Well, Your Honor, I thought this instrument would amount mostly to opening argument. That is why I have offered the evidence now.

Judge Holtzoff: The order of proceedings of the trial is first opening arguments of both counsel, then presentation of evidence by the plaintiff, then presentation of evidence by the defendant.

Mr. Sears: All right.

Judge Holtzoff: Then, if any, closing arguments.

Mr. Sears: Then, I will reserve my other remarks for the closing argument.

Judge Holtzoff: Well, suppose you make them now. [42] Just what—you can't offer evidence now but you may make any remarks you wish.

Mr. Sears: All right. I intended, Your Honor, to refer to certain pages of the papers.

Judge Holtzoff: Then, you had better reserve your remarks until the evidence is offered.

Now you may proceed, Mr. Browne.

Mr. Browne: I just wanted to touch on one or two points which I had not had any notice that Mr. Sears was going to rely upon any authority other than those in the Patent Office record—Dwinell-Wright case in 128 Federal 2d 848. We had notice of that. But I don't think it is pertinent from the way he described it.

Judge Holtzoff: We will leave that to your closing argument. Do you have any evidence to offer?

Mr. Browne: Yes, I do, Your Honor.

Judge Holtzoff: Suppose you proceed.

Mr. Browne: I might explain that pursuant to an agreement between Mr. Schimmel, Solicitor of the Patent Office, and myself and of which Mr. Sears has been informed, rather than having a subpoena duces tecum to have the

Patent Office bring in the original record upon which this action was based. It has been agreed that we would compare our file copy [43] with the Patent Office record and we would xerox our copies and submit that in lieu of the original record with the same force and effect.

Judge Holtzoff: That is much better.

Mr. Browne: So, I would like to offer first as plaintiff's Exhibit 1 an item which was so bulky that it couldn't conveniently be included with the Patent Office record of the cancellation and that is the record in Appeal 19276, the Goodyear Tire and Rubber Company versus the Commissioner of Patents, in the United States Court of Appeals for the District of Columbia Circuit. Plaintiff's Exhibit 1.

(The document referred to was marked Plaintiff's Exhibit No. 1 for identification.)

Judge Holtzoff: Well, now—

Mr. Sears: No objection.

Judge Holtzoff: How is that relevant? I don't want to encumber the record with irrelevant material even if there is no objection.

Mr. Browne: It is the basis, Your Honor, upon which the District Court here and the Court of Appeals here remitted plaintiff to a remedy under Title 15, United States Code, 1064 by way of petition to cancel.

[44] Judge Holtzoff: Yes. I think I am going to exclude the record. You can refer to the opinion of the court or order of the Court of Appeals, but the whole voluminous record, I don't think should be here.

Mr. Browne: Well, I only intend to use portions of it and those portions are the ones to which counsel for the Patent Office made representations to this court regarding the effect of issuing a registration subject to cancellation proceeding, as compared to the opposition proceeding.

Judge Holtzoff: I am not interested in representations made by counsel.

Mr. Browne: We feel there was a breach of faith by the Patent Office in light of representations made to this court.

Judge Holtzoff: I will read the record. I don't think it appropriate to accuse anybody of breach of faith, Mr. Browne. You didn't quite mean that.

Mr. Browne: Perhaps I have chosen the wrong word to describe what I understand to be the facts and I will only rest on what the record says.

Judge Holtzoff: The words breach of faith imply dishonesty of some kind and I know you didn't mean that. Dishonesty or deceit.

[45] Mr. Browne: I can only go by what the record says and that is why I want the record in.

Judge Holtzoff: I don't think members of the Bar ought to accuse each other of breach of faith. At least members of the Patent Bar don't do it.

Mr. Browne: Ordinarily we don't, Your Honor.

Plaintiff's Exhibit 2 is the xerox copy of the plaintiff's file copy of cancellation 8738, Goodyear Tire and Rubber Company versus Weather-Rite Sportswear Company, Incorporated, which has been compared with the record.

Judge Holtzoff: I don't care about the comparison.

Mr. Browne: And there is one thing, item number 3, which is a Post Office certified mail return receipt which is not included but it is immaterial.

Judge Holtzoff: I don't care about that. This is a copy of what proceeding?

Mr. Browne: This is the cancellation proceeding which has been suspended. Plaintiff's Exhibit 2.

(The document referred to was marked Plaintiff's Exhibit No. 2 for identification.)

Judge Holtzoff: Will you want the order which stayed or suspended the proceeding and the opinion or memorandum of the [46] Patent Office official, Mr. Browne?

Mr. Browne: This includes the decision.

Judge Holtzoff: I know, I know, but you find it for me.

Mr. Browne: I am sorry. Yes, sir. That is a paper—

Judge Holtzoff: I think the court is entitled to that much help from counsel.

Mr. Browne: Paper 22.

Judge Holtzoff: This is a very voluminous record.

Mr. Browne: That is right, Your Honor. The order—

Judge Holtzoff: Put a bookmark or a tab or something. Mark it. Would you mind writing something on it?

Mr. Browne: I presume you would like me to mark the action by the Trademark Trial and Appeal Board from which we petitioned.

Judge Holtzoff: I would like the order staying the proceeding and any memorandum or opinion accompanying it, whether it be the action of the Trial Board or the Commissioner or both. When I say Commissioner, I mean Assistant Commissioner.

Mr. Browne: The four that I mark are the order to show cause entered by the member of the Trademark Trial and Appeal Board, the decision of the Trademark Trial and Appeal [47] Board suspending proceedings, the denial of a petition for reconsideration of that decision, and then the decision of Assistant Commissioner Reynolds on the petition to the Commissioner. Those four.

Judge Holtzoff: I see. Now, if you will bear with me a moment while I go over the papers that you have marked.

Very well. Anything else?

Mr. Browne: Yes, I do. Plaintiff's Exhibit 3, certified copy of the file wrapper and contents of registration number 811725 which is the subject of the cancellation proceedings.

Judge Holtzoff: In other words, file wrapper. Trademark.

Mr. Browne: Of the registration, yes. As it stood as of the time the cancellation proceeding was commenced.

(The document referred to was marked Plaintiff's Exhibit No. 3 for identification.)

Plaintiff's Exhibit 4, the interrogatories and answers to the interrogatories which were submitted to the defendants and answered by defendants after having hearing by this court.

(The document referred to was marked [48] Plaintiff's Exhibit No. 4 for identification.)

There is only one comment I would like to make on the timing here, I think, to which reference has been made as between the filing of the pleadings, the issuance of the registration, the petition for cancellation, and the suspension of proceedings.

When Weather-Rite sought suspension by motion, they appended to the motion the pleadings in the New York case as they stood as of the time of their motion, which was after the registration issued.

Now, Mr. Sears is trying to relate his argument back to what the pleadings showed at the time answer was filed or at the time complaint was filed. That is not the papers upon which the Patent Office acted. They acted on the papers presented by Weather-Rite which were up to date as of a date after the registration issued.

Judge Holtzoff: Well, have the issues changed?

Mr. Browne: No, sir.

Judge Holtzoff: Well, that doesn't make any difference.

Mr. Browne: Thank you very much. Plaintiff rests its case.

[49] Judge Holtzoff: Defense counsel?

Mr. Sears: Your Honor, I have some certified copies of papers from the file of the cancellation petitioner matter. I intended to offer them in evidence. However, it seems that Mr. Browne has submitted all these papers in uncertified form.

Judge Holtzoff: I don't care whether they are certified or not.

Mr. Sears: All right. I mentioned earlier I would like to refer to certain page—

Judge Holtzoff: Yes.

Mr. Sears: —in one of these papers.

Judge Holtzoff: Well, now, just a moment. You can do that in your final argument.

Mr. Sears: All right.

Judge Holtzoff: Now, do you have any evidence to offer?

Mr. Sears: No.

Judge Holtzoff: Defense rests?

Mr. Sears: No. I would like a few closing remarks.

Judge Holtzoff: I know, but you have to rest first and then have closing remarks.

Mr. Sears: All right. Defense rests.

Judge Holtzoff: Do you wish to add anything by way of closing remarks?

[50] Mr. Browne: I will waive closing arguments and submit on our pretrial brief, the opening arguments and evidence.

Judge Holtzoff: Now, I will hear you.

Closing Argument on Behalf of the Defendants

By Mr. Jere Sears

Mr. Sears: All right. I will try to be very brief, Your Honor. The remarks I have here are addressed primarily to the pretrial brief which I haven't referred to earlier in the plaintiff's file.

Judge Holtzoff: You mean the plaintiff's.

Mr. Sears: Plaintiff's pretrial brief, yes. One point that plaintiff makes in this brief is that copies of the pleadings submitted with Weather-Rite's motion for suspension are allegedly hearsay. I would point out—

Judge Holtzoff: No, no. They are not hearsay. They are not proof of the facts stated therein but they are proof of what the status of the proceeding is or what the issues are.

Mr. Sears: And with regard to the timing aspect, Your Honor, I tried to make this clear, I hope, that the pleadings that Weather-Rite submitted with paper number 7 in the [51] cancellation file—

Judge Holtzoff: What is that?

Mr. Sears: That would be plaintiff's exhibit—

Judge Holtzoff: What is paper number 7? That is what I want to know.

Mr. Sears: It is the motion by Weather-Rite to suspend the cancellation proceeding.

Judge Holtzoff: Why don't you say so instead of giving its number?

Mr. Sears: All right. As part of the trademark rules, Your Honor, every attorney who submits a signed paper in effect certifies that he has read it and he thinks there is good basis for it, so I don't think hearsay is at all proper.

I will go on. I know you have spoken on that.

There is another paper, I believe it is number—the tab is 12. It is plaintiff's Exhibit 2, page 14, at the very bottom.

Judge Holtzoff: What is it?

Mr. Sears: It is a paper submitted by the plaintiff in connection with this motion for suspension. It follows [52] that—

Judge Holtzoff: Well, what is the paper? The number doesn't help but the title of the paper would.

Mr. Sears: It is entitled "Petitioner's Response to Order of Board to show cause why proceedings should not be suspended."

Judge Holtzoff: Now, I will be glad to hear from you.

Mr. Sears: At the bottom of page 14, plaintiff here stated with reference to itself: "Petitioner would be put to further expense and trouble if required to move to amend the pleadings in the civil action at this time or later to bring in the matter of the right of respondents to maintain the registration."

In other words, plaintiff is well aware of its right under Section 1119, Title 15, United States Code, to amend its complaint in the New York action to seek cancellation by the court of the registration involved here. And yet, plaintiff says it is too expensive to take that simple step.

I think that is all I care to say.

Judge Holtzoff: Do you wish to respond?

Closing Argument on Behalf of the Plaintiff**By Mr. Francis C. Browne**

Mr. Browne: As far as the last comment is concerned, [53] I think the plaintiff has the right to elect its statutory remedy.

Judge Holtzoff: Oh, yes.

Mr. Browne: —however it wishes, particularly when it has been remitted by the Court of this circuit to a remedy under the cancellation section, Title 15, 1064.

Judge Holtzoff: You don't mean to say that the Court of Appeals limited you to that remedy, do you?

Mr. Browne: They did not limit us to it but on the facts before them at that time, they said that would be adequate.

Judge Holtzoff: Yes, it would be.

Mr. Browne: That is all we are seeking, adequate remedy.

Judge Holtzoff: Very well.

This is an action for relief in the nature of a mandamus against the Commissioner of Patents in effect to require him to vacate a stay granted by him staying proceedings pending in the Patent Office to cancel a trademark of which the plaintiff complains, and to resume the progress of the proceeding for cancellation. The proceeding to cancel the trademark is authorized by Title 15 U.S. Code 1064.

The salient facts are as follows:

The plaintiff had brought an action in the United [54] States District Court for the Southern District of New York to enjoin the defendant named in that action from using the word Goodyear in its trademark. This trademark was registered by the defendant in that action after the action was filed. Subsequently the plaintiff brought a proceeding in the patent office for cancellation of that trademark. Such a proceeding is authorized by 15 U.S. Code 1064. Neither the New York action nor the cancellation proceeding in the Patent Office has as yet come to final hearing.

On the Motion of the defendant in the New York action who had registered the trademark to which the plaintiff objects, the Patent Office has stayed the cancellation proceeding pending before it until the final determination of the New York action. The plaintiff brought an action before this Court against the Commissioner of Patents to require him to vacate the stay and to proceed with the cancellation proceeding.

At the outset this Court had grave doubts as to whether it has the power to grant relief that the plaintiff seeks because it is an interjection of the Court into an administrative proceeding pending before an administrative body, before the proceeding is completed. Ordinarily, any review of administrative action is had only in respect to final action.

[55] However, for the purpose of this case, the counsel for the Commissioner of Patents does not contest the power of the Court to grant that limited relief and the Court will, therefore, act on the merits of the issues raised by the complaint. Even if the Court had the power to set aside and vacate the action of the Commissioner of Patents and to require him to proceed, that should be done only if the Court is convinced that there has been an abuse of discretion on the part of the Commissioner. The Court is unable to find any abuse of discretion.

Here are two proceedings involving the right of the same party to use a particular trademark. One proceeding is a civil action for an injunction pending in the Federal Court. The other is a proceeding in the Patent Office for the cancellation of the trademark. The issues are substantially the same in both proceedings.

Irrespective of whether any final judgment of the New York Court would be *res judicata*, the appropriate officials of the Patent Office have indicated they would follow it. To allow two proceedings to be actively prosecuted at the same time where both involve the same issue, and substantially the same trademark would not be efficient administration.

The Court is of the opinion that the Commissioner [56] not only did not abuse his discretion but that he properly used his discretion. One proceeding or the other should be stayed while the other is brought to a conclusion.

The plaintiff complains of the fact that it has taken too long a time for the New York case to be released for trial. Whether that complaint is justified or not, it is a matter of which this Court cannot take cognizance. Perhaps the plaintiff, if necessary, could move in the New York proceeding to advance this cause, but that is not a matter for this Court.

In light of these considerations, the Court will render judgment in favor of the defendant, dismissing the complaint on the merits.

Counsel may submit proposed findings of fact and conclusions of law and a proposed judgment.

We will take our mid-afternoon recess at this time.

(Whereupon, at 3:05 o'clock p.m., the Court was recessed.)

Reporter's Certificate

Certified as the Official Transcript of the Oral Opinion of the Court.

SIMON BANKS, JR.
Simon Banks, Jr.
Court Reporter

[2]

Opinion of the Court

The Court: This is an action for relief in the nature of a mandamus against the Commissioner of Patents in effect to require him to vacate a stay granted by him staying proceedings pending in the Patent Office to cancel a trademark of which the plaintiff complains, and to resume the progress of the proceeding for cancellation. The proceeding to cancel the trademark is authorized by 15 U.S. Code 1064.

The salient facts are as follows:

The plaintiff had brought an action in the United States District Court for the Southern District of New York to enjoin the defendant named in that action from using the word Goodyear in its trademark. This trademark had been registered by the defendant in that action. Subsequently the plaintiff brought a proceeding in the Patent Office for cancellation of that trademark. Such a proceeding is authorized by 15 U.S. Code 1119. Neither the New York action nor the cancellation proceeding in the Patent Office has as yet come to final hearing.

On the motion of the defendant in the New York action who had registered the trademark to which the plaintiff [3] objects, the Patent Office has stayed the cancellation proceeding pending before it until the final determination of the New York action. The plaintiff brought an action before this Court against the Commissioner of Patents to require him to vacate the stay and to proceed with the cancellation proceeding.

At the outset this Court had grave doubts as to whether it has the power to grant relief that the plaintiff seeks because it is an interjection of the Court into an administrative proceeding pending before an administrative body, before the proceeding is completed. Ordinarily, any review of administrative action is had only in respect to final action.

However, for the purpose of this case, the counsel for the Commissioner of Patents does not contest the power of the Court to grant that limited relief and the Court will,

therefore, act on the merits of the issues raised by the complaint. Even if the Court had the power to set aside and vacate the action of the Commissioner of Patents and to require him to proceed, that should be done only if the Court is convinced that there has been an abuse of discretion on the part of the Commissioner. The Court is unable to find any abuse of discretion.

[4] Here are two proceedings involving the right of the same party to use a particular trademark. One proceeding is a civil action for an injunction pending in the Federal Court. The other is a proceeding in the Patent Office for the cancellation of the trademark. The issues are substantially the same in both proceedings.

Irrespective of whether any final judgment of the New York Court would be *res judicata*, the appropriate officials of the Patent Office have indicated they would follow it. To allow two proceedings to be actively prosecuted at the same time where both involve the same issue, and substantially the same trademark would not be efficient administration.

The Court is of the opinion that the Commissioner not only did not abuse his discretion but that he properly used his discretion. One proceeding or the other should be stayed while the other is brought to a conclusion.

The plaintiff complains of the fact that it has taken too long a time for the New York case to be released for trial. Whether that complaint is justified or not, it is a matter of which this Court cannot take cognizance. Perhaps the plaintiff, if necessary, could move in the New York proceeding to advance this cause, but that is not a matter for this Court.

[5] In light of these considerations, the Court will render judgment in favor of the defendant, dismissing the complaint on the merits.

Counsel may submit proposed findings of fact and conclusions of law and a proposed judgment.

We will take our mid-afternoon recess at this time.

(Whereupon, at 3:05 o'clock p.m., the Court was recessed.)

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Certified as the Official Transcript of the Oral Opinion of the Court.

SIMON BANKS, JR.
Simon Banks, Jr.
Court Reporter
Rm. 4419
U.S. District Court
Washington, D. C.

Findings of Fact and Conclusions of Law

FINDINGS OF FACT:

1. This is an action under the Administrative Procedure Act (5 U.S.C. 701-706) in which Plaintiff seeks an order directing Defendants to resume proceedings in Trademark Cancellation 8,738 and proceed to completion thereof without further suspension, in the absence of agreement by the parties or a court order to the contrary. The complaint also requested the Court to order and direct the named Defendants to perform their statutory duty of determining and deciding, as members of the Trademark Trial and Appeal Board, the right of registrant to retain Registration 811,725, involved in said Cancellation proceeding, but this request was tacitly withdrawn by Plaintiff in its pre-trial brief and at trial.

2. Weather-Rite Sportswear Co., Inc., filed Trademark Application Serial Number 172,441 on July 3, 1963 for registration of "GOODYEAR DELUXE BY WEATHERITE" for rainwear.

3. Trademark Application Serial Number 172,441 was amended on October 22, 1964, after publication of the application in the Official Gazette of the United States Patent Office on May 12, 1964 for purposes of opposition as pro-

vided by Title 15, United States Code, Section 1063 (Section 13 of the Trademark Act of 1946).

4. Plaintiff in the present case sought, in an antecedent civil action in this court (*The Goodyear Tire & Rubber Company v. The Commissioner of Patents*, Civil Action 2894-64), to have Application Serial Number 172,441 published after amendment thereto on October 22, 1964 to afford Plaintiff an opportunity to oppose said application in the amended form.

5. The antecedent civil action was dismissed by this court and the dismissal was affirmed by the United States Court of Appeals for the District of Columbia Circuit in Appeal No. 19,276, decided December 29, 1965, Plaintiff being remitted to the remedy provided by Title 15, United States Code, Section 1064 (Section 14, Trademark Act of 1946) by way of cancellation of the registration as soon as it would issue.

6. Defendant. The Commissioner of Patents, issued Trademark Registration 811,725 on July 26, 1966, based on the aforementioned Application Serial Number 172,441 without having published the application a second time in the Official Gazette of the United States Patent Office for purposes of opposition under Title 15, United States Code, Section 1063 (Section 13, Trademark Act of 1946).

7. Two days after Registration 811,725 was issued by Defendant, The Commissioner of Patents, namely on July 28, 1966, Plaintiff filed in the Patent Office a petition to cancel the registration as provided by statute in Title 15, United States Code, Section 1064 (Section 14, Trademark Act of 1946) and in accordance with Rules 2.111 et seq. of the Trademark Rules of Practice of the Patent Office.

8. On July 28, 1966, Plaintiff filed a petition in the Patent Office under 15 U.S.C. 1064, seeking cancellation of Registration No. 811,725. This petition initiated Trademark Cancellation proceeding No. 8,738.

9. Defendant, The Commissioner of Patents, duly instituted the cancellation proceeding as Trademark Cancellation 8,738 and directed a Trademark Trial and Appeal Board "to determine and decide the respective rights of registration" in accordance with Title 15, United States Code, Sections 1067 and 1068 (Sections 17 and 18, Trademark Act of 1946).

10. Plaintiff gave notice on October 7, 1966 of the proposed taking of a discovery deposition of a corporate officer of the registrant corporation on October 17, 1966.

11. Registrant thereafter moved, on October 12, 1966, to suspend all proceedings in the trademark cancellation pending termination of a civil action between registrant and The Goodyear Tire & Rubber Company filed in the United States District Court for the Southern District of New York on February 15, 1965. (The Goodyear Tire & Rubber Company v. Weather-Rite Sportswear Co., Inc., Civil Action 65C476.)

12. One member of the Trademark Trial and Appeal Board, on October 27, 1966 issued an order to show cause against the Plaintiff why proceedings in the trademark cancellation should not be suspended as desired by the registrant. Plaintiff responded to the order, pointing out that the registration sought to be canceled in Cancellation 8,738 was not involved in the civil action pending in the Southern District of New York and asking that proceedings in the cancellation be allowed to go forward.

13. Following the order to show cause why the foregoing suspension should not be granted, and petitioner's response thereto, a member of the Trademark Trial and Appeal Board suspended proceedings on December 9, 1966, "pending the final outcome of the civil suit between the parties" In doing so, he noted that "[a]lthough . . . the civil suit is not concerned with the cancellation of respondent's registration here involved, the injunctive relief which petitioner is seeking therein in respect to re-

spondent's use of the term "GOODYEAR" will unquestionably have a direct bearing on the question of respondent's right to maintain its registration of a composite mark which includes said term as a salient feature thereof."

14. On petition for reconsideration, the member of the Trademark Trial and Appeal Board adhered to his decision suspending proceedings, noting with respect to the civil action between the parties that "a decision by the United States District Court will be binding on the Patent Office whereas a decision by the Trademark Trial and Appeal Board would be only advisory in respect to the disposition of the civil suit."

15. Upon subsequent petition to the Commissioner of Patents to exercise his supervisory authority, the First Assistant Commissioner sustained the foregoing suspension order, noting that such "does not deny the petitioner's right to maintain the present proceeding; at most, it merely delays the decision somewhat in the interest of avoiding unnecessary work by the parties and the Patent Office." The decision also notes that while "Title [15], Sections [1067 and 1068], does not, in terms, authorize the suspension of a cancellation proceeding . . . authority to suspend such proceedings in the interest of expediency and orderly conduct is inherent in the right to hold them at all." Plaintiff thereby exhausted its administrative remedy as to the relief sought in Prayers A and C of the complaint in this action.

16. Registration 811,725 is not referred to in any pleadings before the United States District Court for the Southern District of New York as far as the record of the present action shows and there is no record in the files of Registration 811,725 or Cancellation 8,738 of a notice from the Clerk of the United States District Court for the Southern District of New York to the Commissioner of Patents that Registration 811,725 is involved in any action pending in that court, as required by Title 15, United

States Code, Section 1116 (Section 34, Trademark Act of 1946), if such was or is the fact.

17. The cancellation proceedings have remained suspended for two years and the civil action in the Southern District of New York is still in the pre-trial stage, no date for trial having been forecast or set.

18. The foregoing temporary suspension of proceedings in Cancellation 8,738 does not constitute any abuse of discretion by the Officials of the Patent Office, but on the contrary amounts to a reasonable exercise of good judgment and proper discretion on their part.

CONCLUSION OF LAW:

1. The Complaint should be dismissed.

.....
Judge

Approved as to form:

FRANCIS C. BROWNE
Francis C. Browne
Counsel for Plaintiff

December 19, 1968

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Joseph Schimmel
Solicitor
United States Patent Office
Counsel for Defendants

December, 1968

Order

This action came on to be heard at this term and thereupon consideration thereof, it is this — day of December, 1968.

ADJUDGED that the complaint be and it is hereby dismissed.

.....
Judge

Approved as to form:

FRANCIS C. BROWNE
Francis C. Browne
Counsel for Plaintiff

.....
Joseph Schimmel
Solicitor
United States Patent Office
Counsel for Defendants

Notice of Appeal

Pursuant to Rule 3, Federal Rules of Appellate Procedure, notice is hereby given that The Goodyear Tire & Rubber Company, plaintiff above named, hereby appeals to the United States Court of Appeals for the District of Columbia Circuit from the Order and Final Judgment entered in this action on December 20, 1968, dismissing plaintiff's Complaint.

Respectfully,

THE GOODYEAR TIRE & RUBBER COMPANY

By FRANCIS C. BROWNE
Francis C. Browne
Esquire
Attorney for plaintiff

Dated: February 18, 1969

Docket Entries

CIVIL DOCKET

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

Date

1967—Deposit for cost by

Feb. 24—Complaint, appearance. filed.	1
Feb. 24—Summons, copies (4) and copies (3) of Complaint issued # 1 & 2 ser. 3-10; DA ser. 3-1; A.G. ser. 3-2	2
Apr. 25—Answer of defts. to complaint: c/m 4-25; appearance of Joseph Schimmel. filed.	3
Apr. 25—Calendared(N) AC/N.	
Aug. 30—Interrogatories of pltf to defts: c/m 8-30-67. filed.	4
Sept. 14—Opposition of defts to interrogatories and motion to strike; P&A; c/m 9-11-67; M.C. filed.	5
Sep. 19—Opposition of plaintiff to opposition of defendants to interrogatories and motion to strike: c/m 9-18-67. filed.	6
Sep. 20—Motion of defts for leave to file amended answer; P&A; Exhibits A thru D; c/m 9-20-67; M.C. filed.	7
Sept. 26—Opposition of pltf to motion of defts to amend answer; c/m 9-26-67. filed	8
Sep. 29—Recommendation allowing motion of defendants for leave to amend answer; allowing amendment to answer contained in the motion to be the answer. AC/N Pretrial Examiner.	9
Oct. 3—Supplemental P&A of deft in support of opposition to and motion to strike interrogatories; c/m 10-3-67. filed.	10

- Oct. 13—Memorandum of pltf; in reply to supplemental P&A in support of deft's opposition to motion to strike interrogatories; c/m 10-13. filed. 11
- Oct. 18—Addendum by pltf. to memorandum in reply to supplemental P&A's in support of opposition of defts. to motion to strike interrogatories; c/m 10-16-67. filed. 12
- Oct. 25—Recommendation sustaining defts' opposition to and motion to strike interrogatories. AC/N (Signed: 10-24-67) Pretrial Examiner. 13
- Oct. 30—Objections of pltf to recommendation of pretrial examiner on defts' objections to pltf's interrogatories; c/m 10-30-67; M.C. filed. 14
- Oct. 31—Addendum to objections of pltf to recommendation of Pretrial Examiner on defts' objections to interrogatories; Appendices A & B; c/m 10-31-67. 15
- Nov. 8—Answer of defts to objections of pltf and addendum to Recommendation of Pretrial Examiner: Exhibits A & P; c/m 11-8-67. filed. 16
- Nov. 16—Reply of pltf to answer of defts to pltf's objections and addendum to recommendation of Pretrial Examiner; c/m 11-16-67. filed. 17
- Nov. 17—Objections of pltf to recommendations of Pretrial Examiner argued and taken under advisement. (Rep. Nicholas Sokal) Sirica, J.
- Nov. 20—Transcript of proceedings 11-17-67, pp. 1-23. (reported by Nicholas Sokal. Clerk's copy) filed. 18
- 1968
- Jan. 5—Order sustaining objections of pltf. to recommendations of pretrial examiner; referring original objections to interrogatories by deft. to pretrial examiner ruling on merits of each interrogatory; allowing certification to Court of Appeals. (N) Sirica, J. 19

- Feb. 28—Recommendation sustaining in part and overruling in part deft's objections to interrogatories; giving defts. until March 25, 1968 to respond. (AC/N) Pretrial Examiner 20
- Mar. 5—Objection of pltf. to further recommendation of pretrial examiner on defts' objections to and motion to strike pltf's interrogatories; Annex A and Annex B; M.C. filed. 21
- Mar. 6—Objections of deft. to pretrial examiner's recommendations; c/m 3-6; N.C. filed. 22
- Mar. 6—Request by defts. for clarification of pretrial examiner's recommendations; appendix. filed. 23
- Mar. 12—Reply of pltf. to defts' request for clarification of pretrial examiner's further recommendation on defts' opposition to and motion to strike interrogatories; c/m 3-12. filed. 24
- Mar. 12—Reply of pltf. to defts' "objection to pretrial examiner's further recommendation on defts' opposition to and motion to strike interrogatories; c/m 2-12. filed. 25
- Mar. 12—Opposition of defts. to "ptf's objections to further recommendation of pretrial examiner on defts' objection to and motion to strike pltf's interrogatories"; c/m 3-12. filed. 26
- May 2—Order overruling pltf's objections to the Pretrial Examiner's Further Recommendation on Defts' Opposition to Motion to Strike Interrogatories; overruling defts' objections insofar as they pertain to interrogatories 7, 15, 27, 29 & 30 (and all subdivisions thereof), but are otherwise sustained; defts. to have 15 days to file answers to the enumerated interrogatories. (N) Holtzoff, J. 27

May 16—Answers of defts. to interrogatories; c/m 5-16. filed.	28
Jun. 3—Transcript of proceedings, 4-24-68. Vol. I, pp. 1-34. (reported by Gerald Nevitt. Clerk's copy.) filed.	29
Oct. 18—Trial brief by pltf.; c/s 10/18/68; Appendix I, II, III. filed.	30
Oct. 21—Hearing begun; concluded; finding for defts. (judgment to be presented) (Rep: Ruth Taylor in place of Simon Banks.) Holtzoff, J.	
Dec. 13—Transcript of proceedings of Oct. 24, 1968; pages 1-5; (Rep: Simon Banks, Jr. Court's copy. filed.	31
Dec. 16—Objections of pltf. to defts' suggested Find- ings of Fact & Conclusions of Law and pltf's coun- ter-suggestions; c/m 11-19-68. filed.	32
Dec. 20—Findings of Fact and Conclusions of Law (N) Holtzoff, J.	33
Dec. 20—Judgment dismissing the complaint. (N) Holt- zoff, J.	34
1969	
Feb. 18—Notice of appeal of pltf; deposit by Browne \$5.00. (copy mailed to Joseph Schimmel). filed.	35
Feb. 18—Order authorizing deposit of \$250.00 cash in lieu of cost bond on appeal. (N) McGuire, J.	36
Feb. 19—Cash deposit by pltf. \$250.00 in lieu of order of 2-18-69. filed.	
Feb. 20—Cost bond on appeal (cash security) of pltf. in amount of \$250.00 per order. filed.	

